



Topic 11: **Priority Claims and Prior Art**

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Agenda

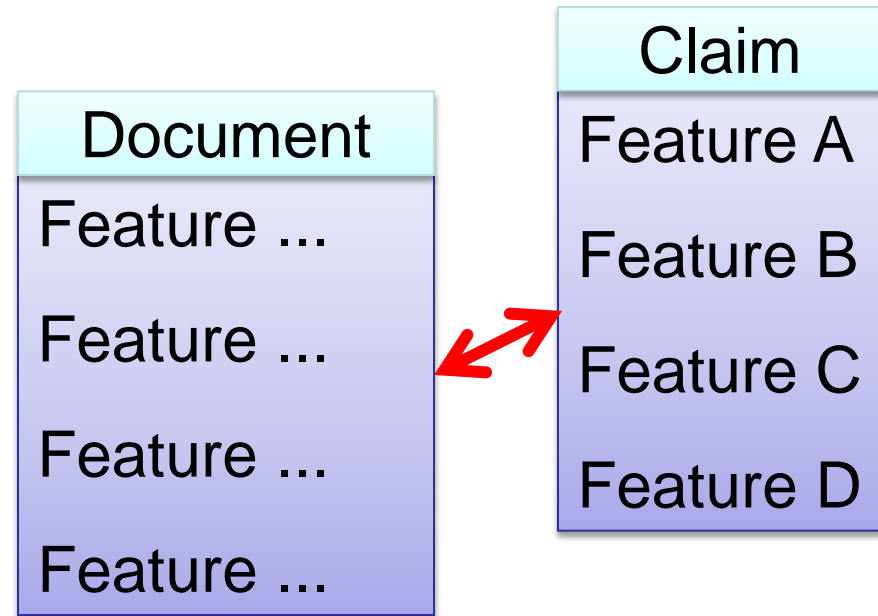
- Prior art in the presence of priorities
- Validity of priorities

Sample: Main claim & dependent claims

1. A method of producing a soya bean product, the method including the step of **exposing soya beans to an acidic aqueous solution.**
one single feature
2. A method **as claimed in Claim 1**, in which the acidic aqueous solution has a pH of between about 2,0 and 5,5.
3. A method **as claimed in Claim 1 or Claim 2**, in which the soya beans are whole beans.
4. A method **as claimed in any one of the preceding claims**, which includes the prior step of dissolving an organic acid in water to produce the aqueous acidic solution.

Claims 2-4 are dependent claims since they refer to claim 1.

