

**Enlarged Board of Appeal EPO, 10 October 2023,
Entitlement to priority
[G 1/22 and 2/22]**



PATENT LAW

The right to claim priority and its transfer are matters of autonomous EPC law

I. The European Patent Office is competent to assess whether a party is entitled to claim priority under Article 87(1) EPC.

- Distinction between (a) title to the European patent application (subject of national property laws) and (b) the right of claim priority, which is created under the autonomous law of the EPC and the Paris Convention, the transfer of which should also be assessed under the autonomous law of the EPC

129. The subsequent applicant wishing to file a European patent application should not only hold the title to that European application (i.e. the right to the European patent) but also the priority right if such right is claimed for the European application. In the context of the EPC and the proceedings before the EPO, a strict distinction should be made between the two rights. The title to the subsequent application, on the one hand, is subject to national property laws. Its transfer is governed by national laws (to be determined in accordance with national conflict of laws rules) and assessed by national courts in view of Article 60(3) EPC (above points 79 ff). The right to claim the priority date for the subsequent European application, on the other hand, has been shown to be a right created under the autonomous law of the EPC and the Paris Convention, the transfer of which should also be assessed under the autonomous law of the EPC (above points 83 ff).

130. The exclusive application of the autonomous law of the EPC to the transfer of priority rights removes the need for conflict of laws rules and the application of national laws, thereby eliminating two main reasons invoked against the EPO's competence to assess whether a party is entitled to claim priority under Article 87(1) EPC. After evaluating various arguments supporting and denying this competence of the EPO (above points 83 ff, 93 ff), the Enlarged Board concludes that the EPO is competent to assess priority entitlement.

- There is a rebuttable presumption under the autonomous law of the EPC that the applicant claiming priority in accordance with Article 88(1) EPC and the corresponding Implementing Regulations is entitled to claim priority.

131. In view of the interests of the parties involved, the lack of formal requirements for the transfer of

priority rights and the necessary cooperation between the priority applicant and the subsequent applicant in the context of the procedural requirements under Article 88(1) EPC, the Enlarged Board concludes that the entitlement to priority should be presumed to exist. This presumption should be rebuttable to take into account rare exceptional cases in which the claiming of the priority by the subsequent applicant appears to be unjustified (above points 101 ff).

II. The rebuttable presumption also applies in situations where the European patent application derives from a PCT application and/or where the applicant(s) are not identical with the subsequent applicant(s).

- In a situation where a PCT application is jointly filed by parties A and B, (i) designating party A for one or more designated States and party B for one or more other designated States, and (ii) claiming priority from an earlier patent application designating party A as the applicant, the joint filing implies an agreement between parties A and B allowing party B to rely on the priority, unless there are substantial factual indications to the contrary.

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Enlarged Board of Appeal EPO, 10 October 2023

(C. Josefsson, F. Blumer I. Beckedorf G. Ambrasaitė-Balynienė R. van Peursesem A. Ritzka P. Gryczka)

Case Numbers: G 0001/22 and G 0002/22

DECISION

of the Enlarged Board of Appeal of 10 October 2023

Appellant in cases T 1513/17 and T 2719/19: (Patent Proprietor / Applicant)

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Respondent in case T 1513/17: (Opponent 1)

Novartis AG Lichtstrasse 35 4056 Basel (CH)

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Respondent in case T 1513/17: (Opponent 2) F. Hoffmann-La Roche AG Grenzacherstrasse 124 4070 Basel (CH) Chugai Pharmaceutical Co. Ltd. 5-1, Ukima 5-chome, Kita-ku Tokyo 115-8543 (JP)

Representative: Teschemacher, Andrea Simmons & Simmons LLP Lehel Carré, Thierschplatz 6 80538 München (DE)

Referring decision: Interlocutory decision in consolidated cases T 1513/17 and T 2719/19 of Technical Board of Appeal 3.3.04 of the European Patent Office dated 28 January 2022.

Composition of the Board:

Chairman: C. Josefsson

Members: F. Blumer I. Beckedorf G. Ambrasaitė-Balynienė R. van Peursesem A. Ritzka P. Gryczka

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SUMMARY OF FACTS AND SUBMISSIONS

The referred questions

1. By the interlocutory decision dated 28 January 2022 in consolidated proceedings T 1513/17 and T 2719/19 (the “referring decision”, published in OJ EPO 2022, A92), Technical Board of Appeal 3.3.04 (the “referring board”) referred, on the basis of Article 112(1)(a) EPC, the following questions of law (the “referred questions”) to the Enlarged Board of Appeal (the “Enlarged Board”) for decision:

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 to 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?

The patent and the opposition proceedings underlying appeal T 1513/17

2. European patent application No. 05 779 924.9, published as international application WO 2005/110481 with the filing date of 16 May 2005 (the “PCT application”), claims priority of the US provisional patent application No. 60/571,444, filed on 14 May 2004 (the “priority application”). The priority application was filed in the name of R.P. Rother, H. Wang and Z. Zhong, the inventors. The PCT application names the three inventors as inventors and as applicants for the United States of America (US) only. For all designated States except the US, it names Alexion Pharmaceuticals, Inc. and the University of Western Ontario as applicants. European patent No. 1 755 674 (the “patent in suit”), was granted on the basis of application 05 779 924.9 on 19 November 2014. Since the University of Western Ontario had assigned their right to the patent application to Alexion Pharmaceuticals, Inc. in 2007, the patent in suit names the latter as the sole patent proprietor (the “patent proprietor”, later the “appellant”) and R.P. Rother, H. Wang and Z. Zhong as inventors.

3. The patent in suit was revoked after opposition proceedings instituted by Novartis AG (“opponent 1”, later “respondent I”) and F. Hoffmann-La Roche AG together with Chugai Pharmaceutical Co. Ltd. (jointly, “opponent 2”, later “respondent II”). The grounds of opposition included lack of novelty over the disclosure in documents D10, D20 and D21, all published after the filing date of the priority application but prior to the filing date of the patent in suit. The validity of the priority claim was contested, inter alia because the applicants, Alexion Pharmaceuticals, Inc. and the

University of Western Ontario were alleged not to be the applicants or the successors in title of the applicants of the priority application.

4. The priority right was found to be invalid because only the priority right of one of the three inventors had been assigned to the patent proprietor. An assignment of the other two inventors to the patent proprietor or to the University of Western Ontario had not taken place prior to the filing of the PCT application. As a consequence of the invalid priority right, the opposition division found, inter alia, that claim 1 of the main request lacked novelty over D20 and D21.

The patent application and the examination proceedings underlying appeal T 2719/19

5. European patent application No. 16 160 321.2 (the “application in suit”) was filed as a divisional application of an earlier divisional application derived from application EP 05 779 924.9 (the application to the patent in suit). Based on the same PCT application as the patent in suit, the application in suit also claimed priority from US provisional application No. 60/571,444, referred to above in the context of appeal case T 1513/17 as the “priority application”.

6. During the examination proceedings, the same issues concerning the priority claim were invoked as in the opposition proceedings concerning the patent in suit (see above points 3 and 4). The same documents D20 and D21 as used in the opposition proceedings concerning the patent in suit were invoked against the subject-matter of the application in suit. For the same reasons as in the opposition proceedings underlying T 1513/17, the priority was found to be invalid. Consequently, the application in suit was refused because intermediate publications D20 and D21 were found to be novelty-destroying prior art.

Appeal proceedings and referring decision

7. Alexion Pharmaceuticals, Inc. as applicant of the refused application in suit and proprietor of the revoked patent in suit, filed appeals (ex-parte appeal T 2719/19 and inter partes appeal T 1513/17) allocated to the same board of appeal. In both cases, the appellant argued that the priority right derived from the priority application was valid and documents D20 and D21 were thus not prior art.

8. The board summoned for oral proceedings on 8 December 2021 for both cases. At the hearing the board decided to deal with both appeal cases in consolidated proceedings pursuant to Article 10(2) RPBA. Both the appellant (in both cases) and respondent II in T 1513/17 requested, inter alia, that questions concerning the validity of priority rights be referred to the Enlarged Board. At the end of the oral proceedings, the chair announced that the board was seriously contemplating referring questions to the Enlarged Board concerning issues related to the entitlement to priority.

9. The referring decision was issued as a joint decision in T 1513/17 and T 2719/19 on 28 January 2022. The board found both appeals to be admissible. A request of the appellant for correction of designation of the applicants for all designated States except the US in form PCT/RO/101 under Rule 139 EPC – which would

have resolved the entitlement to priority issue – was not allowed (Reasons, points 4 to 9).

10. The referring decision then discusses the point which is decisive for the board’s final decision in both cases, namely the entitlement to priority under the “joint applicants approach”. As described in the referring decision, the “joint applicants approach” concerns, in the most simple case, the situation where a party A is applicant for the priority application and parties A and B are applicants for the later application for which the priority is claimed. In this situation, party B can benefit from the priority right to which its co-applicant A is entitled; a separate transfer of the priority right to party B is not needed according to this approach which was found to be undisputed in the referring decision (Reasons, points 15 and 16, referring to T 1933/12).

11. The appellant argues that the joint applicants approach should not only apply to European patent applications with a plurality of applicants but also to PCT applications having different applicants for different designated States. This approach is referred to in the referring decision as “PCT joint applicants approach” (Reasons, point 17). It implies that in a PCT application where parties A and B are applicants for different designated States, both applicants may rely on the priority right derived from a priority application filed by only one of the applicants without the need for any transfer of priority rights from party A to party B.

12. The referring decision noted that the “PCT joint applicants approach” was a disputed concept. In accordance with the requests of all parties to the referral case, it was decided to refer “a question concerning the PCT joint applicants approach” (referred question II) to the Enlarged Board (Reasons, point 19).

