

# Poisonous Priorities

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Reddie & Grose

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# Prior Art and Novelty

- a patentable invention must be, *inter alia*, novel to be valid (PA 77 s 1(1))
- novel if no prior art (PA 77 s 2(1) / (2))
  - *Synthon v SmithKline Beecham* [2006] RPC 10
  - enabling disclosure
- a claim lacks novelty if any embodiment within the claim is anticipated

# Novelty in respect of unpublished applications

- **PA 77 s 2(3) / EPC as 54(3) & 87-89: the prior art also includes other unpublished applications if:**
  - the priority date of the other application is earlier, and
  - the relevant subject matter is contained in both the application as filed and as subsequently published
- **avoids two patents for the same invention**

# Priority

- a patent may claim an earlier priority date than its filing date if it is “supported by matter disclosed” in the priority document (PA 77 s 5(2)(a))
- must be for the “same invention” / “same subject matter” (EPC a 87(1)/(4), PA 77 s 130(7))
  - *G02/98 X/Same Invention* [2002] EPOR 167
  - if a skilled person can derive the subject matter of the claim directly and unambiguously, using CGK, from the previous application as a whole
  - interpreted narrowly (metal / Cu tool): to be entitled, the whole scope of the claim must be entitled to priority

# Partial Priorities

- it is possible to ascribe different priority dates to different parts of a claim where those parts represent a limited number of clearly defined alternative subject matters (*Novartis v Johnson & Johnson Medical* [2009] EWHC 1671 (Pat) at [122]) (emphasis added)
- this may be done even if the claim has adopted a generic term to describe and encompass those alternatives

## Poisonous Divisional

- **T-1496/11 *Self-verifying Security Documents* [section 3]**
- **a latter application with a broader feature is not entitled to the priority of the earlier application**
- **a subsequent divisional application with both specific and broad features might then anticipate its own parent**

# Poisonous Priority Document

- *Nestec v Dualit* [2013] RPC 32
- a latter application with a broader feature is not entitled to the priority of the earlier application
- as the broader feature did not comprise clearly defined alternative subject-matters, it could not be ascribe different priority dates to different parts [96]
- therefore, priority document was novelty destroying [111]

# Potential Solution

- based upon:
  - concept of partial priorities, and
  - imaginary claim splitting
- either two claims or one claim divided hypothetically:
  - earlier narrow matter alone
  - subsequent wider matter minus earlier matter
- earlier narrow matter entitled to priority, and so fine
- other wider matter, not so entitled, but not anticipated, and so fine



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- MA (Natural Sciences) (Cantab), DPhil (Biophysics) (Oxon)
- all areas of IP law and practice, in particular patents, trade marks, copyright and designs. 100 reported cases since 2000, of which two thirds were appeals or judicial reviews.
- appeared often before the CJEU and the GC (Luxembourg) in appeals from OHIM and Article 267 references (over 40 cases), and in the EPO (Legal and Technical BoA and Opposition Division).
- acted for the UK government, Comptroller-General of Patents, Registrar of Trade Marks, CIPA, ITMA and AIPPI UK.