I. Summary of Facts and Submissions

1 European patent 2 771 468 having the title "ENGINEERING OF SYSTEMS, METHODS AND OPTIMIZED GUIDE COMPOSITIONS FOR SEQUENCE MANIPULATION" is based upon European patent application No. 13 818 570.7 and the PCT application, PCT/US13/74819, filed on 12-12-2013. It claims priority from twelve provisional applications (P1-P12).

2 The priority documents are:

P1: 61/736527P 12.12.2012;

P2: 61/748427P 02.01.2013;

P3: 61/758468P 30.01.2013;

P4: 61/769046P 25.02.2013;

P5: 61/791409P 15.03.2013;

P6: 61/802174P 15.03.2013;

P7: 61/806375P 28.03.2013;

P8: 61/814263P 20.04.2013;

P9: 61/819803P 06.05.2013;

P10:61/828130P 28.05.2013;

P11:61/835931P 17.06.2013; &

P12:61/836127P 17.06.2013

3 For P1 and P2: Mr. Zhang; Mr. Cong; Mr. Hsu; Mr. Ran; Mr. Habib, Mr. Cox, Mr. Lin and Mr. Maraffini were indicated as inventors/applicants.

For P5: Mr. Zhang; Mr. Cong; Mr. Hsu; Mr. Ran; Mr. Habib, Mr. Cox, Mr. Lin; Mr. Maraffini, Mr. Bikard and Mr. Jian were indicated as inventors/applicants.

For P11: Mr. Zhang; Mr. Cong; Mr. Hsu; Mr. Ran; Mr. Cox, Mr. Lin; Mr. Maraffini, Mr. Platt, Mr. Sanjana, Mr. Bikard and Mr. Jian were indicated as inventors/applicants.

For P3, P4 and P12: Mr. Zhang; Mr. Cong; Mr. Hsu and Mr. Ran were indicated as inventors/applicants.

For P6 to P10: Mr. Zhang; Mr. Cong; Mr. Hsu, Mr. Ran and Mr. Platt were indicated as inventors/applicants.

4 The opposed patent indicated at filing the following applicants: The Broad Institute, Inc.; the Massachusetts Institute of Technology (MIT); Mr. Zhang; Mr. Cong; Mr. Hsu; Mr. Ran.

5 On 23.05.2014 a change in the indication of the applicants Mr. Zhang, Mr. Cong, Mr. Hsu and Mr. Ran in favour of the President and Fellows of Harvard College (Harvard College) was recorded according to Rule 92bis(1) PCT.

6 The mention of the grant of the patent has been published in the European Patent Bulletin of 11-02-2015. Proprietors of the patent (PP) are:
The Broad Institute, Inc.
415 Main Street
Cambridge, MA 02142
US
&
Massachusetts Institute of Technology
77 Massachusetts Avenue
Cambridge MA 02142
US
&
President and Fellows of Harvard College
17 Quincy Street
Cambridge, MA 02138
US.

7 Notices of opposition have been filed by

Opponent 1 (O1):
Schlich, George
9 St Catherine's Road
Littlehampton
Sussex BN17 5HS
GB
on 26-10-2015

Opponent 2 (O2):
Grund, Dr., Martin
Nikolaistr. 15
80802 Munich
DE
on 10-11-2015

Opponent 3 (O3):
Regimbeau
20, Rue de Chazelles
75847 Paris Cedex 17
FR
on 10-11-2015

Opponent 4 (O4):
CRISPR Therapeutics AG
Aeschenvorstadt 36
4051 Basel
CH
on 05-11-2015

Opponent 5 (O5):
Storz, Dr. Ulrich
Michalski Hüttermann & Partner Patentanwälte mbB
Speditionstrasse 21
40221 Düsseldorf
DE
on 11-11-2015

Opponent 6 (O6):
Novozymes A/S
Krogshøjvej 36
2880 Bagsværd
DK
on 11-11-2015

Opponent 7 (O7):
Boxall Intellectual Property Management Limited
Homefield
133 Woodnesborough Road
Sandwich
Kent CT13 0BA
GB
on 11-11-2015

Opponent 8 (O8):
Sagittarius Intellectual Property LLP
19-21 Chapel Street
Marlow
Buckinghamshire SL7 3HN
GB
on 11-11-2015

Opponent 9 (O9):
Adams, Harvey Vaughan John
Mathys & Squire LLP
The Shard
32 London Bridge Street
London SE1 9SG
GB
on 11-11-2015.

8 All opponents request revocation of the patent in its entirety based on Articles 54, 56, 83 and 123(2) EPC.

9 The priority claim was objected to for both lack of applicant's entitlement and lack of the same invention requirement. In respect of the lack of legal entitlement, it was objected that neither Mr Maraffini, one of the inventors-applicants named in P1 and P2, nor his successor in title, the Rockefeller University of New York (USA), did assign his right to claim priority to the applicants named on the PCT application.

10 In a letter received on 30.06.2016, the PP requested the rejection of the opposition (Article 101(2) EPC). The PP held that it is for the national law of the country of the priority application, in this case US law, to rule on the questions of what was an application for a patent in respect of the same invention, who was deemed to have filed that application, whether the application had been duly filed and who qualified as successor in title to the applicant. In particular the PP explained that the meaning of "applicant" under US law differed from the European definition. Under US law the status of applicant was defined by the contribution made by the inventor to the specific invention - that was disclosed or claimed in the application – and applicants might be added or removed during prosecution of the application, depending on amendments to the claimed subject-matter. Further, rights of priority were separable, so that an applicant of a first application only held a priority right in respect of the invention to which he had contributed.

11 On 25.07.2016, the opposition division (OD) was extended by the nomination of a legally qualified member.

12 On 31.10.2016, the PP filed a letter with a request that the EPO confirmed that neither the documents nor testimony relating to the inventorship analysis under US law were relevant for the opposition before the EPO. The cause of the PP's request was that O1 had filed a request in the United States of America for document and oral discovery of the Broad Institute and other parties.

13 With letter of 18.11.2016, O9 asked that the PP's request of 31.10.2016 be rejected because the PP themselves had put the US inventorship analysis as the basis for their priority argumentation in the present opposition case.

14 With letter of 23.12.2016, the new representative of O4 filed a number of new documents and arguments.

15 On 19.04.2017 the OD issued a summons to attend oral proceedings from 16.01.2018 to 19.01.2018. Annexed to the summons was the OD's preliminary and non-binding opinion on the patent as granted.

16 In particular, the OD was of the preliminary and non-binding opinion that:

the claims did not meet the requirements of Article 123(2) EPC;

the applicants were not legally entitled to claim priority from priority documents P1, P2, P5 and P11;

the US discovery proceedings according to 28 U.S. code §1782 actually pertained to issues of entitlement and were, per se, not relevant for the opposition before the EPO;

the subject-matter of claim 1 was not disclosed in priority documents P3, P4 and P6-P10;

the claims lacked novelty over D3 and D4 which were both published after P1 and P2, but before the remainder of the priority documents, and over D28 and D29 which were both published before P12.

With respect to novelty over D2 and D69, this would depend on whether the transfer of priority rights had taken place in D2 such that the priority was validly claimed from the first priority document, P1, which was identical in the opposed patent and in D2.

The opposed patent was preliminarily found to be novel over D16.

However, the subject-matter of claims 1 and 7-8 was disclosed in D36 which was published after P12, but before the opposed patent's filing date.

With respect to Article 56 EPC, the OD preliminarily concluded that viral vector systems were routinely employed by the skilled person at the effective filing date of the application.

With respect to Article 83 EPC, the OD preliminarily found that none of the objections by the opponents had provided any evidence substantiated by verifiable facts that it would not be possible for the skilled person to design compositions and vector systems as defined in the claims of the opposed patent.

17 With letter of 24.04.2017, O7 filed further arguments and declarations on legal entitlement to claim priority.

18 With letter of 16.10.2017, O1 filed further arguments on Article 123(2) EPC, on whether the priority applications disclosed the same invention as the opposed patent, and declarations on the legal entitlement to claim priority.

19 With letter of 13.11.2017, the PP requested that Steven Trybus be allowed to address the OD on aspects of US law.

20 With letter of 13.11.2017, O7 filed further arguments and declarations on legal entitlement to claim priority and novelty of the opposed patent over D16.

