

GERMANY



**Maiwald Patentanwalts
GmbH
Munich**

Andrea Lasar

Federal Supreme Court clarifies priority issues

In its decision “Kommunikationskanal“ (X ZR 107/12) of February 11 2014 the Federal Supreme Court discussed the criteria for claiming the priority of an earlier application. It appears to adopt a more liberal approach than the EPO Boards of Appeal.

According to Article 87 EPC, a right of priority may be claimed for the same invention. If certain elements of the invention for which priority is claimed do not appear among the claims formulated in the previous application, priority may nonetheless be granted, provided that the documents of the previous application as a whole specifically disclose such elements (Article 88(4) EPC).

In the case at issue here, the German Federal Patent Court as court of first instance had declared the patent-in-suit invalid, holding that it could not validly claim the priority of the earliest prior applications and was consequently anticipated by documents published in the priority period. In the opinion of the Federal Patent Court, these prior applications contained specific information on the features of a data channel and a control channel, whereas the patent-in-suit generally claimed a data channel and control channels, that is the claims were not restricted to this specific information.

The Federal Supreme Court annulled this decision. It confirmed its established case law that when evaluating whether the same invention is claimed, it has to be determined what the skilled person would directly and unambiguously derive from the earlier application(s). It stated that the priority of an earlier application can be validly claimed, if the technical guidance described therein, either through an embodiment example or otherwise, represents for the skilled person an embodiment of the general technical teaching paraphrased in the later application, and if this teaching which is disclosed in general terms in the later application can be derived from the earlier application as belonging to the claimed invention. Applying this principle, it found

that the skilled person would not derive from the prior applications that the specific features disclosed therein contribute to, and much less are necessary for, the solution of the technical problem. Consequently, the general technical teaching of the later application can be directly derived from the specific embodiment in the priority application.