Novelty



- Subject matter described in a claim is not novel if

all features are known

from a **single** piece of **prior art**, e.g. another patent

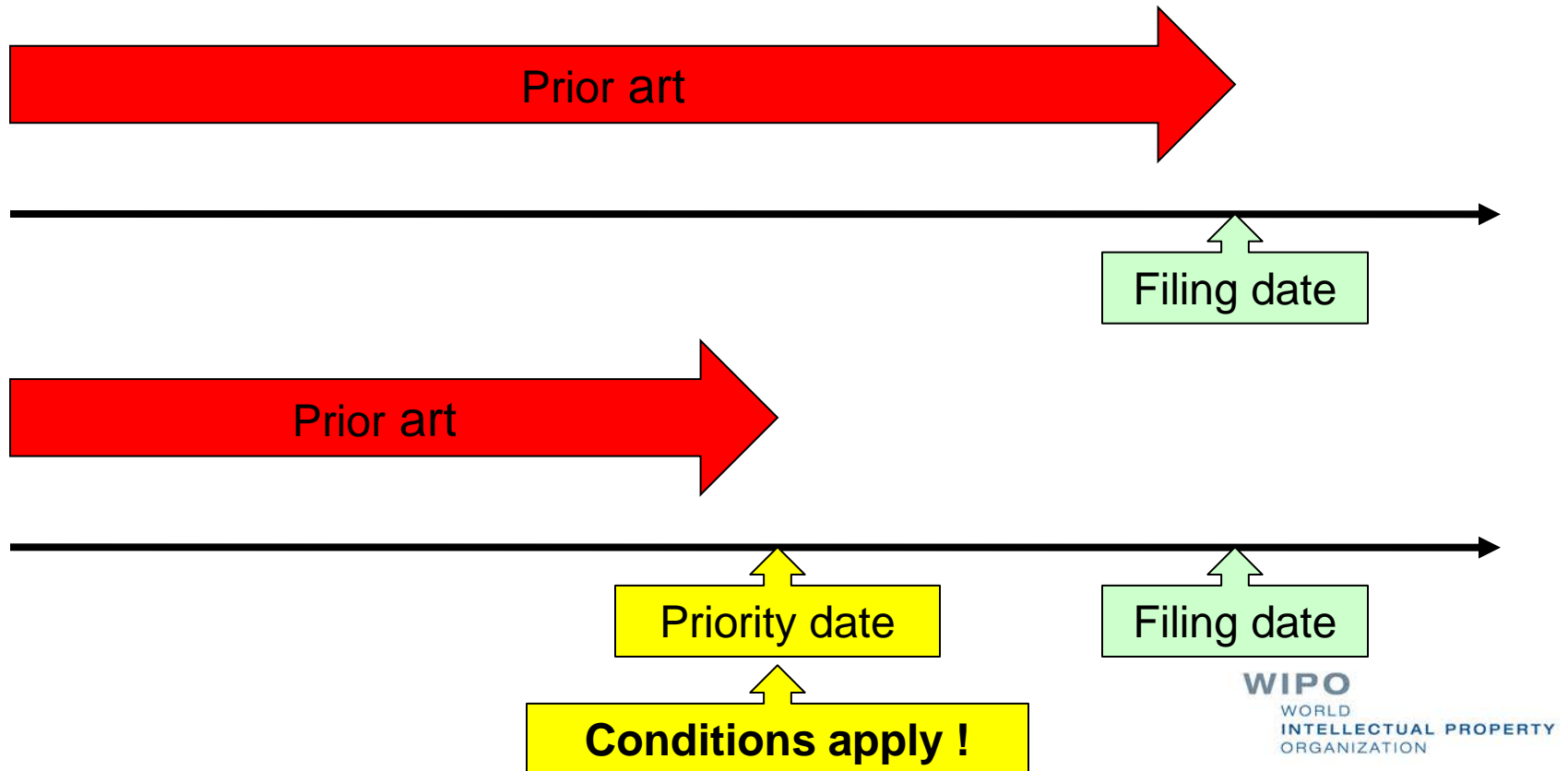
Prior Art

Section 64 (2) (a):

- Prior art shall consist of everything **disclosed** to the public, anywhere in the world, by publication in tangible form or by oral disclosure, by use or in any other way, **prior to the filing date** or, where appropriate, the **priority date**, of the application claiming the invention.

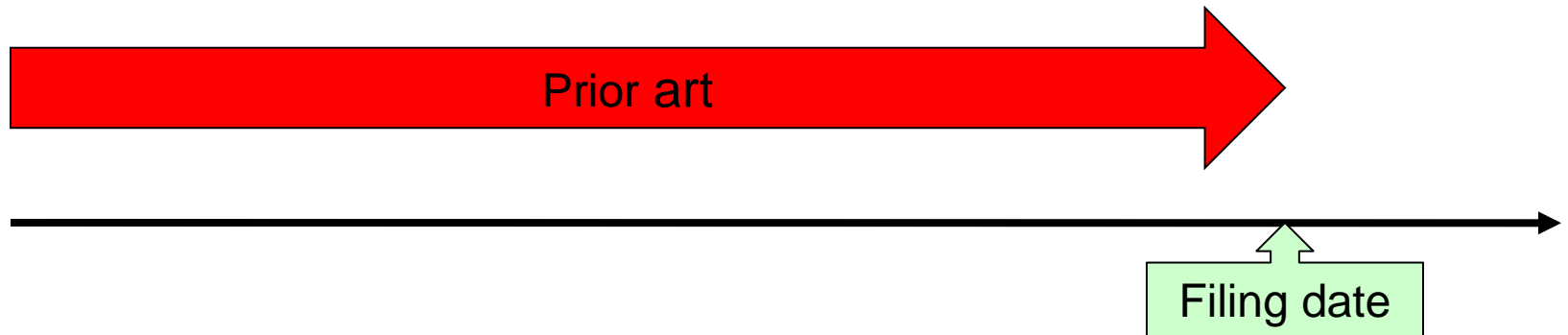
Prior art

- Any information that is made **available to the public** until the application date or the **priority date** (provided priority is acknowledged)