21 With letter of 16.11.2017, the PP filed further observations, documents and expert declarations. In particular, the PP argued: that O4's submission of 23.12.2016 represented a new opposition filed after the opposition period and that it should therefore not be admitted into the proceedings;

that the opposed patent met the requirements of Article 123(2) EPC;

that the applicants were legally entitled to claim priority based on interpretations of the EPC which would mean:

that the EPO was not entitled to check whether this requirement was fulfilled;

that "any person" in Article 87 EPC meant that any one person of a group of applicants was allowed to claim priority; or

that the person, who had duly filed according to Article 87 EPC, was determined by the national law of the country of filing and not by the EPO.

Moreover, the PP's letter contained further arguments with respect to inventive step in view of D1 and against a lack of reasonable expectation of success.

Finally, the PP filed 72 auxiliary requests (AR1-AR72).

22 With letter of 16.11.2017, O4 filed further declarations and observations on Article 123(2) EPC and on lack of novelty over D1 and D16.

23 With letter of 16.11.2017, O2 filed observations on Article 123(2) EPC, on legal entitlement to claim priority, on the same invention requirement and on novelty over D16.

24 With letter of 16.11.2017, O9 filed a document on NLS and observations that:

the claims did not meet the requirements of Article 123(2) EPC;

the applicants were not legally entitled to claim priority;

none of the priority documents P1-P12 disclosed the same invention as the opposed patent;

the claims lacked novelty over D16; and

the claims lacked inventive step.

25 With letter of 13.12.2017, the PP requested that a separate appealable decision be given on the issue of legal entitlement to priority, and that novelty over D2 be dealt with as the next issue during the oral proceedings if the OD did not wish to stop the oral proceedings after having concluded on legal entitlement to priority.

26 With letter of 29.12.2017, O4 filed further arguments and declarations relating to legal entitlement to priority and inventiveness of the opposed patent in view of D1, and argued against a separate appealable decision being given on legal entitlement to priority.

27 In a brief communication dated 03.01.2018, the OD indicated that it would deal first with the issue of legal entitlement to priority at the oral proceedings.

28 With letter of 15.01.2018, the PP filed further arguments and two documents D253-D254 on legal entitlement to priority.

29 With letter of 15.01.2018, O1 filed for completeness the observations by the patentee, as D255, in Board of Appeal proceedings T293/16 to which D207 related.

30 In their respective letters, O1, O3, O4, O9 and the PP requested that the issue of legal entitlement to claim priority be dealt with first during the oral proceedings.

31 On 16-01-2018, oral proceedings started. O5, O6 and O8 did not attend the oral proceedings.

During the oral proceedings, it was concluded that:

all documents submitted before the oral proceedings be admitted into the proceedings;

a document presented during the oral proceedings was not admitted into the proceedings;

the applicants of the opposed patent were not legally entitled to claim priority from P1, P2, P5 and P11; and

that the opposed patent lacked novelty over D3 and D4.

In response, the PP filed 64 of the previously filed 72 auxiliary requests as AR1-AR64. The OD decided not to admit the 64 auxiliary requests into the proceedings. The PP did not wish to file any other request and the OD decided that the opposed patent was revoked.

32 The decision is based on the patent as granted:

Description, Pages

3-69	of the patent specification

Claims, Numbers

1-17	of the patent specification

Drawings, Sheets

1/44-44/44	of the patent specification

33 The numbering of the documents (D1-D255) is as shown in the list of documents (D1-D227) filed by O1 on 24.11.2017, as numbered by O4 (D228-D252) in their letter of 29.12.2017, as numbered by the PP (D253-D254) in their letter of 15.01.2018 and in the letter from O1 filed on 15.01.2018 (D255).

II Reasons for the Decision:

II.1 Admissibility of Oppositions:

34 All of the oppositions filed within the opposition period meet the requirements of Articles 99(1) & 100 EPC and of Rules 3(1) and 76 EPC. This has not been contested by the PP. As regards O4's submission of 23.12.2016 (see paragraph below).

II.2 Procedural Decisions:

II.2.1 Admittance of documents filed before the oral proceedings:

35 Before the oral proceedings, the PP had argued that O4's submission of 23.12.2016 should not be admitted into the proceedings since it amounted to a new opposition being filed more than nine months after the mention of the grant of the opposed patent. This should not be allowed just because the representative of O4 had changed. O4 argued in writing that its submission should be seen as a reply to the PP's extensive submission filed on 30.06.2016 and that the PP's reply of 16.11.2017 contained an abusive number of auxiliary requests, documents and declarations.

36 During the oral proceedings, the opponents objected to the documents D120-D121 because they were contradicting the PP's line of argument and therefore could not be relevant. Moreover, all documents and auxiliary requests filed with the PP's reply of 16.11.2017 should be considered late filed because they were filed on the last date before the expiry of the Rule 116 EPC time limit.

37 In the letter of 16.11.2017, the PP argued that the documents D147-D150, D154-D158, D160-D161 and D166 should not be admitted into the proceedings. During oral proceedings, the PP argued in favour of admitting all documents into the proceedings in view of the importance of the outcome of the proceedings. In particular, D120-D121 were filed in support of one of the PP's lines of argumentation and therefore should be admitted even if contradicting one of the PP's present lines of argumentation.

38 The PP requested in writing that O4's submission of 23.12.2016 should not be admitted into the proceedings because it represented the filing of a fresh opposition. However, the OD finds that all opposition grounds and arguments were already submitted within the opposition period on 10.11.2015 and therefore admits O4's submission of 23.12.2016 into the proceedings.

39 The OD finds that prima facie all documents concerning entitlement to priority and filed before the oral proceedings, have been filed in reply to previous observations of the parties and therefore are all relevant. Moreover, the documents filed after the Rule 116 EPC time limit were filed long enough in advance of the oral proceedings that none of the parties could convincingly argue and did not argue that they did not have time to prepare for the discussion of the documents during the oral proceedings. With respect to the opponents' objections to the documents filed on 16.11.2017, the OD finds that these documents were filed within the Rule 116 EPC time limit and since they are relevant, because they represent support to the PP's reply to the opponents' observations, cannot be considered late-filed. Finally, the OD agrees with the PP that D120 and D121 were filed with the PP's first reply and supported the PP's line of argumentation in that reply. None of the opponents objected to the admittance of D120-D121 at that stage and they therefore entered into the proceedings at that stage already (see annex to the summons to oral proceedings). As argued by the PP, a legal provision for a later non-admittance of previously admitted documents does not appear to exist in the EPO. Thus, the OD decides to admit all documents concerning entitlement to priority and filed before the oral proceedings into the proceedings.

39.1 Admissibility of documents relevant for substantive issues were not decided upon during the oral proceedings.

II.2.2 Admittance of a document distributed during oral proceedings:

40 A document was distributed on the beginning of the second day of the oral proceedings. The PP explained that it was relevant because it showed that the Rockefeller University and Broad Institute had come to an agreement that Rockefeller had no rights to the opposed patent. The opponents objected that the document - being a Press Declaration from the PP - be admitted as it had been known to the PP days before the oral proceedings and could have been filed earlier. According to the opponents, the filing at this stage represented an abuse of procedure.

40.1 The OD finds that the PP had already explained in writing and during oral proceedings their view that the fact that Mr.Marraffini or a successor in title was not listed as applicants of the opposed patent did not represent a mistake and the document therefore did not add any information to the PP's line of argument and was not relevant for the proceedings. Therefore, the OD decided that the document was not admitted into the proceedings.

II.2.3 Should the Technical Expert announced by the PP be allowed to speak:

41 By letter of 13.11.2017, the PP had announced Steven Trybus as a Technical Expert to be heard during the oral proceedings and indicated that he was an expert in US law. The opponents argued that he should not be allowed to speak because his expertise was not relevant for the proceedings which concerned European law and because the issue on which he was characterised as an expert was too broadly defined.

42 During the oral proceedings, the OD announced that it would decide on whether Steven Trybus be allowed to speak once it was requested and it was clear on which subject the PP wished him to comment. The PP did not at any particular stage of the oral proceedings indicate an intention to hear Steven Trybus and the OD therefore did not need to decide on this question.

II.2.4 Separate Appealable Decision on Legal Entitlement to Priority:

43 The PP argued during oral proceedings and in writing that a separate appealable decision should be issued by the OD with respect to legal entitlement to priority because the further proceedings depended entirely on the interpretation of the law on legal entitlement to priority (cf Guidelines E-X 3.). The opponents (Os), in particular O4 in its letter of 29.12.2017, argued against a separate appealable decision on legal entitlement to priority since this would delay even further a decision on the merits of the case and by consequence decisions in the co-pending patents and would extend the legal uncertainty for the public. In addition, there were other objections raised against the opposed patent so that continuation of the proceedings did not depend entirely on said point-of-law.