13. The parties further took the position that the questions to the Enlarged Board should include a question regarding the jurisdiction of the EPO to decide on the entitlement to the priority right. The referring board noted that the jurisdiction of the EPO to decide on the entitlement to the priority right had been extensively addressed and supported in T 844/18 while the opposite position was not explicitly taken in appeal decisions but in certain communications of boards in cases that were eventually resolved without taking a decision on the issue of entitlement to priority. Considering that the issue would arise in other cases, the referring board took the opportunity to seek a final decision on the “jurisdiction issue” as well (Reasons, point 26; referred question I).

Proceedings before the Enlarged Board of Appeal

14. In accordance with Article 8 of the Rules of Procedure of the Enlarged Board of Appeal (RPEBA), the Enlarged Board decided on 21 March 2022 to consider the points of law referred to it by the board in case T 1513/17 (G 1/22) and in case T 2719/19 (G 2/22) in consolidated proceedings.

15. In March 2022, a communication from the Enlarged Board concerning cases G 1/22 and G 2/22 was published (OJ EPO 2022, A36), inviting third parties to file written statements in accordance with Article 10 RPEBA by 29 July 2022. Thirteen amicus curiae briefs

were received in response (which were published on the internet website of the Enlarged Board under “www.epo.org/law-practice/case-law-appeals/eba.html”):

- (1) Maiwald
- (2) Vossius & Partner
- (3) Nokia Technologies Oy (represented by Cohausz & Florack)
- (4) George W. Schlich
- (5) Boehringer Ingelheim
- (6) The Broad Institute, Inc. (represented by Bird & Bird / Brinkhof)
- (7) Peter de Lange
- (8) IP Federation
- (9) Grund IP Group
- (10) EFPIA – European Federation of Pharmaceutical Industries and Associations
- (11) IPO – Intellectual Property Owners Association
- (12) König Szynga Tilmann von Renesse
- (13) CIPA – Chartered Institute of Patent Attorneys

16. The authors of the amicus curiae briefs can be attributed to the following groups:

- (i) independent members of the patent profession (mainly patent attorneys) and associations of such professionals;
- (ii) enterprises regularly acting as applicants/patent proprietors and/or as opponents.

17. Many amicus curiae briefs were accompanied by documents previously filed in various appeal proceedings in which transfer of priority was relevant (in particular, expert opinions).

18. After expiry of the time limit for filing amicus curiae briefs, Professor Joseph Straus submitted a letter concerning the referral on 22 August 2022. Further comments were submitted by FICPI in a letter dated 13 October 2022 and in a supplemental amicus curiae brief of Mr Peter de Lange on 27 January 2023.

19. In preparation for the oral proceedings, the Enlarged Board issued a communication on 21 March 2023. Based on the comments received in the referral proceedings, a few questions were formulated which, in the Enlarged Board’s view, could help to facilitate the discussion on the merits of the referred questions. All parties as well as the President of the EPO responded to the Enlarged Board’s communication on or before 5 May 2023.

20. During oral proceedings held on 26 May 2023, the representatives of all parties and of the President of the EPO addressed the Enlarged Board.

Summary of the stakeholders’ positions

21. The parties to the referral case, the President of the EPO as well as most of the amicus curiae took the position that the referral should be admissible. A few amicus curiae briefs (Vossius & Partner, G.W. Schlich, Grund IP Group) questioned the admissibility of question I, mainly because they saw no need to ensure uniform application of the law in view of case law they found to be long-standing and consistent. After the Enlarged Board gave its preliminary view in its communication of 21 March 2023 that the referral should be admitted, neither the parties nor the President

of the EPO wished to address the admissibility issue in the oral proceedings.

22. As far as the merits of question I are concerned, the opinions were split. While the appellant, respondent II and the President of the EPO supported an affirmative answer, respondent I – even though in the same procedural position as respondent II – took the clear position that the EPC did not confer jurisdiction to determine whether a party validly claims to be a successor in title as referred to in Article 87(1) EPC. Out of the amicus curiae contributions, about half supported a positive answer while the other half supported a negative answer.

23. The stakeholders supporting the EPO’s jurisdiction mainly argued (i) on the basis of legal certainty and uniformity across all Contracting States and (ii) that entitlement to priority concerned a patentability requirement and that the EPC did not foresee any exception from its jurisdiction in this context. The opposite view was mainly supported by the argument that the EPC lacked the conflict of laws rules necessary to determine the applicable national laws relevant for succession. It was also argued, inter alia, that there was no public or third-party interest in the assessment of a succession that has never been challenged by any party involved in the succession and that the assessment of the entitlement to priority was an assessment of entitlement to the patent, or an analogous assessment, which was prohibited under Article 60(3) EPC.

24. Almost all stakeholders who took the position that question II should be answered by the Enlarged Board supported a positive answer. They argued mainly based on the purpose of the priority system, namely, to facilitate international patent protection. In this context, the “PCT joint applicants approach” was widely supported but also other lines of reasoning such as the concept of an “implied transfer” of priority rights. More emphasis was placed on a benevolent assessment of the applicant’s right to priority than on specific legal considerations. For example, CIPA in its amicus curiae brief (point 2.19) wrote that it was “of the view that it would be beneficial for applicants and proprietors if a generous approach is adopted by the EPO when considering entitlement to priority.”

REASONS FOR THE DECISION

The EPC provisions on priority

25. Articles 87 to 89 EPC form Chapter II (titled “Priority”) of Part III of the EPC. They provide a complete, self-contained code of rules of law on the subject of claiming priority for the purpose of filing a European patent application (G 1/15, OJ EPO 2017, A82, Reasons, point 5.2.3; J 15/80, OJ EPO 1981, 213, Headnote I). **Since the EPC constitutes, according to its preamble, a special agreement within the meaning of Article 19 of the Paris Convention for the Protection of Industrial Property (“Paris Convention”), the EPC provisions on priority are intended not to contravene the basic principles concerning priority of the Paris Convention (see G 3/93, OJ EPO 1995, 18, Reasons, point 4; G 2/98, OJ EPO 2001, 413, Reasons, point 3).**

26. Article 87 as well as Articles 88(2), (3) and (4) EPC pertain to the material conditions under which priority rights may be derived from an earlier application. Article 88(1) EPC concerns the procedural requirements to be met by an applicant desiring to take advantage of the priority of an earlier application, namely the filing of a declaration of priority and other documents with the EPO. These procedural requirements are further specified in the Implementing Regulations (Rules 52 to 54 EPC). Article 89 EPC prescribes the effect of a priority right, i.e. that the priority date shall count as the date of filing of the European patent application for the purposes of the delimitation of the prior art under Articles 54(2) and (3) EPC. In other words, the priority right allows the exclusion of everything that has become prior art between the priority date and the filing date (often referred to as “intermediate prior art”) for the assessment of patentability.

27. Article 87(1) EPC provides that “[any person who has duly filed, in or for (a) any State party to the Paris Convention for the Protection of Industrial Property or (b) any Member of the World Trade Organisation, an application for a patent, a utility model or a utility certificate, or his successor in title, shall enjoy, for the purpose of filing a European patent application in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application” (emphasis added).

Article 87(1) was amended in the context of EPC 2000, inter alia, by the introduction of the reference to applications filed in a Member of the World Trade Organisation in order to align the provision with the TRIPS Agreement (bullet point (b) in Article 87(1) EPC, see OJ EPO Special Edition 4/2007, p. 88).

28. The “same invention” criterion of Article 87(1) EPC (often referred to as “substantive priority” or “substantive validity of the priority”) is regularly an issue in examination and opposition proceedings, and it was underlying two referrals to the Enlarged Board: [G 2/98](#) (OJ EPO 2001, 413) and [G 1/15](#) (OJ EPO 2017, A82). The present referral concerns the question whether the applicant of the later application is entitled to claim the priority of the earlier application, in particular as a successor of the applicant of the priority application (often referred to as “formal priority” or formal validity of the priority; for the terminology see e.g. the comments of the President of the EPO of 8 July 2022, footnote 1).

29. Hereafter, to maintain consistency with the referring decision and existing case law (e.g. T 844/18), the application from which priority is claimed (“first application” in Article 87(1) EPC, “previous application” in Article 88(1) EPC) shall be referred to as the “priority application”. Any application claiming priority from a priority application shall be referred to as a “subsequent application”. Accordingly, the respective applicant shall be the “subsequent applicant” and the applicant of the priority application the “priority applicant”.

30. Article 4A(1) Paris Convention provides: “Any person who has duly filed an application for a patent, or

for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.” (emphasis added)

The extension of the priority entitlement to the successor in title (i.e. the second underlined passage in the quote above) was introduced at the Washington Conference in 1911 (Bodenhausen, Paris Convention for the Protection of Industrial Property, Geneva 1968, p. 37). With respect to the definition of the parties entitled to claim priority from an earlier patent application (“any person who has duly filed an application (...) or his successor in title”), the provisions of Article 4A(1) Paris Convention and of Article 87(1) EPC are identical.

Interpretation and scope of the referred questions

Question I

31. Question 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?*”) refers to Article 87(1)(b) EPC only, where reference is made to priority filings in or for Members of the World Trade Organisation. Article 87(1)(a) EPC refers to priority filings in or for States party to the Paris Convention. The “*successor in title*” passage in Article 87(1) EPC is not specific to one of the groups of states referred to in Article 87(1)(a) and (b) EPC. These groups overlap to a large extent, and the legal issues are the same for both groups. Moreover, question II refers to “claiming priority rights under Article 87(1) EPC”. It is therefore assumed that the reference to sub-paragraph (b) of Article 87(1) EPC in question I is of no relevance.

32. The wording of question I with respect to the jurisdiction of the EPO is clear in that it addresses the competence of the EPO (i.e. of the examining and opposition divisions and also the boards of appeal) to assess the entitlement to claim priority of the party filing the subsequent application.