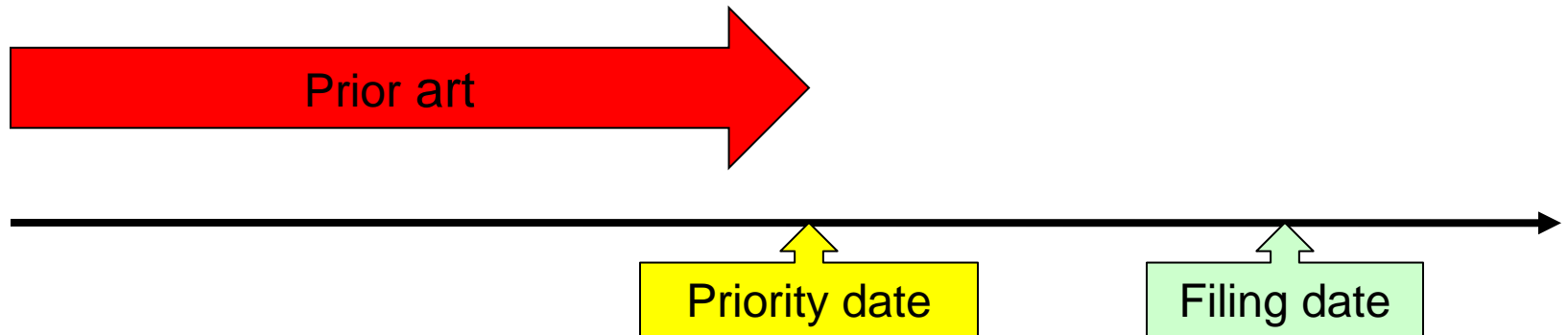
Example: difficulty with multiple priorities

- No priority, OFF



Example: difficulty with multiple priorities

- Single priority



Example: difficulty with multiple priorities

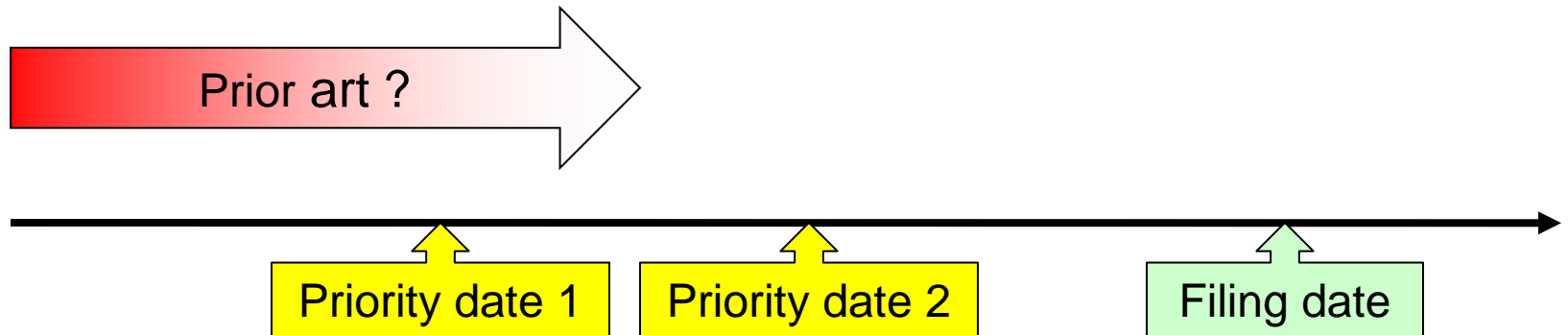
Rule 306. (PCT) Multiple Priorities. – An application can claim **more than one priority even from different countries**. If more than one (1) priority is claimed, time limits computed from the priority date will be based upon the earliest priority date; Provided, that the local application and the priority applications have common inventor(s) or applicant(s).

<> Art. 4 F Paris Convention

Section 76 (1)

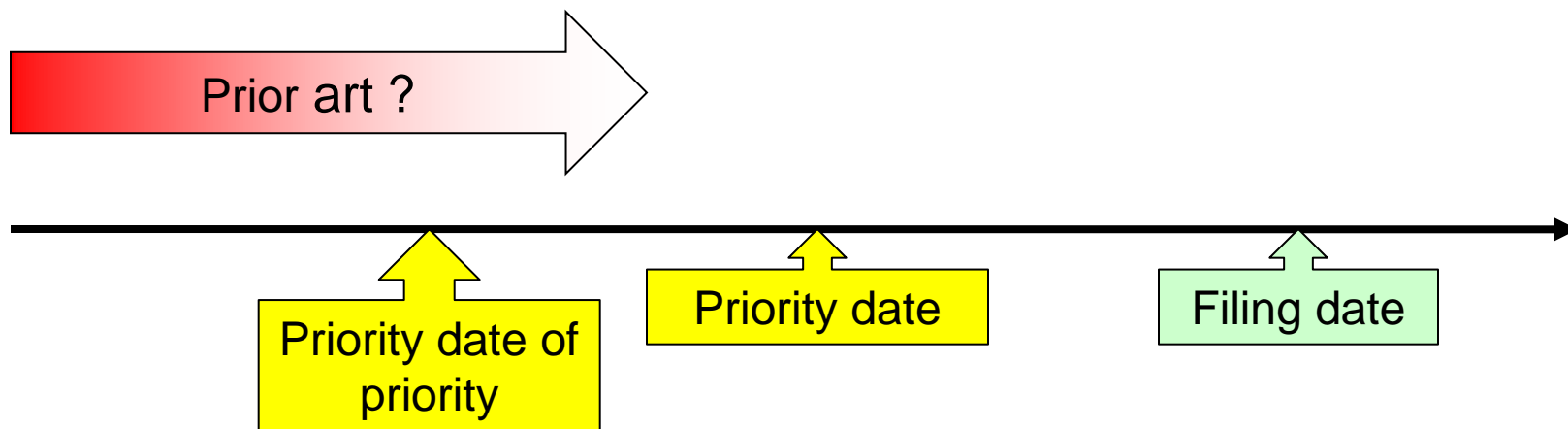
Example: difficulty with multiple priorities