44 The OD finds that a separate appealable decision under Article 106(2) EPC should be the exception in order to avoid fragmentation of the proceedings and should be given only if the duration or costs of the proceedings are reduced (cf Guidelines E-X 3.). Even if the PP finds that a decision on this point-in-law represents a simplification and thereby a reduction of the costs of presenting the case before the Boards of Appeal, the interests of the opponents and public in having a conclusion of the opposition proceedings, as a whole, also needs to be considered.

45 In view of the multitude of objections raised against the opposed patent, the OD is not convinced that the continuation and outcome of the opposition proceedings depend entirely on the point-of-law relating to legal entitlement of priority. Moreover, it finds that there are no conflicting decisions from different Boards of Appeal on this point-of-law and that Guidelines A-III 6.1 provide instructions on how to deal with the issue. Thus, allowing a separate appealable decision would likely not shorten the proceedings or be, otherwise, procedurally efficient. The OD therefore decided against allowing a separate appealable decision on this issue.

II.2.5 Admittance of auxiliary requests AR1-AR62 into the proceedings:

46 The PP filed AR1-AR72 before the Rule 116 time limit in preparation for the oral proceedings. In the letter accompanying the auxiliary requests it was explained that some of the ARs were filed in order to overcome objections under Article 123(2) or problems related to same invention under Article 87 EPC and some were filed in order to overcome novelty and inventive step objections.

47 Upon the OD's conclusion that the opposed patent as granted lacked novelty over D3 and D4, the PP was given time to decide with which auxiliary request to proceed. In response, the PP filed AR1-AR64 which represented a selection from the 72 auxiliary requests filed on 16.11.2017. The PP stated that none of these requests was filed with the purpose of addressing the novelty issue with respect to D3 and D4. The P added that they would not provide any comments on why these requests were novel over D3 and D4, but merely stated that they were filed with a view to appeal proceedings.

48 The Os argued that AR1-AR64 should not be admitted into the proceedings because they did not represent an attempt to overcome the novelty problem and that the auxiliary requests contained many additional clarity and Article 123(2) problems which would have to be discussed if they were admitted into the proceedings. The vast amount of 64 auxiliary requests imposed an undue burden on all parties and therefore represented an abuse of the proceedings.

49 When deciding on the admissibility of auxiliary requests in opposition proceedings, it is a requirement that the amendments are occasioned by a ground of opposition (cf Rule 80 EPC). That is to say, amendments are admissible only if they are required in order to meet a ground of opposition. As a general principle, auxiliary requests must be filed in a reasonable number, must overcome the objections raised and not introduce new ones. In the present case, the PP indicated that the auxiliary requests overcame issues relating to Article 123(2) EPC and novelty and inventive step. However, without indicating specifically how the individual requests overcame which novelty and inventive step objection.

50 The conclusion, which occasioned the examination of auxiliary requests, was the lack of novelty of the patent as granted over D3 and D4. As clearly stated by the PP during the oral proceedings, they were not going to provide any comments on why any of AR1-AR64 should be considered novel over D3 and D4 and indeed none of the 64 auxiliary requests was filed in order to overcome a novelty objection based on D3 and D4. As an example, AR1 was filed to overcome an Article 123(2) objection raised against dependent claims. In line with Guidelines H-II 3.2, the OD finds that "in the absence of any amendments submitted by the patent proprietor with a view to meeting the grounds of opposition" at issue, there is no possibility to make any other amendments addressing said grounds. The OD further finds that this is supported by T382/96, which, as cited in the Case Law book (III.I.3.1, 8th ed., p.717 of the English version), states that defining the subject-matter of a patent rests with the patent proprietor and that this responsibility cannot be offloaded by filing a multitude of requests. Doing so represents an abuse of procedure since it overburdens the EPO with work not originally theirs (see also T446/00 reasons 2.3, 4.3 and 4.5.4). In particular, in a situation where, as in the present case, the 64 requests represent a pick and mix of features present in the opposed patent (cf T745/03).

51 During the oral proceedings, the PP suggested that the auxiliary requests all be admitted into the oral proceedings and subsequently all be found not to be novel over D3 and D4 since the PP would not provide any comments why the auxiliary requests were novel in view of D3 and D4. However, this procedure would clearly not be acceptable since it is a requirement that the OD's decision contains the reasons for not allowing each of the auxiliary requests (cf Guidelines H-III 3.1.3). Moreover, the opponents have a right to comment on each of the auxiliary requests admitted into the proceedings. Thus, the admittance of 64 auxiliary requests would also pose an undue burden on the opponents.

52 The auxiliary requests AR1-AR64 which do not intend to overcome the novelty objection based on D3 and D4, therefore are not filed with the purpose of obtaining a legally valid patent. Considering this fact, the OD finds that procedural economy does not need to be balanced with the PP's interest in obtaining a legally valid patent and therefore decides that procedural economy must cause the OD not to admit the auxiliary requests into the proceedings.

II.3 Conclusions on Grounds of Opposition:

II.3.1 Novelty:

II.3.1.1 Legal Entitlement to Priority:

53 In preparation of oral proceedings, the PP partially modified his argumentation and with submission of 16.11.2017 presented 3 lines of argument, which were then discussed at the oral proceedings:

I. The EPO should have no power to assess legal entitlement to the right of priority.

II. In case of joint/multiple applicants in a first application, the meaning of the term "any person" under Article 87 EPC should be interpreted to mean "*one or some indiscriminately*" of the co-applicants.

III. The meaning of "any person who has duly filed" should be interpreted according to national law, in this case US law.

54 These perspectives were not fully addressed by the OD's preliminary opinion, as they were submitted at a later stage. The OD's preliminary opinion followed the EPO established practice and case law of the boards of appeal (BOA) in the sense that the right of priority is vested on either the applicant or his successor in title. In case of lack of applicant´s identity if the validity of the priority is questioned, evidence is required that a valid transfer of the application from which priority is claimed (or of the priority right as such) has taken place before the filing date of the later patent application. If the earlier application is filed by joint applicants, either all of them or their successor(s) in title should be amongst the joint applicants for the later application.

55 In the specific case, the PP asked the OD to "reconsider" this established practice and case law and to deviate from it.

II.3.1.1.1 What is not disputed by the parties

56 It is firstly observed that the discussion of priority and the 3 approaches suggested by the PP rely on the following common legal basis, which has not been disputed by any of the parties to the present proceedings.

57 First the EPC constitutes a special agreement within the meaning of Article 19 Paris Convention (cf. Preamble to the EPC), therefore application of its provisions cannot contradict the basic principles concerning priority laid down in the Paris Convention (PC) (cf. G 3/93, point 4 of the reasons and T 301/87, OJ EPO 1990, 335, Reasons point 7.5; J 15/80, headnote III; see also *Erster Vorentwurf*, in Grur Int. 1970, 102, point 7). This is valid even if the EPO is not formally bound by the PC. Second, the scope and purpose of the PC is to provide a mechanism as simple as possible and appropriate for applicants to obtain international protection for their invention, as well as for patent offices to assess the validity of priority claims. It was also not disputed that the question of entitlement to a patent is distinct from the question of entitlement to priority. Finally, both the PP and the Os recognised the existence of the established practice at the EPO as mentioned under point 54.

II.3.1.1.2 The PP's first line of arguments - **EPO power to assess legal entitlement to the right of priority**

58 In its first line of argument, filed in preparation of the oral proceedings, the PP submitted that the EPO should not examine the proprietor's entitlement to the right of priority, which should rather be left to the jurisdictions of the national courts. In application of the principle of the division of powers between the EPO and the contracting states, the EPO should accept entitlement to priority as validly claimed, subject to the objective assessment on the "same invention" requirement. To support his arguments, the PP relied on the preliminary communication of the BOA in T 239/16 (D207, EP05012711.7), on the Travaux Préparatoires to the EPC 1973 (BR/51/70, Minutes of the second meeting of working party I sub-committee on "implementing regulations" of 15 to 18 September) and on the legal opinions of Prof. Straus (D 199) and Prof. Torremans (D197).

59 The following reasons were submitted by the PP:

59.1 First, the assessment of the rightful owner of the priority right implies a determination of ownership of a property right, which has never been intended to be the EPO's jurisdiction. This is supported by reference to the Travaux Préparatoires to the EPC 1973 BR/51/70, in which the Sub-Committee expressed the view that it was not desirable "*to allow the EPO to require of an applicant proof of his entitlement to avail himself of priority in cases in which the applicant and the proprietor of the first application were two separate persons…*.". On account of further indications, such as the requirements for the priority declaration and the fact that the priority application is not yet published when the later European application is filed, the PP concluded that the system ensures that in principle only the applicant of the first application - or some individual connected to him - has knowledge of the priority application. Thus the system intended *the EPO to presume entitlement* of the applicant claiming priority, whereas possible fraudulent activities would more appropriately be dealt with under entitlement actions before a national court.