33. There may be uncertainties about the entitlement to claim priority under Article 87(1) EPC also in cases where not the succession in title but the identity of the person having filed the priority application is in dispute. In T 844/18, concerning a situation where four inventors were applicants of the priority application and only three of them filed the subsequent European application and claimed priority, the board took the position that succession in title was not an issue in this case (see Reasons, point 21). In the Reasons (point 9 and 23) of T 844/18, reference is made to the jurisdiction to examine “who is entitled to the right of priority” (Reasons, points 9 and 23). The discussion of the EPO’s jurisdiction in T 844/18 consequently encompasses the determination of both the person who filed the priority application and its successor in title. Similar to the facts underlying T 844/18, a legal entity consisting of a plurality of persons or entities (such as a partnership) may be the applicant of a priority application, and the same entity with a changed composition or membership may claim priority from this application. In such situations, it may be difficult to distinguish between the determination of the personal

identity between the two applicant entities and the assessment of a succession in title.

34. To cover all situations where the right of an applicant to claim priority is relevant in proceedings before the EPO, question I is rephrased as follows: “*Is the EPO competent to assess whether a party is entitled to claim priority under Article 87(1) EPC?*”. As explained in the communication of the Enlarged Board of 21 March 2023, question I refers to the EPO’s competence to assess the entitlement to claim priority for the subsequent application and it encompasses all situations where the applicant claiming priority for its subsequent application is not clearly identical with the applicant of the priority application.

35. As has long been pointed out in the discussions on entitlement to priority, the issue of entitlement not only arises with respect to a patent or patent application examined or opposed to in proceedings before the EPO. The issue equally arises with respect to prior art, namely patent documents forming prior art under Article 54(3) EPC and relying on a priority date prior to the effective date of the European patent application or European patent under consideration (see e.g. T 493/06, Reasons, points 1 to 11; T 382/07, Reasons, point 9). Question I is understood to cover both cases; the objection that an applicant was not entitled to claim priority can equally be raised by an opponent (if the priority issue concerns the opposed patent) or by a patent proprietor (if the priority issue concerns a prior art document).

Question II

36. Question II is understood to concern proceedings before any instance or department of the EPO where the situation described in question II occurs. According to the referring decision, the question needs to be answered only “[i]f question I is answered in the affirmative”.

37. The question covers a special situation occurring where a party, typically the inventor(s), files a US priority application (also in the form of a provisional application) which is then used as priority application for a later PCT application designating one party (typically still the inventor(s) for the US only and another party (typically the employer of the inventor(s)) for regional European patent protection. Before the “America Invents Act” (AIA) of 2011 entered into force, only the inventor(s) could be applicants in a US patent application (see e.g. Druschel/Kommer, Die formelle Priorität europäischer Patente, GRUR 2022, 353). The priority application underlying the present referral (filed in 2004) had to be filed by the inventors under the then applying laws.

38. As implied by the referring decision (see Reasons, point 43), the wording of question II is addressing the facts underlying the referral and the “PCT joint applicants approach” (see above point 11) in a general way but it is not to be understood as being further limited to specific factual circumstances (e.g. to a number of parties).

39. As pointed out in the referring decision (Reasons, point 18), confusion should be avoided between the “PCT joint applicants approach” mentioned

above and the “all applicants approach” used, for example, in decision [T 844/18](#) (Facts and Submissions, point VIII). In this case, four inventors were applicants of the priority application and only three of them filed the subsequent PCT application (encompassing the European application) and claimed priority. The priority claim failed to meet the requirement that all applicants of the priority application must also be applicants of the subsequent PCT application for which the priority is claimed.

40. The referring decision critically summarises various possible legal bases for the “PCT joint applicants approach” (Reasons, points 28 to 39). However, the referring board did not limit its question II to the viability of the “PCT joint applicants approach”, thereby leaving open the possibility that question II could be answered in the affirmative with another reasoning (for example, by acknowledging that the joint filing of a PCT application is sufficient proof for the validity of the priority claim).

41. As far as the reference to Article 4 of the Paris Convention at the end of question II is concerned, it is understood that this refers to compliance with all provisions of Article 4 Paris Convention except for the entitlement to priority as addressed in Article 4A(1) Paris Convention (see above point 30).

42. The referring decision addresses the conflict of laws rules applicable to the transfer of priority rights, noting that a separate question was not necessary “because it is inherently contained in the questions posed and it will be addressed in the considerations of the EBA, as needed” (Reasons, point 37).

Admissibility of the referral

Requirements for admissibility

43. According to Article 112(1)(a) EPC, “[i]n order to ensure uniform application of the law, or if a point of law of fundamental importance arises”, a board of appeal “shall, during proceedings on a case and either of its own motion or following a request from a party to the appeal, refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes.”

44. The Enlarged Board must examine the above admissibility requirements with respect to each referred question individually ([G 1/19](#), OJ EPO 2021, A77, Reasons, point 56, with further references).

Question I – Jurisdiction of the EPO

45. Since the Enlarged Board takes the position that question II should be admitted (see below points 49 ff), question I should also be admitted for the sole reason that the questions are interlinked insofar as an affirmative answer to question I is a precondition for approaching question II. However, question I in itself already fulfils the requirement of Article 112(1) EPC that an answer is required to ensure uniform application of the law or because a point of law of fundamental importance arises.

46. The issue of entitlement to priority arises with every patent application for which priority from an earlier application is claimed or which is confronted with prior art patent documents claiming priority. Where

priority entitlement is disputed in any proceedings, the EPO instance addressing the issue must (at least implicitly) decide on question I. The question – or an affirmative answer thereto – thus can be viewed as fundamental for any investigation of priority entitlement under Article 87(1) EPC. The discussion concerning question I in the present referral proceedings shows that fundamental questions of law are touched upon, such as the extent of the EPO’s jurisdiction for questions of civil law or the right of a third party to challenge entitlement to priority rights to which the third party cannot claim any entitlement.

47. It has been argued in certain amicus curiae briefs (Vossius & Partner and Grund IP Group) that question I should not be admitted because there was no conflicting case law on the issue of the EPO’s jurisdiction. However, diverging decisions are not a requirement for the admissibility of a referral if a board is referring a question to the Enlarged Board (Article 112(1)(a) EPC). Regardless of whether or not any decisions are in direct conflict with e.g. T 844/18, the EPO’s jurisdiction concerning the entitlement to the priority right has been questioned by boards of appeal in several cases (see the referring decision, Reasons, point 26), and the issue is arising in various other cases before different boards. The condition that an answer of the EPO is required to ensure uniform application of the law is therefore met.

48. The Enlarged Board is satisfied that both of the alternative conditions of Article 112(1)(a) EPC are met (point of law of fundamental importance and necessity to ensure uniform application of the law). The condition that an answer to question I is needed for the referring board to decide is met because an answer is needed to question II (above point 45). For these reasons, referred question I is admissible.

Question II – Validity of the priority in the specific case

49. Question II mirrors the facts underlying the referring decision (see above point 38). An answer to question II is therefore required for the referring board to decide in the two pending appeal cases.

50. As described above (point 37), question II concerns a specific situation related to US law where only inventor(s) could file a patent application. This requirement has ceased to exist. However, apart from the two cases underlying this referral, there are still a significant number of cases pending where the application was filed while only inventors could apply for a US patent (see e.g. case T 419/16, where an interlocutory decision was taken on 3 February 2022 to stay the appeal proceedings until a decision is issued in the present referral). Moreover, inventors still act as applicants for the US only in cases where the PCT application is filed both for the US and for protection in Europe under the EPC.

51. While the question refers to a specific situation, the answer would not necessarily be limited to the viability of the “PCT joint applicants approach” and it may cover other situations where the applicant’s entitlement to the priority right is challenged. However,

even if the answer covered only the situations described in question II, the question is considered to touch a point of law of fundamental importance in the terms of Article 112(1) EPC.

52. The Enlarged Board is not aware of any case law challenging the viability of the “PCT joint applicants approach”. However, it is noted that the possible legal bases for this concept have been questioned even in the referring decision (Reasons, points 28 to 33). The fact that there are different legal bases proposed for the “PCT joint applicants” approach already shows that there is no uniform approach to this concept. Moreover, decisions of national courts (see Reasons of the referring decision, points 40 and 41) and various amicus curiae briefs base their positions supporting an applicant’s right to priority on other arguments than the “PCT joint applicants approach” (see above point 24). In view of future case law, it is desirable that not only the answer to question II is uniform but also the basic reasoning behind such answer.

53. Since an answer to question II is necessary for the referring board to decide the pending appeal cases and at least the criterion of “a point of law of fundamental importance” under Article 112(1)(a) is met, question II is admissible.

The “right of priority” and its assignment under Article 87 EPC

Purpose of priority rights

54. The basic purpose of the right of priority is to safeguard, for a limited period, the interests of patent applicants in their endeavour to obtain international protection for their inventions, thereby alleviating the negative consequences of the principle of territoriality in patent law (T 15/01, OJ EPO 2006, 153, Reasons, point 32, with references to the relevant literature). The priority provisions contained in the Paris Convention should not be regarded as a body of exception clauses which should be interpreted strictly (see in this respect T 998/99, OJ EPO 2005, 229, Reasons, point 3.1; see also T 1201/14, Reasons, point 3.2.1.3). To the contrary, the Rules of the Paris Convention and the self-contained priority system of the EPC should be construed in a manner which ensures that the above-mentioned general purpose is fulfilled as far as possible (T 15/01, Reasons, point 34, confirmed in T 5/05, Reasons, point 4.4; see also Straus, *The Right to Priority in Article 4A(1) of the Paris Convention and Article 87(1) of the European Patent Convention*, *JIPPLP* 2019, 687, 688/689).