- Different priority dates > different prior art



Example: Priorities with priorities

- Single priority which itself claims another priority



Conditions for claiming priorities

Conditions for claiming priority date

Section 76

- Application filed within 12 months after **first** filing (Art. 4 C (1))
- Explicit statement for claiming priority of earlier filing
- Time limits for claiming priority
 - Usually to be claimed with filing
 - Sometimes grace period
- **Certified copy of first filing** (+ translation) Why certified copy?
- Paris Convention: no explicit conditions apply for
 - Inventor and applicant names
 - **Additions of subject matter (are permitted)**

Conditions for applying priorities

- **Why certified copy? What if additions of subject matter?**
 - Some priority applications are never published, e.g. withdrawn before they are published
 - May be needed to confirm that claimed priority is indeed the first filing
 - Needed for comparison of disclosure of priority application and of application claiming the priority
- There are further **conditions for acknowledging validity of priority date for examination**, i.e. whether priority date determines relevant prior art:
 - All technical features of a claimed subject matter need to be disclosed in priority document

Conditions for claiming priorities

Rule 306.1. If one or more priorities are claimed, the **right of priority shall cover only those technical feature or features of the invention which are included in the application or applications whose priority is claimed.**

Rule 306.2. If the technical feature or features of the invention for which priority is claimed does not appear among the claims formulated in the previous application, priority may nonetheless be granted; provided, that the previous **application as a whole specifically discloses such technical feature or features.**