59.2 Second, such assessment would require the EPO to apply the national law of all of the (177) countries of the Union, with a consequent enormous burden for a patent office.

59.3 Third, a challenge to the entitlement of a priority right, as for an entitlement objection to a property right under most legal systems, should be allowed only against a person alleging himself to be the real owner, rather than against any third party (so-called question of legal standing).

59.4 Fourth, in respect of the entitlement to the right of priority within the meaning of Article 87(1) EPC, the EPO should adopt the same approach established under Article 60(1) EPC for the entitlement to a patent (application) and thus leave this assessment to the jurisdiction of national courts.

60 The OD cannot follow the approach proposed by the PP for the following reasons, some of which were also submitted by the Os.

60.1 Firstly, the OD observes that the opinion of the Board in T 239/16 (D207), on which the PP mostly relied for the present line of argument, constitutes a non-binding opinion in preparation of the oral proceedings, where the Board intended to set the basis for a discussion in view of a possible referral to the Enlarged Board of Appeal (cf. point 3 of the preliminary opinion). In D207, the BOA thoroughly presented arguments in favour of and against the EPO's power to address legal entitlement to the right of priority, but it finally revoked the patent without deciding on the priority claim (and the request for referring the question of the interpretation of Article 87(1) EPC to the Enlarged Board of Appeal was finally withdrawn). So far no decision of a BOA has ever taken this approach or even suggested it. On the contrary the aforementioned established practice (point 54) has never been questioned to the extent of the EPO's power to assess legal entitlement to priority.

60.2 Having clarified this, the OD does not dispute that, as a rule, the EPO has no competence to assess rightful ownership of the priority right, i.e. inventorship. A dispute as to the right to claim priority cannot be solved within the framework of the EPC since the EPO has no jurisdiction to decide claims to the right to national patent applications or priority rights derived therefrom (cf. J 11/95, reasons 4, last sentence). This is however not in conflict with the established EPO practice but rather confirms it, as explained in the following.

60.3 Under the established EPO practice, Article 87(1) EPC has been regarded as sufficient legal basis for the examination by the EPO of the legal entitlement to the right of priority (cf. conclusions in the preliminary opinion in T 239/16 last paragraph of point 3.4.1). In case of relevant state of the art in the priority interval – the EPO assesses whether the requirements, both formal and substantive, for a valid claim to priority have been fulfilled. The substantive requirements include assessment of the "same invention" and the 12 months' time limit for filing the later application. The formal requirements include the declaration of priority and examination of whether the applicant/proprietor, or his successor in title, was the applicant of the priority application (cf. Guidelines for examination, edition 2017, A-III, 6.1 and F-IV, 1.3; see also the case law of the BOA T 493/06, reasons 8, T 788/05 reasons 2, T 008/96 reasons 3.1 and 3.2, T 5/05 reasons 4.2, T 62/05 reasons 3.1 to 3.3, G 1/15 reasons 4.2; see also in the patent literature Bremi, *Singer/Stauder, EPÜ*, 7th edition 2016, Art. 87, No. 55-57; Grabinski, *Benkard, EPÜ,* 2nd edition 2012, Art. 87,No. 15, Moufang, *Schulte, Patentgesetz mit EPÜ*, 10th edition 2017,

§41, No. 27; Visser, *The annotated European Patent Convention,* 25th edition 2017, Article 87(1) no. 4 and 4.1.; Hesper, *Singer/Stauder, EPÜ*, 7th edition 2016, Art. 151, No. 164).

60.4 The assessment of the formal requirements does not determine the rightful owner of the priority right; rather it establishes whether the priority was validly claimed by those named as applicants in the later application (*applicant's status*), irrespective of their actual entitlement. Thus since it is not required to determine inventorship, also the PP's argument on the difficulties in having to apply a multitude of national laws (point 59.2 above) does not have a basis.

60.5 The cited passages of the Travaux Préparatoires (BR/51/70) confirm the absence of an obligation for the EPO to assess substantial entitlement to priority and clarify that the validity of the claim to priority should not be examined by the EPO in every case. However as a result of the discussion which took place in the Patents Working Group in 1963, applicants who are not applicants of the priority application but claim priority from it have to submit proof of entitlement only if the EPO invites them to do so (cf. also the conclusion on the Travaux Préparatoires cited in T 577/11, reasons 6.5.6). This conclusion confirms the established practice that, at least when there is relevant state of the art in the priority interval, the EPO could ask for proof of succession in title (cf. Travaux Préparatoires, document 7669/IV/63, Article 74 and document 4419/IV/63).

60.6 In the OD's opinion, the *wording* of Articles 87-89 EPC and the *system of priority* in patent law imply that the EPO has been entrusted with the assessment of the validity of a claim to priority, in order to determine the patentability requirements in respect of novelty and inventive step. The wording of both the PC and the EPC – to the extent they require that priority be formally claimed by the person filing the first application, or by his successor in title – would be disregarded if the EPO were to rely simply on the applicant's declaration. If it were merely presumed that any person filing a later application is entitled to claim priority from a first application, the EPO would ultimately grant patents with an unreliable state of the art, as any control over at least a "relationship" between the first application and the one claiming priority would be shifted entirely to national courts.

60.7 Legal certainty and the protection of the interests of the public (against the granting of invalid patents) require that priority is validly claimed, since this is relevant for defining the effective date of a claimed invention and for determining the relevant state of the art (cf. T 577/11, reasons 6.2; cf. also Ullmann, *Das Prioritätsrecht im Patentwesen – Verbrauch oder Missbrauch?* in *Mitt.*, 2009, 201, 205). It is true that a competitor is not interested in the substantial entitlement to the invention, but rather in the question of the valid claim to priority, i.e. which state of the art is relevant for the application claiming priority. Since a valid claim to priority requires the fulfilment of both formal and substantive requirements, it must be concluded that both are to protect the interests of third parties. Legal certainty would be negatively affected if only national invalidity proceedings determined whether the applicant of a later application was not the "same" as in the first application. This requirement cannot always be established from the declaration of priority alone, if the applicant(s) of the later application is not the same as in the first application.

60.8 The OD also does not share the view that a reason in support of the PP's approach is given by the fact that a challenge to the entitlement to the right of priority is, in most legal systems, only allowed against a person alleging himself to be the owner (point 59.3 above). The question of the legal standing of a person in respect of a given right is an issue distinct from the competence of an organ to decide on such right.

60.8.1 In addition, the OD observes that even in certain national systems the substantial and legal conditions for the validity of the claim to priority may be assessed in the course of nullity and/or infringement proceedings if raised by any third party (cf. for instance in Germany where in nullity proceedings even the condition of the "applicant's identity", required for the claim of priority, may be reviewed if lack of novelty is raised under § 21, Abs.1 Nr.1 and even without the limitations on legal standing foreseen for entitlement claims according to § 21, Abs.1 Nr.3, see Rogge/Kober-Dehm in *Benkard Patentgesetzt* § 22 Rn 60 and § 21 Rn 32 and 33).

61 Finally, in respect of the entitlement to the right of priority under Article 87 EPC, the OD does not find a legal basis for applying the same approach established under Article 60 EPC for the entitlement to a (patent) application (point 59.4 above).

61.1 The principles of Article 60 EPC cannot be applied by means of analogy, because there appears to be no *lacuna legis* in Article 87 EPC which needs to be filled (G 1/97, reasons 3, b)). On the contrary it has been consistently held that the provisions of Articles 87 to 89 together with Rules 52 and 53 EPC form "a complete, self-contained code of rules of law on the subject of claiming priority for the purpose of filing a European patent application" (cf. J 15/80, headnote I).

61.2 Further, from a substantive point of view, the traditional distinction between entitlement to the patent (application) and entitlement to the priority right does not allow the same approach to be used for both. Whereas the validity of the priority right under Article 87(1) EPC has a procedural relevance, i.e. it serves to set the relevant date for the state of the art and ultimately affects the patentability of the invention; the entitlement to the (patent) application under Article 60 EPC does not as such affect the patentability of the invention. In case of a challenge to the entitlement, proceedings are stayed according to the procedure set by Article 61 and Rules 14 to 18 and 78 EPC.