55. For the person filing a patent application in a state addressed in Article 87(1) EPC, the priority system means that it has the option to file a bundle of subsequent applications for the same invention in a freely selected group of other territories where each of the later (national or regional) applications may benefit from the priority date of the first application. The priority period of twelve months on the one hand allows for an evaluation by the applicant as to where patent protection should be sought. On the other hand, the clear limitation of the period provides legal certainty to third parties who ought to know the geographical limitations of the patent protection they may be confronted with.

56. The effect of the priority right (namely, the exclusion of intermediate prior art; see above point 26) often concerns publications originating from the priority applicant or persons connected with it. The priority right thus also protects an applicant from its own intermediate prior art and allows it to publish the content of the priority application before the subsequent applications are filed. This aspect is of particular relevance in a patent system like the European patent system that generally does not provide grace periods prior to filing a patent application during which publications of the applicant are non-prejudicial.

57. Only the subsequent application (for which priority is claimed) and the respective applicant may benefit from the priority right. For the priority application, the priority right derived therefrom is irrelevant since for the priority application there is no period between the priority date and the application date (and, consequently, no intermediate prior art).

EPO case law under Article 87 EPC

Jurisdiction of the EPO

58. In most of the cases where the boards had to assess whether the applicant of a subsequent application was entitled to claim priority under Article 87(1) EPC, the boards tacitly assumed that they had jurisdiction for such assessment. [In T 844/18](#), where this jurisdiction was challenged, the board affirmed its jurisdiction, primarily because it saw no reason why it should concern itself with three of the requirements for priority under Article 87(1) EPC (where? / what? / when?) but not with the first requirement (who?) (see Reasons, points 11 to 14). The board also did not see a possibility for applying Article 60(3) EPC (i.e. the presumption that the applicant is entitled to exercise the right to a European patent) by analogy to the right to claim priority under Article 87(1) EPC (Reasons, point 15). These views in [T 844/18](#) were confirmed in [T 2431/17](#), see Reasons, point 1.5.2).

59. However, deviating positions have been discussed within the boards of appeal, as shown in the non-binding preliminary view of the board in the communication of 14 June 2017 in case [T 239/16](#). (The priority issue was not relevant for the final decision.) There is more widespread scepticism concerning the EPO's jurisdiction for determining entitlement to priority. This has also been demonstrated by the positions taken in the amicus curiae briefs and by the different positions taken by the two opponents in the inter partes case underlying this referral (see above point 22).

60. From the case law quoted by the different stakeholders, the conclusion could be drawn that before T 62/05 and T 788/05, the entitlement to priority was not regularly questioned, which would mean that the EPO's jurisdiction in this respect was not an issue in most cases. Earlier decisions quoted in this context (most notably T 1008/96) appear to be isolated cases. Another early decision, J 11/95 is even quoted as a counterexample since it held that the EPO had no jurisdiction to decide claims to the right to national patent applications or priority rights derived therefrom (Reasons, point 4). In

an amicus curiae brief (efpia) it was noted that attacks on formal priority started to become routine in EPO oppositions from about 2010, and it was speculated that such objections became popular after practitioners became alerted through some decisions of national courts in the United Kingdom and because they offered a simple way to invalidate patents whenever there was intervening prior art. In response to a question in the Enlarged Board's communication of 21 March 2023, respondent I provided, in its letter of 5 May 2023, statistical evidence supporting the assertion that there has been a "dramatic increase in frequency" of priority entitlement challenges from 2015 onwards.

61. Considering the rarity of priority entitlement challenges during the first decades of the EPO, it can be concluded that the boards' case law is substantially uniform (at least during the past 10 or 15 years) insofar as the EPO is viewed to have jurisdiction to decide who is entitled to claim priority. When it comes to how the EPO should decide disputes on entitlement to priority, the case law is diverging or has not developed much in many aspects.

Application of national law to assess succession under Article 87(1)EPC

62. According to consistent case law, national law is applicable to the succession in title addressed in Article 87(1) EPC (see e.g. T 1201/14, Reasons, point 3.1.2, with further references). The EPC contains no conflict of laws rules for the determination of the applicable national laws except for the provision in Article 60(1) EPC that for employee inventions the right to a European patent shall be determined in accordance with the law of the State in which the employee is mainly employed or in accordance with the law of the State in which the employer has the place of business to which the employee is attached. This rule is addressed to the national courts of the Contracting States assessing disputes concerning the right to a European patent as addressed in Article 61(1) EPC. The EPC does not contain, in particular, any conflict of laws rules applicable to the transfer of rights from an applicant other than the inventor(s) to the successor(s) of such applicant (see e.g. T 205/14, Reasons, point 3.6.5; T 725/14, Reasons, point 4.3; T 1201/14, Reasons, point 3.1.2).

63. Conflict of laws rules concerning the succession under Article 87(1) EPC could refer to a range of different national laws. In [T 1201/14](#) the following possibilities were listed (Reasons, point 3.1.2):

- a) the law of the country where the first application was filed ("lex originis");
- b) the law of the country where the subsequent application was filed ("lex loci protectionis");
- c) the law of the country which is agreed upon in the relevant contract ("lex loci contractus");
- d) the law of the country where at least one of the parties to the transfer has its residence ("lex domicilii").

64. Any one of these options is related to specific issues which may imply further uncertainties. For example, the freedom to choose the applicable law of a

contract (e.g. an employment contract) may be limited and choice of law rules tied to the territory of the priority application or of the subsequent application (options a) and b) listed above) are difficult to apply where a patent territory does not coincide with the territory in which the relevant law applies (in the territory of US patents federal law and state laws apply, the territory of a European patent encompasses a multitude of jurisdictions with different laws). In sum, the private international law aspects of Article 87(1) EPC can be described as complex (see Moufang, in Schulte (ed.), *Patentgesetz mit EPÜ*, 11th ed., Hürth 2022, § 41 N 28).

65. So far, no clear preference has been expressed for any choice of law rule in the EPO case law (see Maibaum, *Die rechtsgeschäftliche Übertragung des Prioritätsrechts bei europäischen Patenten*, Hürth 2021, p. 24-30). In several cases before the boards of appeal, the succession under Article 87(1) EPC was assessed under different national laws for the same set of facts with the same result, and, as a consequence, the board did not have to decide which law was applicable. For example, in [T 577/11](#), the board found that none of the appellant's lines of argument, which were based on the applicability of Italian and Dutch law, led to a finding favourable for the applicant (Reasons, point 6.3). In [T 1201/14](#) (see Reasons, point 3.2), the appellant relied on four lines of arguments to support its entitlement to priority: a (retroactive) *nunc pro tunc* assignment under US law, an implicit transfer by virtue of a general policy under German law, a "direct transfer" under US law and an implicit transfer by virtue of a general policy under Taiwanese law. Since none of these lines of arguments was both admitted and accepted by the board, there was no reason to determine the applicable national law (Reasons, point 3.3).

66. In cases where the applicable national law is determined, national provisions are regularly applied by the boards of appeal. For example, the board in [T 205/14](#), found that Israeli law was applicable and, relying on opinions of experts in that law, that Israeli law on service inventions did not provide for formal requirements to be fulfilled in the context of the transfer of the rights related to service inventions (Reasons, point 3.7). Parties are regularly requested to file evidence (such as a legal opinion from an independent law expert) concerning the effects of the applicable national laws (see already [J 19/87](#), Facts and Submissions, point VIII).

67. For the referring board, it was "far from clear" that the legal requirement for the transfer of priority rights by agreement should be assessed under national law, as the EPC does not contain any conflict of laws rules (referring decision, Reasons, point 37). The referring board drew the conclusion from earlier case law that the EPC did not seem to impose any formal requirements for the transfer of priority rights by agreement. Consequently, it envisaged – at least for the situation addressed in question II – that an implicit agreement could be sufficient to bring about the transfer of the priority right for the EPC territory (Reasons, point 38).

Autonomous considerations discussed while assessing succession under Article 87(1) EPC

68. It has been deduced from the wording of [Article 87\(1\) EPC](#) (without reference to national law) that the transfer of the right of priority has to have been concluded before the filing of the subsequent European patent application ([T 1201/14](#), Reasons, point 3.1.1.1; [T 577/11](#), Reasons, point 6.5, Catchword 3; [T 1946/21](#), Reasons, point 2.3). The requirement that the right of priority has to be transferred before the filing of the subsequent application can be described as a requirement based on autonomous substantive law under the EPC.

69. Another autonomous rule has been discussed in view of [Article 72 EPC](#), although with different outcomes. In [T 62/05](#), the board required an equally high standard of proof for the transfer of priority rights as the one required for the assignment of a European patent application, i.e. that the assignment of priority rights had to be in writing and had to be signed by or on behalf of the parties to the transaction (Reasons, point 3.9). In [T 205/14](#), on the other hand, the application of Article 72 EPC to the transfer of a right of priority was rejected (Reasons, point 3.6; see also [T 517/14](#), Reasons, point 2.7.1).

National case law under Article 87 EPC

70. If questions of entitlement to claim priority under Article 87(1) EPC arise in national proceedings, the court seized needs to address all issues concerning the applicant's identity or succession, including the determination and application of foreign laws. However, in proceedings before national courts, conflict of laws issues and the related application of foreign law tend to cause less concern than in proceedings before the EPO. On the one hand, national courts can rely on their applicable conflict of laws rules and the respective case law. On the other hand, the domestic (substantive) laws of the national court are often applicable, either because the applicable conflict of laws rules refer to it or because conflict of laws issues are not relevant in cases not having connections to more than one jurisdiction.

71. If the facts of a case involve one or more jurisdictions other than the court's own jurisdiction, the court's set of conflict of laws rules is applied by first qualifying the legal relationship at issue in view of the individual conflict of laws rule that may be applicable. Specific statutory conflict of laws rules for the transfer of priority rights do generally not exist in national legislations on private international law. German courts have found, for example, that the validity of the transfer of a right to claim priority is subject to the laws of the state of the priority application (*lex originis*) while the obligations between the assignor and the assignee are subject to the laws applicable to the contractual relationship between these parties (*lex contractus*) (see the summary in [German Federal Court of Justice X ZR 14/17 – Drahtloses Kommunikationsnetz](#), point 68).

