



# **T 1201/14: The Importance of Validly Claiming Priority**

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## ■ According to EPC Article 87(1):

- “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 Organization, an application for a patent, a utility model or a utility certificated, 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.)

# Facts

- European Patent No. 1883190 B1, issued from an application filed by Innovative Sonic Limited (“Patentee”), and claimed priority from a U.S. provisional application filed under the name of a sole inventor (i.e., not filed by Patentee).
- During the Opposition Proceedings, the issue under dispute was whether Patentee was entitled, as a “successor in title”, to the right of priority to the U.S. provisional application.
- The right of priority was critical to Patentee because of a public disclosure during the priority year before the filing of the EP application.

# Facts (cont'd)

- Patentee claimed that two assignments took place:
  - First: from the inventor to ASUSTek Computer Inc.;
  - Second: from ASUSTek to Patentee.
- The Opposition Division (“OD”) did not accept the validity of the second transfer.
  - The language “for the purpose of filing” in Art 87(1) EPC requires the transfer of the right of priority to occur prior to the convention filing; and Patentee was relying on a back-dated assignment.
  - Patentee’s arguments that the second transfer is valid under other national laws were also rejected.
- Therefore, the OD held Patentee could not prove that it was “successor in title” to the right to claim priority. As a result, the OD decided to revoke the patent on the grounds of lacking novelty.

# T1201/14

- According to the Board, the substantive requirements for a transfer of the right of priority:
  - The successor in title with respect to the right to claim priority from a first application must prove that it indeed owned
    - before the filing of the later European application,
    - the right of priority relating to the first application for the purpose of filing the later European application claiming that priority.

# T1201/14

- According to the Board, regarding the formal requirements for a transfer of the right or priority, national laws have been relied on:
  - the law of the country where the first application was filed
  - the law of the country where the later application was filed
  - the law of the country which is agreed upon in the relevant contract
  - the law of the country where at least one of the parties to the transfer has its residence.

# T1201/14

Patentee argued:

- ❑ The priority application was filed in the U.S., and US law allows for retrospective assignments of the right to priority.
- ❑ Germany is a designated member state and German law does not require an assignment to be in writing. An implicit transfer took place by virtue of a general policy that all IP relating to telecommunication standards should be transferred from ASUSTek to Patentee.
- ❑ Taiwan is the residence country of the Assignor, and Taiwanese law does not require an assignment to be in writing. In addition, Taiwanese law does not differentiate the right of priority and the right to file a later application claiming that priority.
- ❑ A direct transfer by virtue of the transfer of "all rights" for a separate application which claimed priority from the same priority document.

# T1201/14

The Board held:

- US law: not compatible with EP case law and Art 87(1) requiring the assignment to conclude prior to the filing of the convention application - a substantive requirement irrespective of which national law governed the formal aspects of the assignment.
- German & Taiwanese laws: Implicit or oral contract may be sufficient for a timely transfer, but the evidence was insufficient to establish "beyond reasonable doubt" that an implicit transfer had occurred before the filing date.
  - "beyond reasonable doubt", not "balance of probabilities".
  - Patentee's arguments relied on internal documents only in Patentee's possession; and additionally, the "general policy" which Patentee claimed to be in place was not always complied with in all filings.
- Right of priority and right to file a later application claiming that priority: the Board considered these to be separate rights, and emphasized that the EPC imposes a requirement for a specific transfer of the right of priority.
- "Direct transfer" concerned a different application thus insufficient to establish transfer of the right of priority derived from the priority application.