61.3 In addition, the division of powers between the EPO and the contracting states behind Articles 60, 61 and 138 EPC with regard to the entitlement to a patent application is complemented by the legal fiction of Article 60(3) EPC. The provision that the applicant shall be deemed to be entitled to exercise the right to a European patent constitutes a clear basis for the EPO's lack of competence to go beyond this legal fiction. It is noted that this legal fiction does not extend to the right of priority; neither is there an analogous legal fiction foreseen in the priority system under Articles 87 and 89 EPC.

62 The OD would also like to comment on additional arguments brought up by the PP in support of its proposed approach.

62.1 The PP has alleged that an argument against the EPO's power to assess legal entitlement to priority may derive from the difficulties of such assessment when the validity of a priority claim of a patent application representing prior art pursuant to Article 54(3) EPC is at stake (cf. also T 239/16, point 3.4.3). There will be difficulties in obtaining evidence where the patentee of an earlier European right is not party to the proceedings before the EPO. An earlier European application constitutes state of the art under Article 54(3) EPC from the moment of its publication, and it is fixed with the legal status it had in that moment (cf. Gall, in Mitt. 998, No. 4.4, 174), independently from its later fate. Once it has been published, the question whether a European application can be a conflicting application under Article 54(3) EPC is determined firstly by its filing date and the date of its publication. If the published European application claims priority, the priority date replaces the filing date for that subject-matter in the application which corresponds to the priority application. Thus, when assessing prior art under Article 54(3) EPC, the EPO necessarily has to consider the question of the validity of its claim to priority. It is noted that this approach corresponds to the practice reflected in the Guidelines for Examination and has also been adopted by the BOAs (cf. GL G, IV-5.1. and T 493/06). In view of possible difficulties in obtaining the relevant evidence, the assessment of legal entitlement to priority for a document cited under Article 54(3) EPC may be based on a lower standard of proof, i.e. a balance of probabilities.

62.2 The OD also observes that the approach proposed by the PP is not even the one implemented in the "more liberal" US system, which recognises the legal entitlement to priority only where there is at least a "relationship" between the applicants of a priority application and a later application (e.g. common inventorship, employment, etc.).

II.3.1.1.2.1 Conclusion on the PP's first line of arguments

63 On account of the wording of Article 87 EPC (identical to Article 4 PC), in the light of the Travaux Préparatoires and based on the relevance of the priority claim for the patentability of the invention, the OD concludes that the EPO has the task to assess the identity of the applicant, as well as the validity of its succession in title. This conclusion is fully in line with the EPO established practice and case law cited under point 60.3. Thus, the approach proposed by the PP, that the EPO should neither assess the identity of the application, nor the successor in title, cannot be followed.

II.3.1.1.3 The PP's second line of arguments - ***Meaning of the term "any person" under Article 87 EPC in case of joint/multiple applicants in a first application***

64 The PP alleged that the word "any" in the context of Article 87 EPC should mean "one or some indiscriminately of whatever kind", so that any one of a plurality is sufficient. It supports this approach on the basis of the *ordinary meaning* to be given to the EPC provision pursuant to Article 31 Vienna Convention on the Law of the Treaties, and concludes that all three texts ("Any person", "Jedermann", "Celui qui") bear such open, permissive meaning. On account of the different wording of Articles 4A(1) and 4D PC (permissive form "any person", in the French version "Celui qui" and "Quiconque" respectively) and Articles 4F and 4G PC (prescriptive form "the applicant", in the French version "le déposant" and "le demandeur" respectively), the PP inferred that under the PC a more permissive notion of who is allowed to claim priority was intended, as compared to who may prosecute the subsequent application once filed, including who may file a divisional application. If it were the intention of the legislators of both the PC and the EPC to prescribe a strict "all applicants" approach, this would have been made explicit.

64.1 Further, having in mind the *object* and *purpose* for which the priority right was designed, i.e. to assist the applicant in obtaining international protection for his invention, the PP held that in the case of joint/multiple applicants this can only mean to assist each of them indiscriminately. In this context protection of third parties' interests would be sufficiently guaranteed by the "same invention" requirement, rather than by the "identity" of the person claiming priority. Thus the established EPO practice of requiring all applicants neither fulfils the purpose of the PC, as it often leads to the loss of the priority right of all interested persons and often also of the patent, nor does it protect the interests of third parties. Lacking a basis both in the language of the PC and of the EPC for the requirement that *all* persons who duly filed the priority application (or their successors in title) be applicants on the subsequent application, this element ultimately turns out to be an additional requirement for the assessment of the validity of a priority claim, defeating the purpose of the right of priority.

64.2 The PP also drew attention to the US implementation of the PC, which merely requires one inventor in common between the priority application and the subsequent application (35 U.S.C. § 119(e) and US Manual of Patent Examining Procedure (MPEP) section 1828).

64.3 The PP supported these arguments with the legal opinions by Prof Straus (D 199), Prof Torremans (D197), U. Scharen (D 125, *Wie ist das Erfordernis der so genannten Anmelderidentität des Art. 87 zu verstehen?,* GRUR 2016, 446) and the legal literature of Ladas (*Patents, Trademarks and Related Rights, National and International Protection*, 1975, Vol.I).

65 The Os substantially maintained that the PP's new argument should be rejected in view of a) the established EPO case law and the international practice, b) the authoritative French text of the PC and c) the fact that co-owners of a priority right – considered in its whole disclosure - necessarily have to exercise their right jointly.

66 The OD has given particular consideration to the arguments and expert opinions in support of the present approach. This approach might have practical benefits for applicants. However, in view of its far-reaching implications the OD does not consider it appropriate to deviate from the established practice.

66.1 Under the principles of interpretation provided for in Articles 31 and 32 of the Vienna Convention, which are to be applied when interpreting the EPC (cf. G 5/83, G 2/08, G 1/07, G 2/12, G 2/13, J 10/98), "*A treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose*".

66.2 Following these principles, the **wording of Article 87 EPC** - in the three texts in which the EPC has been authenticated (Article 177(1) EPC and Article 33(3) Vienna Convention) – does not provide an exclusive indication as to whether the later application must be filed by "all applicants" of the first or by "any one" of them. This is valid despite the apparent more permissive German and English forms ("*Jedermann*", "*Any person*") rather than the restrictive French one ("*Celui qui*") and in view of the fact that the three texts

are presumed to have the same meaning (cf. also J 8/85, reasons 5.1 and Bruchhausen, GRUR Int. 1983, 205). The use of "any person" in other provisions of the EPC does not provide further indications. The same is true with regard to the **wording of Article 4A(1) PC**, although here the French text should be considered as the prevailing one (Article 29(1)(c) PC).

66.3 Neither is a clear reading provided in one sense or the other, by referring to the Travaux Preparatoires of both treaties. The **Travaux Préparatoires to the EPC** do not contain any specific reference to the meaning of "a person…" (under the wording of the EPC 1973) / "any person…" (under the wording of the EPC 2000) and rather focus on the question of the extent to which the EPO shall examine the entitlement to priority (see point 60.5 above). The change in the English version of the EPC 2000 (from "a person" to "any person") did not imply a change in the law, but was merely intended to reflect the exact wording of the PC, whereas the German and French versions remained unamended. The **Travaux Préparatoires to the PC** determine the meaning of "any person" (as well as of successor in title) by referring to all persons entitled to claim application of the Convention according to Articles 2 and 3, that is, nationals of a country of the Union and nationals of countries outside the Union, who are domiciled in a country of the Union (cf. Bodenhausen, *Guide to the application of the Paris Convention*, Geneva 1968, Art. 4A(1) note (b)). No separate interpretation applicable to the case of joint/multiple applicants of the first application is given.

66.4 However, **a basis for the so-called "all applicants" approach** can be found from the first commentaries to the PC onwards and has been subsequently confirmed without exception both in the EPO practice and case law, as well as in the relevant national case law. This shows a certain degree of established harmonisation between the EPC and national laws:

66.4.1 The requirement of identity of applicant between the first and the later application is, according to *Wieczorek*, undisputed and thus valid both in the case of a sole applicant and in the case of multiple applicants of a first filing (cf. *Die Unionspriorität im Patentrecht*, Köln 1973, S. 128 und 146).