72. The referring decision (in Reasons, point 40) cited another decision of the German Federal Court of Justice (Bundesgerichtshof, BGH) where the German

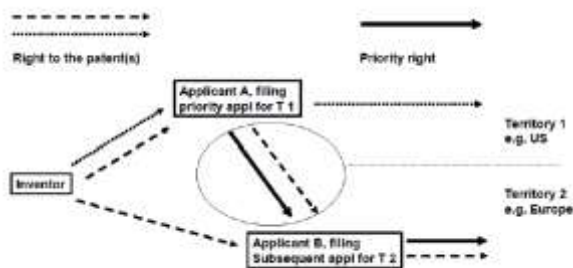
conflict of laws rules, including the Rome I Regulation (see below point 80) pointed to the applicability of German law, which did not require any particular formalities for the transfer of priority rights. In view of the relationship between the parties to the transfer and a research and development agreement concluded between them, the German Federal Court of Justice accepted that there was an implicit agreement (“konkludente Einigung”) between the parties, which was sufficient to acknowledge priority for the European patent ([BGH, X ZR 49/12 – Fahrzeugscheibe](#), points 12 to 18).

73. In a decision of the High Court of Justice of England and Wales ([Accord v RCT \[2017\] EWHC 2711 \(Ch\)](#)), entitlement to priority was critical because it could not be shown that the applicant’s entitlement to priority had been secured by the date of the subsequent application (point 66). Reference was made to earlier case law which “accepted a significant softening to what otherwise might have been the rigour of the rule that the title must be secured by the time the international application is made, by accepting an analysis based on common law principles distinguishing the equitable and legal title to property”. If such distinction could be made, it was sufficient for the applicant to hold “the equitable or beneficial title to the priority right” at the date of the application (point 67).

Transfer of different rights to the subsequent applicant claiming priority

74. The figure below shows in a simplified manner how an inventor (or their employer or other legal successor) may obtain international patent protection, using the priority system established under the Paris Convention.

Autonomous considerations discussed while assessing succession under Article 87(1) EPC



75. The inventor may apply for a patent in every territory or may transfer the right to obtain a patent to separate applicants for the different territories. Inventors often assign the right to the patents in all territories to a single applicant who then files a priority application. Within the priority period, the priority applicant or other applicants may file patent applications in other territories which benefit from the application date of the priority application (i.e. the priority date).

76. The dashed and the dotted lines represent the right to file a patent (evolving into the title to the patent application after filing in the respective territory). Applicant B may obtain the right to file a patent for territory 2 from the priority applicant who acquired the rights for all territories from the inventor. Applicant B

may also acquire the right to file a patent for territory 2 directly from the inventor. Within international groups of companies, the inventor’s employer company may acquire the rights for all territories and then vest its subsidiaries in the different territories with the patent rights for the respective territories. These possibilities reflect the fact that the title to a patent application is a property right that is established and may be transferred for each territory in accordance with the laws of the respective territory.

77. The priority right (straight lines) may be obtained only as a consequence of the filing of the priority application (see below points 83 ff). The priority applicant needs to provide any subsequent applicant with the documents required in the respective territory for claiming priority. The priority right remains relevant for the subsequent application and any patent based thereon but it is not relevant for the priority application.

78. If the priority applicant (Applicant A) transfers the title to the subsequent application to the subsequent applicant (Applicant B), this transfer is normally realised together with the transfer of the priority right (encircled arrows). In the agreements discussed in priority entitlement cases, no distinction is usually made between the two transfers (see below points 93 ff). Also in the existing EPO case law under Article 87(1) EPC (see above points 58 ff), it is not always clear whether the transfer at issue encompasses only the priority right or also the title to the subsequent European application. However, the fact that different parties are potentially involved in the transfer of the different rights already shows that a clear distinction should be made between the title to the subsequent application and the priority right, i.e. the right to attribute the date of the priority application to this application. As will be shown in the following paragraphs, only the transfer of the priority right (straight line) is relevant for the proceedings before the EPO for the purposes of Article 87(1) EPC.

Competence and applicable law for the transfer of the different rights invoked by the subsequent applicant

Title to the subsequent application

79. In proceedings before the EPO, the applicant shall be deemed to be entitled to exercise the right to the European patent ([Article 60\(3\) EPC](#)). The EPO has no power to decide a dispute as to whether a particular applicant is legally entitled to apply for and be granted a European patent in respect of the subject-matter of a particular application. The determination of questions of entitlement to the right to the grant of a European patent prior to grant is governed by the “Protocol on Jurisdiction and the Recognition of Decisions in respect of the Right to the grant of a European patent” (the “[Protocol on Recognition](#)”), which is an integral part of the EPC ([G 3/92](#), OJ EPO 1994, 607, Reasons, point 3). The Protocol on Recognition governs the jurisdiction of the national courts of the Contracting States for disputes on entitlement to European patent applications. After grant, the national courts are competent to decide on disputes on the title to the European patent for each of the designated Contracting States. During disputes on

the right to the grant of a European patent, the proceedings for grant before the EPO are regularly stayed in accordance with the provisions of Rule 14 EPC.

80. Disputes on the title to a European patent application or patent are resolved by the national courts by first determining the applicable law, applying their conflict of laws rules. These rules form part of the respective legislation on private international law but there are attempts to harmonise conflict of laws rules. For example, [EU Regulation 593/2008 of 17 June 2008 on the law applicable to contractual obligations \(Rome I Regulation\)](#) provides uniform conflict of laws rules for contractual obligations in civil and commercial matters.

81. [Article 60\(3\) EPC](#) applies to the applicant of any European patent application, regardless of whether it is a priority or first application or a subsequent application. In the case depicted in the figure above (point 74), assuming that the subsequent application is a European patent application, the national courts would be competent to decide on the title to this European patent application in accordance with the Protocol on Recognition.

82. As far as the title to the priority application is concerned, [Article 60\(3\) EPC](#) is not directly applicable, unless the priority application is a European application. If the title to the subsequent European patent application has been acquired from the priority applicant, national courts may have to assess under the applicable national laws who was entitled to the priority application in order to establish the chain of transfers leading to the subsequent applicant.

Right to claim the priority date for the subsequent application

83. According to decision [T 205/14](#) (Reasons, point 3.3), the right to priority, that is, the right to claim priority for a European patent application from the filing date of an eligible “first application” or “previous application” originates in the applicant of the first application. The prevailing literature also assumes that the first application, not only a subsequent application, establishes the priority right under the Paris Convention (see Wieczorek, Die Unionspriorität im Patentrecht, Köln etc. 1975, p. 21, with further references). **The filing of a first application may be seen as the creation of a bundle of potential priority rights that come into existence and may be examined only when they are invoked in a subsequent application.**

84. For the subsequent application, priority rights are governed exclusively by [Articles 87 to 89 EPC](#) (see above point 25). It may be discussed whether the priority right with the priority applicant is established under [Article 87\(1\) EPC](#) or under the Paris Convention. In any case, no national laws are involved when a priority right is created or claimed for a subsequent application. This is a significant difference to the title to a European patent application or patent, which depends upon national laws (for example, employment law or property law).

85. Since the creation, the existence and the effects of the priority right are governed only by the EPC (and

by the Paris Convention through its relationship with the EPC), priority rights are autonomous rights under the EPC and should be assessed only in the context of the EPC, regardless of any national laws.

86. Consequently, the entitlement to claim priority (and any related assignments of priority rights) should also be assessed under the autonomous law of the EPC. There are decisions that have approached the transfer of priority rights under autonomous rules (see above point 68 for the requirement that the priority right is assigned before the filing of the subsequent application and point 69 for the requirement of a written agreement). The Enlarged Board endorses the assessment of priority entitlement under the autonomous law of the EPC but not necessarily all rules discussed in this context in the existing case law. The autonomous requirements for the valid transfer of priority rights should not be stricter than national rules applicable to the transfer of priority rights or other property rights. As the referring board noted, the EPC does not impose any formal requirements for the transfer of the priority right by agreement (referring decision, Reasons, point 38).

87. A decision of the [Court of Appeal of the Hague in the case Biogen/Genentech v Celltrion of 30 July 2019](#) quoted in the referring decision (Reasons, point 36) applied the EPC as the *lex loci protectionis* for the assessment of the validity of a priority claim. From the perspective of the EPC, the legislation of the EPC and related international treaties, such as the Paris Convention and the PCT, is autonomous.

88. It has often been discussed whether [Article 60\(3\) EPC](#) could be applied by analogy to the “right of priority” addressed in [Article 87\(1\) EPC](#). Such application by analogy would result in a legal fiction (for the purposes of the proceedings before the EPO) that the subsequent applicant is deemed to be entitled to exercise the “right of priority” if the formal requirements are fulfilled. The main argument supporting such application by analogy was that the difficulties related to an assessment of the title to the application by the EPO (applicability of national laws, lack of conflict of laws rules etc.) would apply equally to the assessment of entitlement to priority. This argument in favour of an application of [Article 60\(3\) EPC](#) by analogy is of course not pertinent if entitlement to priority is assessed exclusively under the autonomous law of the EPC.