Claiming and applying priority date

Claiming priority

Applicant

Validating priority claim

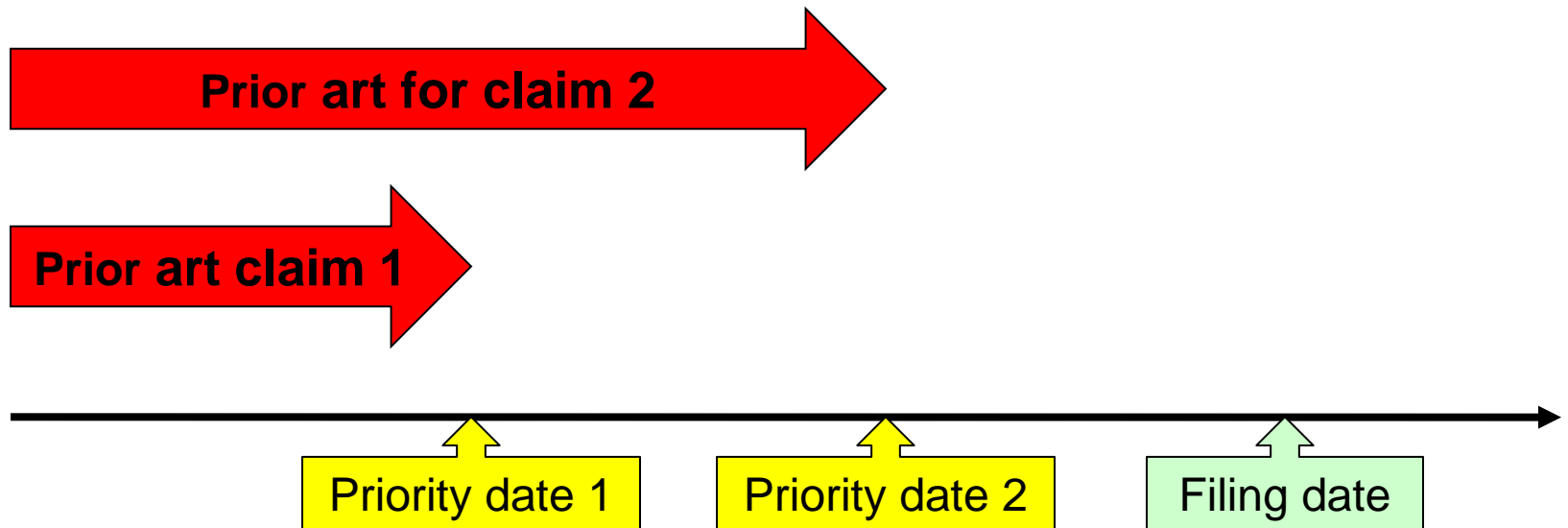
Examiner

Applying validly claimed
priority(ies) per claim

Examiner

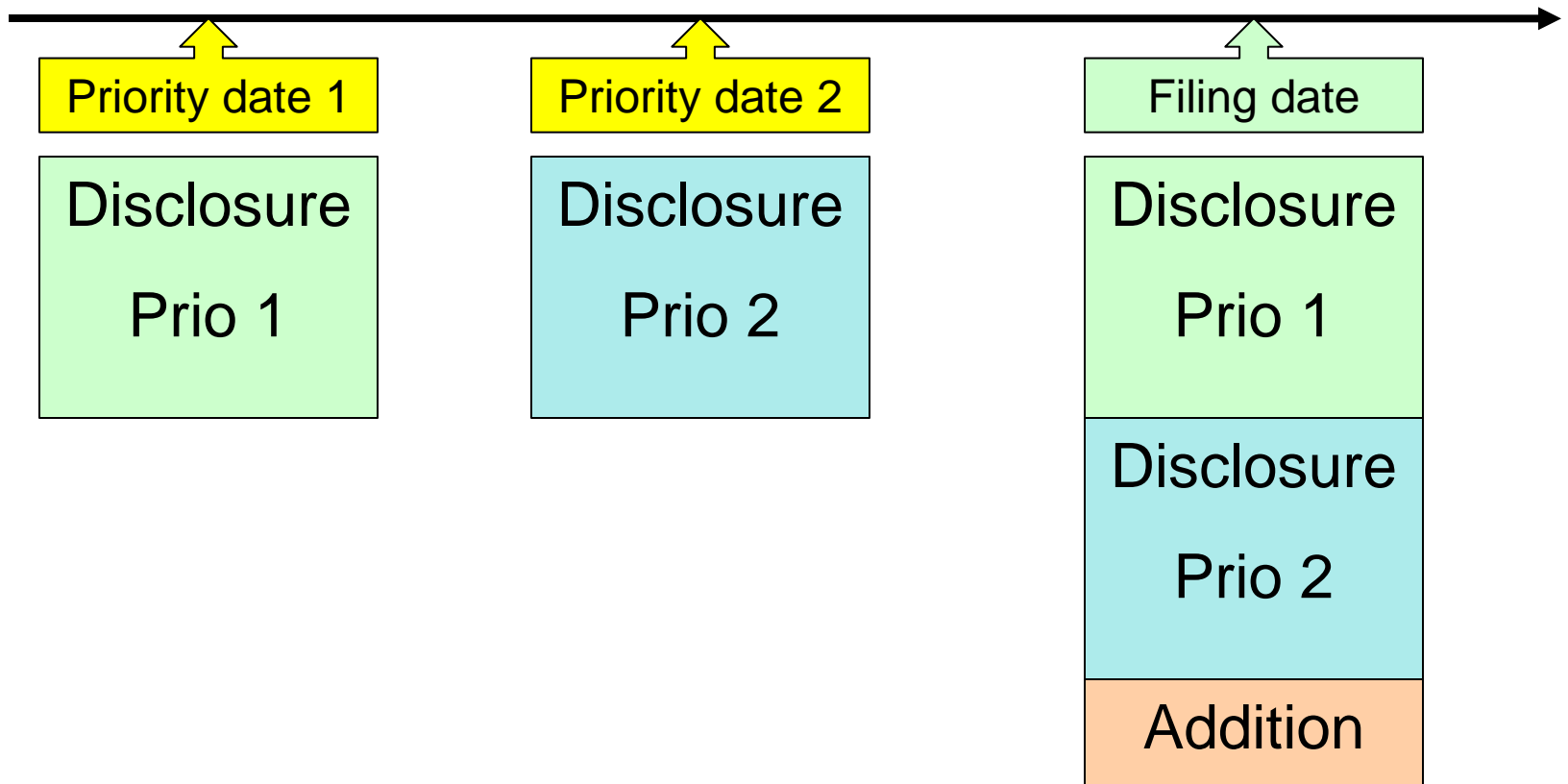
Difficulties with multiple priorities

- **For each claim** check which of the claimed subject matter is disclosed in which priority
- If claimed matter derives from different priority documents, different respective priority dates apply for determination of prior art