66.4.2 This approach was adopted also by the practice of national patent offices right after the implementation of the PC (cf. decisions of the German Patent Office of 16.12.1905, Bl.f.PMZ 1906, 127; of 16.01.1907, Bl.f.PMZ 1907, 127; of 25.10.1917, Bl.f.PMZ 1917, 120; decisions of the Austrian Patent Office of 13.06.1912, ÖPatBl. 1913, 679; of 20.12.1912, ÖPatBl. 1913, 1148; decision of the Czech Patent Office of 25.09.1931, Mitt. 1932, 157) and has been maintained also later (cf. High Court of Justice of England and Wales, *Edwards Lifesciences AG v Cook Biotech Incorporated*, [2009] EWHC 1304(Pat), para 95 and 99 with reference to T 788/05; *HTC Corporation v Gemalto S.A.*, [2013] EWHC 1876 (Pat), para 131 and 132). The only deviation to this requirement was introduced during the revision of the PC at the Washington conference of 1991 by adding the notion of "ou son ayant cause" in order to enhance flexibility for patent applicants. By reaffirming that overly strict solutions would hardly be in accord with the spirit of the Union treaty, no further corrective measure was considered necessary to ameliorate the legal position of patent applicants under Article 4A(1) PC in its present version (Stockholm Act).

66.5 The EPO established practice, as reflected in the **Guidelines for examination** expressly requires the identity of applicant. In particular, in the case of joint applicants filing the later European patent application, it is sufficient if one of the joint applicants is the applicant or successor in title to the applicant of the previous application. There is no need for a special transfer of the priority right to the other applicant(s), since the later European application has been filed jointly. The same applies to the case where the previous application itself was filed by joint applicants, provided that all these applicants, or their successor(s) in title, are amongst the joint applicants of the later European patent application (cf. A-III, 6.1 and F-IV, 1.3; however see A-III, 6.9 and 6.10).

66.5.1 This requirement has been upheld in several **Boards of Appeal decisions** and has so far never been deviated from or subjected to a review. A group of decisions, addressing the question of when an application may be regarded as the "first application" under the meaning of Article 87 EPC, considered the applicants' identity as a requirement to be met, just as the "same invention" condition. In particular it was held that the required identity for the applicants originates from the priority right being *part of the applicant right*. When the first application is filed by two applicants, the priority right **belongs**

simultaneously and jointly to the two applicants, who thus constitute a *legal unity* unless one of them decides to transfer his right to the other applicant (T 788/05, reason 2). Similarly, in an earlier case it was acknowledged that the priority right can only be **exercised jointly** by the applicant of the first application or by his successor in title (T 5/05, reasons 4.2). Applications claiming the same priority filed separately by different applicants of the priority application would constitute state of the art to each other under the meaning of Articles 54(2) and 54(3) EPC (the latter provision however only for European applications as originally filed).

66.5.2 The "all applicants" approach was confirmed also under the opposite circumstances (subsequent application filed by more applicants than the first one), where it was held that the right of priority could only be **exercised** jointly by all owners, or by their successor(s) in title (T 1933/12, reasons 2.3).

66.5.3 The "all applicants" approach was acknowledged as the starting point of another group of decisions, concerned with the question of a valid assignment of the priority right. Stressing the fact that the right to claim priority originates from the applicant of the first application, so that, in principle, the applicant has to be the same for the first and the subsequent applications, the Boards concluded that where the first application has been filed jointly by two or more applicants, the right of priority **belongs** to them jointly (T 205/14, reasons 3.3 and T 517/14, reasons 2.4, see also T 382/07, reasons 9.1).

66.5.4 There is agreement in the **legal literature** on the required identity between the applicant(s) of the priority application and the applicant(s) of the European application claiming priority from it (cf. Grabinski, *Benkard, EPÜ*, 2nd edition 2012, Art. 87, No. 15; Bremi, *Singer/Stauder, EPÜ*, 7th edition 2016, Art. 87, No. 57 and 63; Moufang, *Schulte, Patentgesetz mit EPÜ*, 10th edition 2017, §41, No. 27; Visser, *The annotated European Patent Convention*, 25th edition, 2017, Article 87(1), No. 4 and 4.1; Article 87(4), No.4; Ullmann, *Das Prioritätsrecht im Patentwesen – Verbrauch und Missbrauch*, Mitt. 2009, 201).

66.6 Despite the widely recognised "all applicants" approach under the EPC, the OD has given special consideration to the different opinions by Scharen (D125), Prof. Straus (D199) and Ladas (cited above) in favour of allowing a valid priority claim when *at least one of the persons* who filed the first application (or their successor in title) is an applicant for the later European patent application. It is not disregarded that the wording of the relevant provisions (both in the EPC and in the PC) does not clearly exclude this interpretation (see point 66.2 above). The provision on the succession in title under Article 87 EPC would still be applicable for situations in which a different person, alone, files the subsequent application, without the applicant(s) of the first.

66.7 The co-ownership of an intellectual property right is subject to the same rules as the co-ownership of any other right. On account of the distinction between the **ownership** of the right of priority and its **exercise**, it appears that each co-owner is entitled to an ideal share of the whole right (*communio pro indiviso*) and may exercise the co-owned right either jointly or individually, depending on the arrangements agreed or established by the law. Whereas an *act of disposition* of the common right - such as an assignment, or the constitution of a guarantee - in principle requires a joint act by all co-owners, and one of them alone is not entitled to validly *dispose* of the common right, it is not excluded that each joint owner *may* in principle *exploit* the right individually, for instance to maintain it in force. In the context of the priority right the question whether, in case of co-owners, the filing of the subsequent application requires a joint act depends ultimately on the arrangements chosen by the "co-owners", or on the applicable law.

66.8 Based on the above, the filing of an application claiming priority from a first application may be interpreted as an *act of exploitation* of the common right - rather than an act of its disposition - and consequently could be exercised individually. This interpretation would be consistent with the results of the harmonisation studies on co-ownership of patent rights (cf. AIPPI Question Q194 on "*The Impact of Co-Ownership of Intellectual Property Rights on their Exploitation*", Summary Report and the Resolution, Yearbook 2007/II, pages 445,446 - Executive Committee of Singapore, 5 – 10 October 2007). In principle, individual exploitation of an IP right by one of the joint owners is allowed as long as it does not prevent the other joint owners from equally exploiting the same right. With reference to the priority right this approach

would mean that nobody would be prevented from exploiting the same priority right, as a whole, as long as each of the co-applicants has the right to file separately a subsequent application claiming the whole priority from the first application. The question whether the filing of the later application violates the others' rights, as indicated by Scharen (D125), depends on the individual case and would probably occur only in case of a filing in bad faith, with the purpose of excluding the others (see also D 207 point 3.4.8., however the remedy of national entitlement proceedings would be available). It is noted that in the present case, O1 has cited D141-D148 in order to show that one of the co-applicants of the priority applications – Maraffini - did not agree with not being mentioned as applicant in the PCT application underlying the opposed patent. On the other hand, the OD recognises that the PP's second approach possibly protects the legitimate interest of a joint applicant wishing to keep that right valid and ongoing, even if the co-operation of other joint applicants is missing.

66.9 However, allowing each joint applicant, separately or in different combinations with other co-applicants, to file a patent application claiming priority from the first application would lead to a multiplication of proceedings with identical content. The OD cannot disregard that the logical consequences of this approach would run counter to the interests of patent offices and the public both in terms of procedural inefficiencies and of avoiding multiplication of protections for the same subject-matter, having different patent owners. Some of the disadvantageous results for the public have been also mentioned by Prof Melullis (D 162), as for instance the effect of licensing by one owner for the other owners; the possibility of multiple infringement claims and the relative effect of a settlement in infringement proceedings. All these consequences do not appear compatible with the systems of international and European patent laws, which include measures to minimize such multiple patenting, as for instance by recognising the prior art effect under Article 54(3) EPC. Even following the majority opinion that under the EPC there is no such doctrine of exhaustion of the priority right (T 15/01, reasons 28 and 41) the resulting risk of multiple patenting inherent in this approach would have far reaching consequences for the system.

66.10 It may be questioned whether these considerations are only theoretical or whether account of them is properly to be taken under the instrument of the priority right (or rather whether it is already properly addressed under Article 54 EPC). Nevertheless, the OD as an administrative instance has the duty to apply the EPC, following the interpretation given by the BOAs and to follow, under normal occurrences, the practice established by the Guidelines for examination in order to ensure legal certainty and predictability of the rules of law governing the priority claim. Whereas a deviation from the Guidelines may in principle be justified if the circumstances of a given case are exceptional (cf. T 1388/10, headnote V and reasons 5; J 27/94, reasons 5), the case at stake does not present particular special features. There is no exceptional circumstance in the fact that the priority application is a US provisional application or that the subsequent PCT application was filed by fewer applicants than the first application. It is observed that US provisional applications are given no special treatment under the EPC. Provided a US provisional application has been duly filed, it is recognised as giving rise to a right of priority under Article 87(1) EPC and establishing an effective filing date (cf. Notice of the President of the EPO of 26.01.1996, OJ EPO 1996, 81).

