

GERMANY



**Maiwald Patentanwalts
GmbH
Munich**

Norbert Hansen

Different disclosure standards for novelty and priority

A priority claim is valid only if all features of a technical teaching described by a patent claim can be derived, directly and unambiguously, from the disclosure of the priority document. In a recent nullity case (BGH X ZR 3/10), the German Federal Supreme Court (BGH) overruled the Federal Patent Court (BPatG), which had decided that a patent claim enjoys priority even if one of its features is only implicitly, but not directly and unambiguously disclosed in the priority document.

In the case in question, an intermediate prior art document included a process feature that the components of a photosensitive composition have to be selected such that their solubility in an aqueous developer is not increased by impinging UV-radiation. This feature was not literally disclosed in the priority document, but only some of the embodiment examples disclosed compositions which in fact were insensitive to UV-light, when tested.

At first instance, the BPatG ruled that since the priority document does not include an indication that the example compositions should be handled under protective light, a skilled person would conclude that the compositions must be insensitive to UV-light. The BGH overruled this decision and argued that the missing indication in the priority document to work under protective light is at least ambiguous. The BGH concluded that it is not sufficient for a valid priority claim if an important feature of a technical teaching can only be detected by the skilled person upon repeating the embodiment examples of the priority document. With this finding, the BGH followed the decision of the EPO Appeal Board in the same case in an opposition appeal against the same patent.

The BGH emphasised that the same criteria for direct disclosure would also apply when assessing inadmissible broadening beyond an application in its originally filed version, and that these standards are more strict than those

applied in a novelty analysis. For novelty, the BGH stated that prior knowledge of a method, which, when reproduced, necessarily results in a product or a state objectively having the property required by a claimed invention, would anticipate such an invention.

Applicants are therefore reminded that for novelty and validity of a priority claim, different standards might apply for the same disclosure.