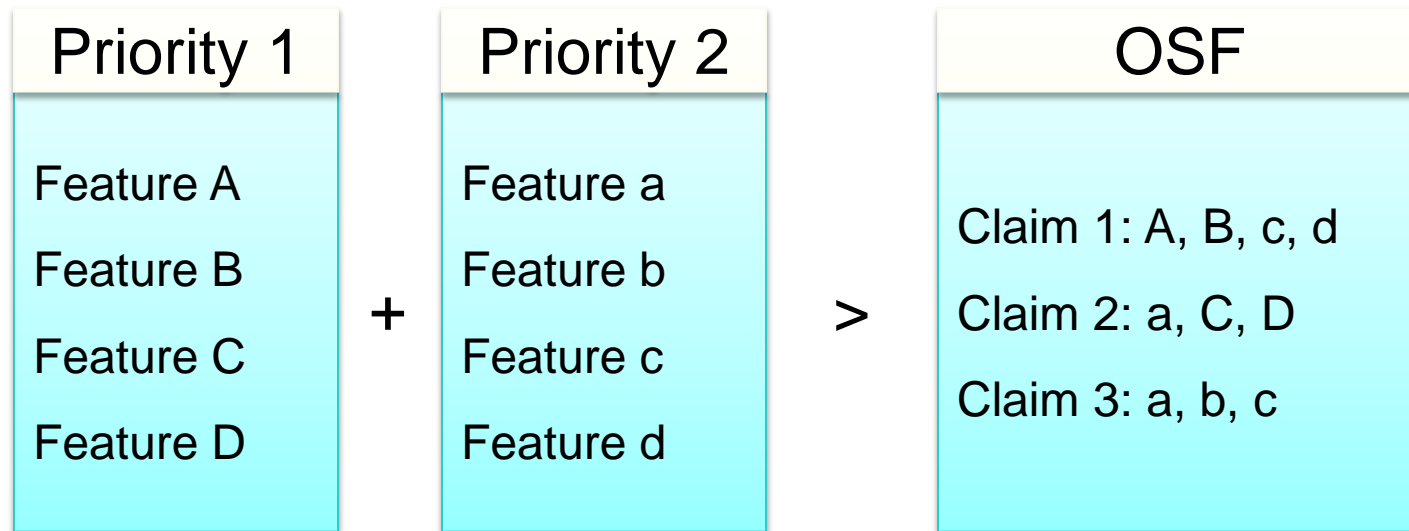
Multiple priorities

- Application claiming two different priorities



Difficulties with multiple priorities

- Combining different priority documents implies combination of different technical features