II.3.1.1.3.1 Conclusions on the PP's second line of argument

67 The proposed approach to consider priority as validly claimed even when *any one* of the joint applicants of the first application is applicant of the later application would protect the legitimate interest of a joint applicant wishing to keep a priority right valid even when the co-operation of the other joint applicants is missing. It would also lead to a result consistent with the EPO practice of recognising priority as validly claimed in the opposite situation, where the applicant(s) of the first application is(are) amongst the applicants of the later application (*de facto* sharing the right of priority, cf. T 1933/12, reasons 2.4.). Such interpretation of the PC had also been adopted by the US Patent Office. Following the distinction between ownership and exercise of a right, the filing of an application claiming priority may be regarded as an act of exploitation (exercise) of the (jointly owned) right of priority, which would be possible also individually. However this approach would have far reaching consequences, in particular the risk of multiple patenting. Although this effect would not violate the first filing requirement of the PC, which had the sole aim of avoiding a chain of priority applications with different dates for the same subject (see Bodenhausen, cit. above, Art. 4A(1), point (d)), still the

conformity with the system of avoiding a potential multiplication of proceedings with identical content is doubtful. For these reasons, the OD considers it not appropriate to deviate from the established practice by following the applicant's second line of arguments.

II.3.1.1.4 The PP's third line of arguments - **The meaning of "any person who has duly filed" and the application of national law**

68 As a third line of argument, the PP submitted that the determination of "any person who has duly filed" under Article 87(1) EPC should be subject to the national law of the place of filing of the priority application. Following the EPO established practice to determine the "successor in title" under national law, the PP considered it appropriate to determine "any person who has duly filed" also under the applicable national law, i.e. the law of the place in which the earlier application was filed (so-called *lex originis*), in this case US law. The PP also submitted that US law, instead of Article 87 EPC, should apply in the present case to the determination of priority in view of Article 8(2)(b) PCT. US law requires that to be an "applicant" one must have either contributed to the invention claimed in the application oneself, or have derived the rights from a contributing inventor. The determination of the contribution to the invention is made by the US patent attorneys prosecuting the application, in this case Mr Kowalski (D120, D121) and Dr. Uthaman (D122). Reference is made to the legal opinions by Hoffmann (D200, para 3-7); Prof. Straus (D199, para 8.3-8.5 and 9.2) and Bremi (D 198, para 6-8, 10-11 and 15).

68.1 The PP alleged that this approach should be followed in view of the special circumstances of the present case, namely that the priority application was a US provisional application disclosing multiple inventions and that some of the inventors/applicants of the priority application (Mr. Maraffini, Mr. Bikard and Mr Jian) did not contribute to the invention disclosed in the later PCT application. Therefore, according to US law the latter could not qualify as "any person who has duly filed" according to Article 87 EPC. Rather the US provisional application should be considered in such a case as a bundle of applications, each disclosing one invention and each filed only by those inventors who contributed to that invention (cf. also the declarations of J. Doll (D118, D119, D203), Judge Michel (D140, D 202), S.B. Maebius (D 206), Prof. J.R: Thomas (D204) and J. Pooley (D 205).

69 The OD cannot follow the PP's arguments for the following reasons:

69.1 The national law of the country of the Union where the first application is made applies to the meaning of "any person who has duly filed" under Articles 4A(1), A(2) and A(3) PC only for the purpose of according a date of filing (cf. Bodenhausen, *Guide to the application of the Paris Convention for the protection of industrial property*, 1968, Article 4A(2), point (c)). The PC only deals with the formal aspects of claiming priority and does not refer to a condition of substance, in the sense that the person filing the first application should be entitled to the invention (see Bodenhausen, *cit.,* Article 4A(2) point (a) and 4A(3) point (b); see Ladas, cited above, § 260; see Teschemacher, *Anmeldetag und Prioritätstag im europäischen Patentrecht*, GRUR Int. 1983, 695). Thus, by a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application. This approach is consistent also with the requirements for accordance of a date of filing under Article 5 Patent Law Treaty, which does not foresee an entitlement to the invention in the person filing the application.

69.2 The **wording** of the PC and of the EPC confirms that the act of formally filing the first application gives rise to the right to claim priority and not a substantive entitlement to the invention claimed. In case of multiple applicants filing the first application, the PC sees this act as one single process.

69.3 The **case law** of the Boards of Appeal has established that for the application of the right of priority, a fundamental principle of the EPC system is to consider neither the status of an inventor nor his concrete contribution to specific subject-matter of the application. A different approach would be contrary to the scope of simplification of proceedings, as intended by the EPC legislator when choosing to focus solely on the status of an applicant in the EPC system both in Article 87(1) and in Article 60(3) (cf. T 5/05, reasons 4.2; T 1933/12, reasons 2.5; T 577/11, reasons 6.5.7, last paragraph; see also Beier-Straus, *Probleme der Unionspriorität im Patentrecht*, GRUR Int. 1991, 255, section II, d., particularly point 23; and Bremi, *epi information* 2010, 17, point II. 4).

69.4 Although recent decisions (see T 517/14, reasons 2.7.3 and T 205/14, reasons 3.6.3.) have confirmed that the organs of the EPO are in principle not barred from applying national law governing an incidental question, such as assessment of the successor in title within the meaning of Article 87(1) EPC (cf. T 1008/96, reasons 3.3.; T 160/13, reasons 1.1; J 19/87 reasons 2; T 493/06, reasons 9 and 11; T 517/14 reasons 2.7.3 and T 205/14, reasons 3.6.3), the same BOAs have never suggested applying national law to any aspects of the "act of filing" other than the formal matter of simply according a filing date to the application. This is indeed a completely different question from that of how and in which form a transfer of the rights of priority is to be made. That the "standards of national law cannot be applied in relation to other requirements of a potential priority application", but for the determination of the date of filing within the meaning of Article 87(1) EPC was also confirmed in T 107/09 (cf. point 23.1 of the reasons).

69.5 The OD also does not consider that the present determination of priority should be controlled by US law in view of Article 8(2)(b) PCT (internal priority), which should have precedence over the EPC. This provision is relevant for the priority from a US provisional application for a later US non-provisional application (which would then be subject to 35 U.S.C. § 119(e)). The present case is instead subject to Article 8(2)(a) PCT (external priority), which determines that the PC – as implemented in Articles 87-89 EPC - applies for priorities claimed for a state different from the country of the first filing.

70 The PP's proposed approach - that the priority right should be acknowledged for the entitled "applicant" of the first application - substantially leads to the application of national law for the determination of the original ownership to the invention. This approach mixes up the status of the applicant for the purposes of Article 87 EPC with matters of substantial entitlement and is thus not consistent with the wording and scope of the PC and of the EPC. As was unanimously acknowledged under the first line of argument (cf. section II. 3.1.1.2) this determination has been traditionally excluded from the EPO's competences, primarily due to the complexities of having to apply several different national laws and carry out the necessary investigations.

70.1 If there were an obligation of a patent office to examine entitlement questions, the simplification adopted with the Paris Convention would become meaningless (cf. Wieczoreck, *Die Unionspriorität im Patentrecht*, 1975, p. 129 ff.; Grabinski in *Benkard, EPÜ*, 2012, Artikel 87, Rn 3 and 25; Ruhl, *Unionspriorität,* 2000, Rn. 184, 259; Moufang in *Schulte, Patentgesetz mit EPÜ*, 10th edition, 2017, § 41 Rn 27 and 28: "*It is not sufficient that the applicant of the subsequent application has a right in the invention of the priority application" and* "*Identity of inventors between the first and the later application is not required*").

70.2 The lack of a harmonised definition of inventive concept as well as of a harmonised interpretation of the term "inventor" in the member states of the PC led to rejecting any reference to "inventor" for the claim to priority when drafting the PC.

70.3 In the present case, the assessment of inventorship under US law would involve complex determinations, for instance the contribution to an invention in a not insubstantial or insignificant manner, as developed by US case law, which clearly cannot be performed by an administrative authority such as a patent office (cf. D 120, D 122).

70.4 Whereas it might be admissible under US law that priority (provisional) applications include independent inventions distributed among the inventors/ applicants according to their contribution, the PC adopts the principle that a first application gives rise to one priority right, and the applicant(s) of the first application has(have) the entire right of priority. Accordingly, the EPC system does not provide for a different treatment of rights of priority on different subject-matters vested in different applicants.