89. It is undisputed that [Article 60\(3\) EPC](#) is not directly applicable to disputes about the transfer of the “right of priority”. In a codified system that has adopted the principles set forth in Articles 31 and 32 of the Vienna Convention on the Law of Treaties, a judge can establish rules going beyond the literal meaning of a legal provision (whether by analogy or otherwise) only if there is a lacuna in the law, in particular where situations arise for which the legislator has omitted to provide (see [G 1/97](#), OJ EPO 2000, 322, Reasons, point 3(b)). If the legislator did not want to include a provision for certain situations, there is no lacuna to fill (see [G 2/04](#), OJ EPO 2005, 549, Reasons, point 2.1.2; see also Schachenmann, Die Methoden der Rechtsfindung der Großen Beschwerdekammer, GRUR Int. 2008, 702,

section IV). As has been shown by many contributors to the discussions in the present referral, the drafters of the EPC did consider that disputes about the entitlement to priority could arise (e.g. by discussing whether subsequent applicants should be obliged to file specific evidence of their right to claim priority). The Enlarged Board thus concludes that the drafters intentionally left open the question of the EPO's competence to decide on the priority entitlement. Consequently, there is no lacuna in this respect that could be filled by an application by analogy of Article 60(3) EPC.

90. Another argument invoked by many stakeholders against the EPO's competence to assess entitlement to priority is the separation of powers between national courts and the EPO enshrined in Article 60(3) EPC, which avoids the need for the EPO to apply national laws (see e.g. Breimi, A New Approach to Priority Entitlement: Time for Another Resolving EPO Decision, GRUR Int. 2018, 128, 130). Such separation of powers can be respected even when the EPO is competent to assess priority entitlement if a clear distinction is made between, on the one hand, the priority right and its transfer as a matter governed by the autonomous law of the EPC and assessed by the EPO, and, on the other hand, the title to the subsequent application and its transfer, which is governed by national laws and assessed by national courts.

91. Furthermore, acknowledging the EPO's competence to assess priority entitlement respects the argument that the EPO, in view of Article 87(1) EPC, has to assess all aspects of the right of priority and that no distinction should be made between the "where", "what" and "when" requirements on the one hand and the "who" requirement on the other hand (T 844/18, Reasons, points 12 to 20). If all four requirements relevant under Article 87(1) EPC are assessed by the EPO, the EPO is competent for all aspects that may be relevant to determine the prior art, enabling it to assess all aspects of patentability. In contrast, national courts would remain competent to assess entitlement to the patent application or patent without getting involved in any questions related to patentability.

92. Even if the "who" requirement underlying Article 87(1) EPC is related to entitlement issues, it is clearly a criterion relevant for the validity of the patent based on the subsequent application since it is relevant for the delimitation of the prior art. Entitlement may be relevant in other contexts of prior art determination, e.g. where it is disputed whether certain information or use of items was made available to the public in the terms of Article 54(2) EPC. If the EPO can assess all aspects of the determination of prior art, the EPO's finding on patentability is based on a comprehensive assessment. If the EPO was barred from assessing priority entitlement, situations could arise in which the EPO has evidence potentially affecting the patentability of an invention but cannot use such evidence in its decision on patentability. Disputes on the entitlement to the patent, on the other hand, do not affect the EPO's findings on the patentability of the invention and the evidence and

assessments underlying such findings, such as the EPO's determination of the relevant prior art.

National and autonomous considerations on the succession under Article 87(1) EPC

Priority entitlement and contractual succession assessed under national laws / by national courts

93. Agreements under which the subsequent applicant acquires the title to the subsequent application and the right of priority usually fail to distinguish between the two rights. For example, most employment agreements under which inventors who filed the priority application assign their rights to a subsequent applicant describe the object of the assignment in a very generic way (e.g. "any and all rights related to the invention in any jurisdiction"). The agreement quoted in T 1201/14 (Reasons, point 3.2.1.1) refers to "the entire right, title and interest throughout the world in and to the invention" and adds "including ... the right to claim priority based on the filing date of the [priority application]". Such clause could be read as distinguishing between the title to the subsequent European application ("title ... throughout the world") and the right to claim priority based on the earlier US application. However, such specific references to the priority right are rare, particularly in employment agreements which are often the basis for the transfer of the right to the patents and of the respective priority rights.

94. In a decision of 2018, the German Federal Court of Justice (Bundesgerichtshof, BGH, case X ZR 14/17 – Drahtloses Kommunikationsnetz) analysed the differing views on the nature of the priority right in different Contracting States of the EPO: German literature and jurisprudence, on the one hand, consider the priority right to be an independent property right that may be assigned from the applicant of the priority application to a third party as its successor in title. In the English jurisprudence, on the other hand, the person having the rights to the invention is considered to be the "successor in title" for the purposes of the priority right (point 62). The German Federal Court of Justice concluded, however, that both views led to the same result in cases where, after the filing of the priority application, the title to the invention is transferred from the applicant of the priority application to the applicant of the subsequent application since the transfer agreement for the subsequent application regularly has to be interpreted in a way that it tacitly encompasses the right to claim priority for the subsequent application (point 63).

95. In the treaty of Bodenhausen on the Paris Convention (above point 30, see p. 37) and in an amicus curiae brief (IP Federation), reference was made to a French decision of 1962 (TGI Valence of 16 February 1962, Ann. 1963, 313-328). This decision found that the priority right is not an independent right which can be assigned on its own but a right that can only be assigned simultaneously with the right for the assignee to file a patent application in another country. In one of the English decisions referred to in "Drahtloses Kommunikationsnetz", the court held that the

“successor in title” in Article 4A(1) Paris Convention must mean successor in title to the invention (High Court of Justice of England and Wales, *Edwards v Cook* [2009] EWHC 1304 (Pat), point 93). The High Court of Justice of England and Wales later held that “[u]sually the right to claim priority goes with the right to the invention” (High Court of Justice of England and Wales (*Accord v RCT* [2017] EWHC 2711 (Ch), point 75).

96. Also national statutes implementing Article 4(1) Paris Convention appear to be based on the assumption that the acquisition of the title to the subsequent application automatically entitles the respective applicant to claim priority (see Article 18(2) Swiss Patent Act: “The right of priority may be claimed by the first applicant or the person who has acquired the right belonging to the first applicant to file a patent application in Switzerland for the same invention.”). Other Contracting States of the EPC have not adapted their national laws to the 1911 amendment of the Paris Convention (above point 30); the “successor in title” is still missing from e.g. § 41 of the German Patent Act and Article 9 of the Dutch Patent Act).

97. Thus, it may be concluded that within Europe there are differing views on the relevance of the “right of priority” addressed in Article 87(1) EPC as a property right separate from the title to the subsequent application for which the priority is claimed. There is a widespread view that the priority right is a mere ancillary right to the right to the subsequent patent application or patent which automatically follows any transfer of the title to the patent application or patent or, depending on the jurisdiction, that the title to the subsequent application automatically implies priority entitlement. These views however do not consider the possibility that the title to the subsequent application has not been acquired from the priority applicant (see above the figure in point 74). They also do not sufficiently reflect the fact that the priority applicant does not just transfer a right but needs also to provide active support to the subsequent applicant wishing to benefit from this right.

98. Such disregard for the priority right or its interpretation as a mere ancillary right to the right to the subsequent application may however partly explain why the priority right is rarely addressed in agreements on the transfer of the patent right. If a priority right is tacitly transferred together with the right to the corresponding patent or patent application, it may be assumed that the same conditions and formal requirements apply to the transfer of both rights. If a transfer of a priority right is not considered necessary in view of the priority entitlement, there cannot be any formal requirements for such transfer. In any case, the Enlarged Board is not aware of national statutes or case law setting higher formal requirements for the transfer of the priority right than for the transfer of the right to the patent application.

Consequences for the autonomous assessment of transfers of priority rights

99. In most jurisdictions, rights to obtain a patent can be transferred without any written agreement or other formalities (e.g. from an employee inventor to the employer who wishes to obtain patent protection in

multiple territories). The right to priority automatically follows the title to the subsequent patent application in many jurisdictions and may thus also be transferred informally. If national laws establish low or no formal requirements for the transfer of priority rights, the autonomous law of the EPC should not establish higher formal requirements than those established under national laws that may be relevant in the context of a European application. To the contrary, the EPO should adapt itself to the lowest standards established under national laws and accept informal or tacit transfers of priority rights under almost any circumstances.

100. For example, the autonomous law of the EPC should not require that the assignment of priority rights has to be in writing and/or has to be signed by or on behalf of the parties to the transaction (see above point 69 for the diverging case law on this issue) since this would establish a high threshold in view of the national laws. Even the requirement that the transfer of the right of priority needs to be concluded before the filing of the subsequent European patent application (above point 68) is questionable in the Enlarged Board’s view. If there are jurisdictions that allow an ex post (“nunc pro tunc”) transfer of priority rights (see the extensive discussion of such transfers under US law in T 1201/14), the EPO should not apply higher standards. The “rigour of the rule” that the transfer must be completed before the filing of the subsequent application underwent a “significant softening” also in a 2017 decision of the High Court of Justice of England and Wales (see above point 73). However, the allowability of a retroactive transfer of priority rights may have limited practical relevance if priority entitlement is presumed to exist on the date on which priority is claimed for the subsequent European application (see below point 109).

Rebuttable presumption of entitlement to claim priority

101. Low standards for a valid transfer of priority rights not only serve the purpose of harmonisation with national laws that could be applicable instead of the autonomous law of the EPC. They serve the purpose of priority rights, namely to facilitate international patent protection, by reducing the risk that the inventors’ (or their legal successors’) interest in obtaining patent protection in multiple jurisdictions is jeopardised by formal requirements they may inadvertently fail to meet.

102. Any party transferring the right to a subsequent application wishes, under normal circumstances, that the subsequent applicant may benefit from the priority right. The Enlarged Board agrees with respondent I in that it is difficult to imagine a realistic scenario in which a party would transfer their rights to the invention but intentionally withhold the relevant priority right (see p. 8 of respondent I’s letter of 5 May 2023). This applies also in cases where the title to the subsequent application is not transferred from the priority applicant (see the figure in point 74). The title to the priority application and the title to the subsequent application originate from the same inventor who normally desires that the priority is valid for all subsequent applications. In this context, it must be assumed that the priority applicant who has not

acquired the right to the subsequent application accepts or at least tolerates the use of the priority by the subsequent applicant.