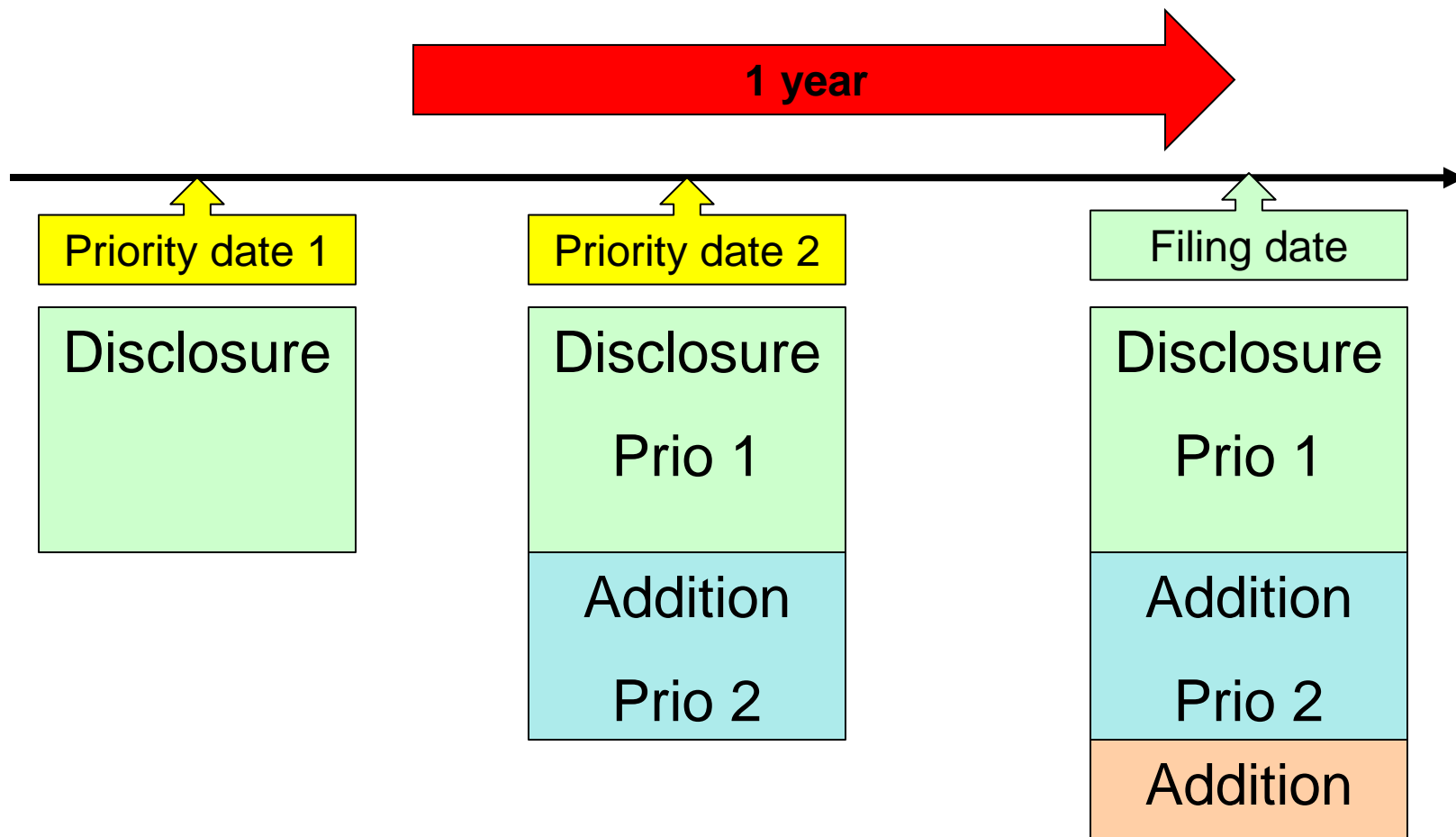
Rule of thumb

- If the claimed subject matter is **fully disclosed in the priority document**, then the priority date determines the relevant prior art,
 - Provided the claimed priority document is indeed the first filing of the claimed subject matter.
- If the claimed subject matter is **not** fully disclosed in the priority document, the filing date determines the relevant prior art
- This rule is applied claim by claim

Checking if claimed priority is first filing

- If the claimed priority itself claims a priority:
 - Priority is valid if the still earlier priority was never published, is withdrawn, abandoned, refused, and no rights are alive anymore,
 - Else, priority is valid for additions of art in priority document, i.e. only for features not yet disclosed in the priority of the priority (Paris Convention Art. 4 F)
- EPO does not acknowledge US continuations and continuations in part (except for additions) as first filings (EPC Examination Guidelines F VI 1.4)