70.5 Rather, following the interpretation of the PC and the EPC as established in EPO practice, both the public and patent offices may rely on the information in the patent registers and available from inspection of the public file. National law, such as US law, thus applies only to the information available in the records.

II.3.1.1.4.1 Conclusions on the PP's third line of arguments

71 Under the PC and the EPC the right to claim priority derives from the formal filing of the first application, irrespective of the status of inventor. The PP's submissions to determine "any person who has duly filed an application" as a matter of ownership under the national law of the place of first filing actually pertain to the right to the invention and the resulting right to the patent, which a patent office is not competent to assess. Since this approach would disregard the wording and the scope of Article 4PC and Article 87 EPC, the OD sees no reason to depart from the established interpretation given by the BOAs that substantive entitlement is not a basis for the right of priority (see points 69.2 and 69.3 above). The OD also considers that the PP's arguments that "any person" and "duly filed" should be determined under US law, in the light of the PP's submissions actually constitute a single argument.

71.1 Actual entitlement to an invention/contribution to an invention may be taken into account by civil law instruments, which are available to permit a valid claim of a priority right according to Article 4 PC and Article 87 EPC (such as a transfer of priority right, or an authorisation to claim a priority right or even the filing of a later application in the name of all inventors/applicants of the first and a later transfer of rights back to the only "contributors"). In the present case it would have also been possible to conclude separate assignments between the parties limited to the European part of the PCT application in order to comply with the formal requirements (cf. also Bremi in *epi Information* 1/2010, 17, section IV; Teschemacher, *GRUR Int.*, 1983, 701).

II.3.1.2 Conclusions of the OD on the legal entitlement to priority

72 In view of the above reasons, the OD has come to the conclusion that none of the three approaches proposed by the PP can be allowed. In particular, due to the potential legal implications of the date of (first) priority in the assessment of patentability or validity of a patent application or patent, it is imperative that applicants and the public at large be provided with legal certainty and predictability with respect to the rules of law governing the subject of claiming priority (cf. T 517/14 reasons 275).

72.1 Thus according to the established practice the identity of the applicant (and the validity of a transfer of the right of priority) must be assessed. In such assessment the EPO should however refrain from considering the status of an inventor or his concrete contribution to the subject-matter of an application under national law.

72.2 For the same reasons of legal certainty and predictability of the applicable rules, the OD, in its function as administrative first instance, does also not deviate from the established practice regarding the applicants' identity, so-called "all applicants" approach, as it is currently understood by the EPO.

73 By applying the established practice to the present case, it appears that the priority rights from Mr. Zhang, Mr. Cong, Mr. Hsu and Mr Ran in relation to P1 and P2 have been validly claimed in the PCT application in view of the applicants' identity. The OD is also satisfied that proof of a transfer of priority rights from Mr. Habib, Mr. Lin and Mr. Cox to the Broad Institute and the MIT has been submitted with regard to P1, P2, P5 and P11, with assignments dated 10.12.2013 (DX3, DX4 and DX5) and thus before the filing date of the PCT application (12.12.2013). Evidence is on file also for the assignments of the priority rights on P11 from Mr Platt and Mr Sanjana to the MIT (DX5) on 10.12.2013.

74 However no evidence has been filed regarding the transfer of the priority rights of Mr. Maraffini in relation to P1, P2, P5 and P11 to one of the applicants mentioned for the PCT application, before its date of filing. The same is true for the priority rights of Mr. Bikard and Mr. Jian in respect of P5 and P11. Thus their priority rights have not been transferred into the PCT application before its filing date.

75 For these three inventors, Mr. Maraffini, Mr. Bikard and Mr. Jian, an assignment of those priority rights dated 7.02.2013 and 12.12.2013 to the Rockefeller University (DX1 and DX2) has been submitted. However the latter is not an applicant of the PCT application.

75.1 An assessment of whether the inventor/applicant Maraffini or his successor in title, The Rockefeller University, were entitled to be named as applicants in the PCT application, in view of the alleged lack of contribution to the invention, would be equal to assessing entitlement to the EP application under Article 60(3) and 61 EPC, for which the EPO is clearly not competent.

75.2 This was confirmed also by the submissions filed by the PP on 31.10.2016 as well as by O9 on 18.11.2016 and by O4 on 23.12 2016 regarding the discovery proceedings initiated by O1 in the US according to 28 U.S. code § 1782.

75.3 For the same reasons the OD decided that the results of the arbitration proceedings between The Rockefeller University and The Broad Institute over the dispute on inventorship and ownership due to the position of Mr Maraffini were not *prima facie* relevant to the issue of the valid claim of priority. Thus the corresponding document, which the PP wanted to file on the second day of the oral proceedings, was not admitted into the proceedings. Indeed the argument that Mr Maraffini was not an applicant of the PCT application was already on file.

76 Finally the recording of a change in the name of the applicants Zhang, Cong, Hsu and Ran to Harvard College dated 23.05.2014 according to Rule 92bis.1 PCT is not relevant for the purposes of the transfer of priority rights under Article 87 EPC. The co-applicants Zhang, Cong, Hsu and Ran, who were named after the PCT filing date, were entitled to validly claim priority at the date of filing.

77 In view of these considerations, the OD concludes that based on the evidence on file, priority has not been validly claimed from P1, P2, P5 and P11.

II.3.2 Novelty over D3 and D4:

78 In view of the OD's conclusion that the opposed patent does not have a legally valid claim to priority from P1, P2, P5 and P11, a number of documents become relevant prior art. During the oral proceedings, only novelty of the patent as granted over only D3 and D4 was discussed. Thus, a conclusion on novelty of the opposed patent as granted was taken only insofar as D3 and D4 are concerned:

79 Together with the summons to oral proceedings, the OD provided the preliminary and non-binding opinion that claims 1-6 and 12-17 of the opposed patent lacked novelty over D3 and D4 for the following reasons:

D3:

The Os argue that D3 is novelty destroying for claims 1-8 and 12-16. In particular the use of a tracrRNA sequence of 64 nucleotides and a guide sequence of 23 nucleotides is disclosed in Figure 1A. The OD preliminarily and non-bindingly agrees with the Os that a composition, which falls within the scope of claim 1, is disclosed in Figure 1A; that a vector system, which falls within the scope of claim 2, is disclosed in page 823, middle column, read in combination with page S7; that claim 3 is not novel in view of page 823, middle column, lines 9-10; that claims 4-5 are not novel in view of pages S16-S18; that claim 6 lacks novelty in view of page 823, middle column.

However, the vectors used in D3 for expressing the chimeric RNA sequence and the Cas9 protein are TOPO vectors (see page S7), lentivectors are only used for the GFP target (see page S7). Thus, the OD preliminarily and non-bindingly is of the opinion that claims 7-8 are novel over D3.

D3 (see Figure 2) discloses genome engineering in multiple cell types of the AAVS1 locus using the vectors mentioned above, it is clear that a target polynucleotide is modified, that a donor DNA is introduced in the cleaved DNA, that the donor DNA is modified compared to genomic sequence, that it takes place by homologous recombination (HR). Thus, the OD is of the preliminary and non-binding opinion that claims 12-16 lack novelty in view of D3.

D4:

The Os object that D4 is novelty destroying for claims 1-4, 7-8, 12-13 and 17. The OD preliminarily and non-bindingly finds that the composition illustrated in Figure 1C has a tracrRNA of 64 nucleotides and falls within the scope of claim 1. Moreover, the sgRNA and the Cas9 protein are expressed from vectors and the Cas9 protein has a NLS at the C-terminal position (see page S1). It is shown that the complex of sgRNA and Cas9 when coexpressed in a cell are capable of introducing indels at the target sites. Thus, the OD is of the preliminary and non-binding opinion that claims 1-4 appear to lack novelty over D4. However, the reference to viral vectors on page 228, right column is not so that it represents a disclosure of an embodiment of D4 and the OD therefore finds that claims 7-8 appear to be novel over D4. The uses in in-vivo genome engineering and the creation of zebrafish embryo is disclosed in the abstract of D4 and the OD therefore finds that also claims 12-13 and 17 lack novelty over D4.

The PP did not at any stage of the proceedings provide any arguments why the claims of the opposed patent would be novel over D3 and D4 and the OD therefore does not see any reasons to deviate from its preliminary opinion and comes to the conclusion that claims 1-6 and 12-17 lack novelty over at least one of D3 or D4.

III Decision

80 The OD concludes that the opposed patent does not meet the requirements of the EPC and therefore decides that it is revoked in accordance with Article 101(2) EPC.