103. The content of the priority application is, in general, not published or otherwise made accessible to third parties before the expiry of the twelve-month time limit for filing subsequent applications. A copy of the priority application must be filed with the EPO within sixteen months after the filing of the priority application under Rule 53(1) EPC while the publication of the priority application normally occurs eighteen months after its filing date. Moreover, the applicant of the subsequent European application must provide documentation that cannot normally be obtained without the cooperation of the priority applicant. In particular, a copy of the priority application certified as correct by the authority where the priority application was filed, must be filed with the EPO (Rule 53(1) EPC, see also Article 4D(1) Paris Convention).

104. These formal requirements for claiming priority in accordance with Article 88(1) EPC can only be met by the subsequent applicant if the priority applicant provides the necessary support completely and in time. The fulfilment of these requirements can thus be seen as strong factual evidence of the priority applicant's approval of the subsequent applicant's entitlement to priority.

105. The Enlarged Board comes to the conclusion that entitlement to priority should in principle be presumed to exist to the benefit of the subsequent applicant of the European patent application if the applicant claims priority in accordance with Article 88(1) EPC and the corresponding Implementing Regulations. This conclusion is reached taking into account (i) that the priority applicant or its legal predecessor must under normal circumstances be presumed to accept the subsequent applicant's reliance on the priority right, (ii) the lack of formal requirements for the transfer of priority rights and (iii) the necessary cooperation of the priority applicant with the subsequent applicant in order to allow the latter to rely on the priority right.

106. The presumption also applies if the title to the subsequent application has not been acquired from the priority applicant but from a third party having the right to the invention in the respective territory (for example, from the inventor, see above the figure in point 74). Also in this situation, the priority applicant must provide the necessary support under Article 88(1) EPC, and the common predecessor with respect to the title to the two applications must be deemed to consent to the subsequent applicant's reliance on the priority right like any priority applicant assigning the title to the subsequent application.

107. The considerations leading to the presumption of priority entitlement apply to any case in which the subsequent applicant is not identical with the priority applicant but receives the support of the priority applicant required under Article 88(1) EPC. It does not matter whether the subsequent European application stems from a PCT application. It is also not relevant

whether and to which extent the members of a plurality of co-applicants for the priority application overlap with the group of co-applicants for the subsequent application.

108. The presumption should be rebuttable since in rare exceptional cases the priority applicant may have legitimate reasons not to allow the subsequent applicant to rely on the priority. Such circumstances could, for example, be related to bad faith behaviour on the side of the subsequent applicant or to the outcome of other proceedings such as litigation before national courts about the title to the subsequent application.

109. Priority entitlement is not relevant before the priority is claimed by the subsequent applicant in accordance with Rule 52 EPC, normally at the filing date of the subsequent application or otherwise within sixteen months from the filing date of the priority application. Consequently, the presumption of entitlement exists on the date on which the priority is claimed and the rebuttal of the presumption must also relate to this date. Later developments cannot affect the rebuttable presumption.

110. The rebuttable presumption involves the reversal of the burden of proof, i.e. the party challenging the subsequent applicant's entitlement to priority has to prove that this entitlement is missing. If there is a strong presumption, the hurdle for rebutting it is higher than in the case of a weak presumption (see T 63/06, Reasons, point 3.2 for the rebuttal of the presumption of sufficiency of disclosure). The presumption that the subsequent applicant is entitled to the priority right is a strong presumption under normal circumstances since the other priority requirements (which establish the basis for the presumption of priority entitlement) can usually only be fulfilled with the consent and even cooperation of the priority applicant (see above points 104 ff). The party challenging the entitlement to priority can thus not just raise speculative doubts but must demonstrate that specific facts support serious doubts about the subsequent applicant's entitlement to priority.

111. Like the priority entitlement in general (see above points 85 f), the presumption of its existence and the rebuttal of this presumption is subject to the autonomous law of the EPC only. Consequently, there is no room for the application of national laws on legal presumptions and their rebuttal.

Specific arguments forwarded during the referral proceedings in the context of question I

Legal certainty and uniform legal situation in the designated Contracting States

112. The Enlarged Board has come to the conclusion that the EPO is competent to assess priority entitlement and that a rebuttable presumption in favour of the applicant's entitlement to priority is justified in view of the purpose of the priority rights, the lack of formal requirements for the transfer of priority rights and the presumed common interest of the priority applicant and the subsequent applicant (who have to cooperate when the priority is invoked).

113. In the context of priority entitlement, the requirement of legal certainty would be best served if third parties could easily, based on publicly available

data, assess whether the subsequent applicant is the successor in title addressed in Article 87(1) EPC. This assessment is difficult for third parties already because the relevant documents are normally non-public and in the possession of the applicant or patent proprietor only. The rebuttable presumption of priority entitlement serves the purpose of legal certainty insofar as the applicant or patent proprietor as well as third parties can or should rely on the subsequent applicant's entitlement to priority unless specific facts support serious doubts about such entitlement.

114. The requirements of legal certainty and fairness in the individual case may conflict, and it may be argued that the presumption of a priority entitlement that is unjustified in a specific case disadvantages third parties, i.e. potential opponents. In this context it should be considered that even if a "wrong applicant" claims priority for its subsequent application, this does not necessarily mean that the priority right cannot be relied on. In national proceedings concerning the title to the subsequent application or the priority application, the priority entitlement issue can be resolved, for example if the outcome of such national proceedings is that the priority applicant and the subsequent applicant are found to be identical. In this context, it may be noted that the EPC explicitly foresees the *ex tunc* assignment of priority rights, at least in the context of disputes on the right to the patent before national courts: if a person other than the original applicant is found to be entitled to the grant of the European patent, this person may choose to file a new European patent application in respect of the same invention under Article 61(1)(b) EPC. To such new applications, Article 76(1) EPC "shall apply *mutatis mutandis*" according to Article 61(2) EPC. Under Article 76(1) EPC, "[t]he divisional application shall be deemed to have been filed on the date of filing of the earlier application and shall enjoy any right of priority". This means that the new application filed by the rightful applicant under Article 61(1)(b) EPC is deemed to have been filed on the date of filing of the earlier application and to have the benefit of any right of priority (G 3/92, OJ EPO 1994, 607, Reasons, point 5.4). In view of legal certainty, it should thus be considered that there is always a party who is entitled to claim priority – even if this party must be determined in national proceedings.

Consequently, third parties can never fully rely on the invalidity of a priority and on the potential invalidity of a patent which may result from such lack of priority entitlement.

115. The EPO's competence to assess priority entitlement does of course not imply that national courts are bound by the EPO's assessments. In national proceedings concerning the validity of a European patent, relevant priority rights can be assessed taking into account all aspects, i.e. not only in view of the "same invention" criterion but also with respect to priority entitlement. A uniform legal situation in all designated Contracting States can therefore never be guaranteed. However, challenges to priority entitlement before national courts are subject to national restrictions

(such as rules affecting the right of third parties to challenge entitlement to priority) – regardless of how the EPO assesses priority entitlement.

Interest of third parties to challenge entitlement to priority

116. Unlike disputes on the title to the patent application, in which normally only the applicant and other parties claiming rights to the invention are involved, challenges to the entitlement to claim priority are usually instituted by third parties, in particular by opponents. It has been argued that in a situation where the priority applicant and the subsequent applicant are in "perfect all-time agreement" on the transfer of the priority right, it was absurd that the priority could be declared invalid and a patent be revoked as a consequence (Bremi, A New Approach to Priority Entitlement: Time for Another Resolving EPO Decision, GRUR Int. 2018, 128, 131). The question whether there can be a public interest in allowing a third party to invalidate patents based on legal flaws related to the entitlement to priority arises both in proceedings before national courts and in proceedings before the EPO. In a decision of the High Court of Justice of England and Wales (Accord v RCT [2017] EWHC 2711 (Ch)), it was held that there was "no obvious public interest in striking down patents on this ground, unlike all the other grounds of invalidity" (point 77).

117. It is a matter of national law whether national courts should acknowledge a legitimate interest of a third party to obtain a decision on who is entitled to claim priority under Article 87(1) EPC. In the EPC however, there are no restrictions on who can file an opposition. If the EPO is competent to assess all aspects of priority (above point 91) together with all patentability requirements *ex officio* in examination proceedings or on the request of an opponent, the EPO cannot refuse to assess a priority entitlement objection based on who raised the objection. The rebuttable presumption concerning priority entitlement however substantially limits the possibility of third parties, including opponents, to successfully challenge priority entitlement.

Entitlement to priority in the context of PCT applications

The "PCT joint applicants approach"

118. The PCT joint applicants approach implies that in a PCT application where parties A and B are applicants for different designated States, both applicants may rely on the priority right derived from a priority application filed by only one of the applicants, without the need for any transfer of priority rights (above point 11). Even if the "joint applicants approach" is acknowledged for regular European patent applications (see above point 10, T 1933/12), the use of this approach for a PCT application with different applicants for different designated territories is questionable and has been questioned in the referring decision (see Reasons, points 30 to 33).

119. Under Article 118 EPC – a provision regularly quoted in support of the "joint applicants approach" –, different applicants for different designated Contracting

States shall be regarded as joint applicants or proprietors for the purposes of the proceedings before the EPO, and the patent shall be uniform for all designated States. Exceptions from the uniformity of the European patent are foreseen in Article 118 EPC and may be justified, for example, by prior rights based on national patent applications (Article 139(2) EPC).