Priorities and additions of subject matter

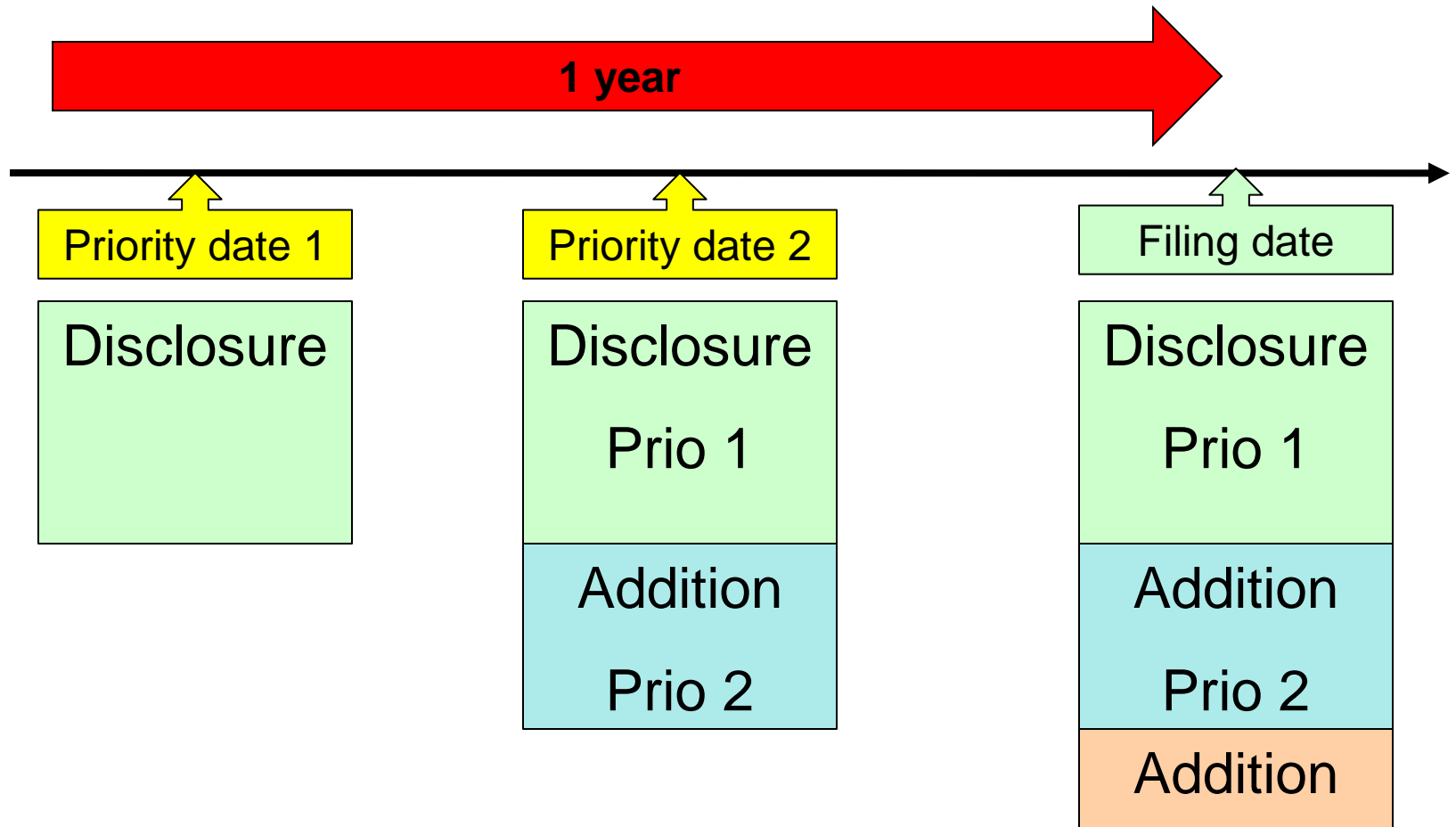


Exercise

What are the relevant dates for the determination of prior art if

- the application claims priority 1 and 2, or
- the application claims priority 2 which claims priority 1

Priorities and additions of subject matter



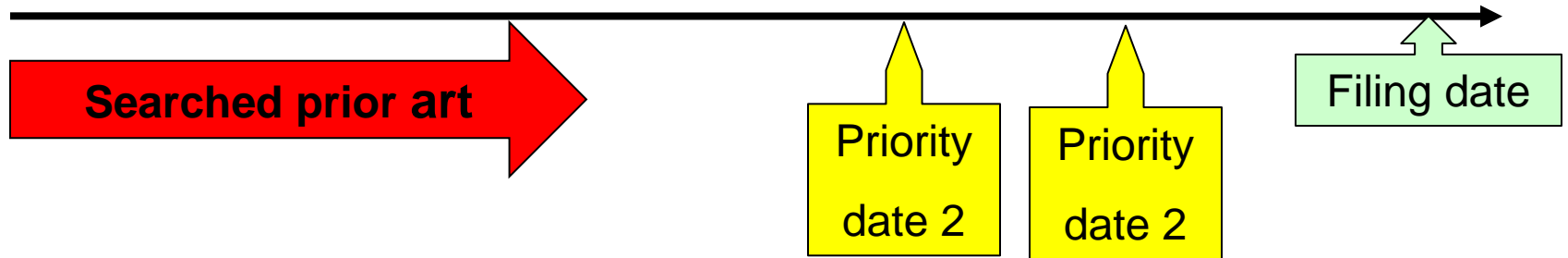
Exercise

What are the relevant dates for the determination of prior art if

- (i) the application claims priority 1 and 2, or
- (ii) the application claims only priority 2 which claims priority 1

Prior art and priorities

- When all relevant prior art documents are before the earliest priority date one need not worry about priorities even if there are several



Utilization of external work products

- Relevant prior art depends on priorities !!
- Check which priorities have been claimed in each of the offices of which you utilize work products and compare with the priorities claimed for your application
- It all depends on the respective claims to be examined !!

Thank you

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