120. The PCT does not contain a provision like Article 118 EPC, which would impose a common procedural role throughout the grant proceedings to a plurality of applicants and prescribe the uniformity of the patent for different designated territories. A PCT application, after being accorded an international filing date, has the effect of a regular national application in each designated State (Article 11(3) PCT) which is prosecuted by the respective applicant for each designated State. The examination is carried out by the patent offices of each designated territory according to its own rules. The PCT does not exclude that different priority rights exist for different designated territories, be it for material reasons (e.g. the “same invention” criterion may be interpreted differently and is dependent on the subject-matter claimed before the respective patent office), be it for formal reasons (e.g. the applicant for one territory may not be entitled to a priority right while another applicant for another territory is entitled to claim priority stemming from the same priority application).

121. However, a general decision on the viability of the PCT joint applicants approach is not needed. The concept of an implied agreement (below points 122 ff) should allow an assessment leading to the same result as the PCT joint applicants approach in most cases.

The concept of an implied agreement

122. Where no formal requirements for the transfer of priority rights exist, priority rights can be transferred under an informal or implicit agreement (see the German case referred to above in point 72, where an implicit agreement was found to be sufficient to acknowledge priority entitlement). In the situation addressed in question II, the priority applicant (party A) actively presents itself together with the other subsequent applicant (party B) as an applicant to the office where the subsequent application is filed. Together they claim priority from the priority application of party A to the benefit of both parties. Even if the subsequent PCT application may be filed by a joint representative, the priority applicant should know about the details of this application and the related proceedings, including the claiming of priority that also benefits its co-applicant.

123. The Enlarged Board concurs with the referring board in that in the circumstances described in question II, the mutual filing demonstrates – absent indications to the contrary – the existence of an implicit agreement between party A and party B, conferring party B the right to benefit from the priority for the EPC territory (referring decision, Reasons, point 38).

124. The joint filing of the PCT application cannot in every case establish final proof of the existence of an implied agreement. However, under normal circumstances it can be assumed that the priority

applicant and co-applicant for the subsequent application (party A) agrees that the subsequent application should take the full benefit of the priority for all applicants. Party A or its predecessors (including the inventor) normally have a common interest with party B in the validity of the priority for all territories encompassed by the subsequent PCT application.

125. The Enlarged Board concludes that, in the absence of clear indications to the contrary, the joint filing of the subsequent PCT application sufficiently proves that the parties entered into an implied agreement allowing party B to rely on the priority right established by the filing of the priority application by party A. Since the considerations leading to this conclusion not only apply in the context of PCT applications, the concept and the conditions for an implied agreement equally apply to co-applicants directly filing a subsequent European application if at least one of the co-applicants was an applicant for the priority application.

126. To put into question the implied agreement, evidence would be needed that an agreement on the use of the priority right has not been reached or is fundamentally flawed. For example, party B could act in bad faith to the detriment of party A who may then not be fully informed about the subsequent PCT application. A dispute between the parties at the relevant filing date was mentioned in an amicus curiae brief (efpia) as a further example (point 3.2). Factual indications putting into question the implied agreement have to be of a substantial nature and have to be presented by the party questioning the implied agreement. The implied agreement is to be assessed under the autonomous law of the EPC, which does not foresee any formal requirements for the transfer of priority rights (above point 86). Assessing the existence of an implied agreement under the autonomous law of the EPC is consistent with the approach chosen for the rebuttable presumption for the priority entitlement (above point 86) and appropriate in view of the object of the implied agreement, which is governed by the EPC and the Paris Convention only.

127. Transfers of private rights and underlying agreements are normally subject to national civil laws, but there are instances where the EPC regulates aspects of national civil laws in order to establish uniform standards (see e.g. Article 72 EPC on the form of the assignment of a European patent application or the development of an autonomous concept of universal succession in T 2357/12). In this context, it is justified in the Enlarged Board’s view to consider the agreement implied by the joint filing of a subsequent application to be an agreement governed only by the autonomous law of the EPC.

128. An agreement (regardless of its form) can only be held against parties who were involved in the facts establishing the agreement. Co-applicants for the priority application who were not involved in the subsequent application may not be deemed to have consented to the reliance on the priority right by the other co-applicants for the priority application (a situation underlying e.g. T 844/18). The subsequent

applicant(s) may however still be entitled to claim priority since the rebuttable presumption of entitlement does not depend on whether the involved applicants acted as co-applicants at any stage.

Implications for the referred questions

Question 1 – Competence of the EPO to assess priority entitlement

129. The subsequent applicant wishing to file a European patent application should not only hold the title to that European application (i.e. the right to the European patent) but also the priority right if such right is claimed for the European application. In the context of the EPC and the proceedings before the EPO, a strict distinction should be made between the two rights. The title to the subsequent application, on the one hand, is subject to national property laws. Its transfer is governed by national laws (to be determined in accordance with national conflict of laws rules) and assessed by national courts in view of Article 60(3) EPC (above points 79 ff). The right to claim the priority date for the subsequent European application, on the other hand, has been shown to be a right created under the autonomous law of the EPC and the Paris Convention, the transfer of which should also be assessed under the autonomous law of the EPC (above points 83 ff).

130. The exclusive application of the autonomous law of the EPC to the transfer of priority rights removes the need for conflict of laws rules and the application of national laws, thereby eliminating two main reasons invoked against the EPO's competence to assess whether a party is entitled to claim priority under [Article 87\(1\) EPC](#). After evaluating various arguments supporting and denying this competence of the EPO (above points 83 ff, 93 ff), the Enlarged Board concludes that the EPO is competent to assess priority entitlement.

131. In view of the interests of the parties involved, the lack of formal requirements for the transfer of priority rights and the necessary cooperation between the priority applicant and the subsequent applicant in the context of the procedural requirements under Article 88(1) EPC, the Enlarged Board concludes that the entitlement to priority should be presumed to exist. This presumption should be rebuttable to take into account rare exceptional cases in which the claiming of the priority by the subsequent applicant appears to be unjustified (above points 101 ff).

132. If the requirements under [Article 88\(1\) EPC](#) are not fulfilled, the subsequent applicant is barred from claiming priority for this reason alone. The fulfilment of these procedural requirements is not covered by the rebuttable presumption. This is reflected in the order where compliance with Article 88(1) EPC and the corresponding Implementing Regulations is set as a condition for the rebuttable presumption of priority entitlement. The referral is not addressing any aspect of how these procedural requirements are addressed by the EPO.

133. Like the nature and the effects of the priority right and the entitlement to priority, the rebuttable presumption in favour of the priority entitlement is subject to the autonomous law of the EPC. It cannot be

excluded, however, that in the context of the rebuttal of the presumption national laws need to be considered as well. For example, the existence of legal entities being parties in transfers of priority rights may be relevant and may need an assessment under national laws.

Question 2 – Priority entitlement in the situation addressed in question II

134. Question II addresses a specific situation in which the EPO has to assess priority entitlement (given the positive answer to question I). The question concerns a group of cases where an applicant other than the priority applicant wishes to rely on the priority right for a subsequent application jointly filed by both applicants. The considerations leading to the rebuttable presumption of priority entitlement apply regardless of whether the subsequent application is a PCT application and in any case where the priority applicant (as an individual or a group) is not identical with the subsequent applicant(s) (above points 101 ff, 107). The rebuttable presumption that the subsequent applicant is entitled to rely on the priority right derived from the priority application therefore fully applies to the situation addressed in question II.

135. For the situation addressed in question II, it has been proposed to extend the acknowledged “joint applicants approach” to a “PCT joint applicants approach” which has been questioned in the referring decision and by the Enlarged Board (above points 118 ff). As an alternative reasoning for a positive answer to question II, the concept of an implied agreement has been proposed not only by the referring board but also in certain amicus curiae briefs. The Enlarged Board concurs with the referring board in that in the circumstances described in question II, the mutual filing demonstrates – absent indications to the contrary – the existence of an implicit agreement between party A and party B, conferring party B the right to benefit from the priority for the EPC territory (referring decision, Reasons, point 38).

136. The Enlarged Board leaves open the validity of the “PCT joint applicants approach” but endorses the concept of an implied agreement. It therefore concludes that, in the absence of substantial factual indications to the contrary, the joint filing of the subsequent PCT application sufficiently proves that the parties entered into an implied or informal agreement allowing party B to rely on the priority right established by the filing of the priority application by party A.

137. An agreement cannot be implied if not all of a plurality of priority applicants are applicants or co-applicants for the subsequent application (the situation underlying e.g. T 844/18, above point 128). However, the rebuttable presumption of priority entitlement can be applied also in situations where one of the priority applicants is not involved in the filing of the subsequent application. In specific contexts, a priority applicant missing from the subsequent application may have reasons to claim the title to the subsequent application (in proceedings before national courts) or may possess evidence to rebut the presumption of priority entitlement in proceedings before the EPO.

138. The interpretation of a joint filing as sufficient proof for an implied agreement on the joint use of the priority right in the context of a joint PCT application may apply independently from the rebuttable presumption addressed in connection with referred question I. An implied agreement in the situation addressed in question II can however reinforce the presumption of entitlement to priority stipulated in view of referred question I.

ORDER

For these reasons, it is decided that the questions of law referred to the Enlarged Board of Appeal are answered as follows:

I. The European Patent Office is competent to assess whether a party is entitled to claim priority under Article 87(1) EPC.

There is a rebuttable presumption under the autonomous law of the EPC that the applicant claiming priority in accordance with Article 88(1) EPC and the corresponding Implementing Regulations is entitled to claim priority.

II. The rebuttable presumption also applies in situations where the European patent application derives from a PCT application and/or where the priority applicant(s) are not identical with the subsequent applicant(s).

In a situation where a PCT application is jointly filed by parties A and B, (i) designating party A for one or more designated States and party B for one or more other designated States, and (ii) claiming priority from an earlier patent application designating party A as the applicant, the joint filing implies an agreement between parties A and B allowing party B to rely on the priority, unless there are substantial factual indications to the contrary.
