

# Implementation of G 1/22 and G 2/22 by the EPO and various Courts

## EPO decision G 1/22 and G 2/22

### Introduction

The EPO strictly distinguishes between the right to the invention/patent (initially with the inventor) and the right to priority (arising with the priority filing and, therefore, initially with the applicant of the priority application) (e.g. T 1201/14). The right to the invention/patent relates to the entitlement to the invention and is governed by national law. According to G 1/22 (consolidated with G 2/22) of the Enlarged Board of Appeal of the EPO, the right to priority relating to the entitlement to the priority («formal priority right») is created under the autonomous law of the EPC and governed by Art. 87 to 89 EPC (within the framework of the Paris Convention). The EPC provides no formal requirements for the transfer of the priority

right, such as regarding formalities or retroactive transfers. Therefore, according to G 1/22, the lowest formal requirements are applicable (Reasons 99, 100).

### Introduction of a rebuttable presumption approach

In G 1/22, the Enlarged Board of Appeal has established a strong rebuttable presumption that the applicant is entitled to claim priority, in general (Headnote I). **This shifts the burden of proof to the effect that the party contesting the right to priority must more or less prove that this right is actually lacking.** The presumption is a strong one (G 1/22, Reasons 110). The intention of the Enlarged Board of Appeal was to ensure that the priority is challenged less frequently in opposition proceedings (G 1/22, Reasons 117).

## Introduction of an implied agreement approach

The Enlarged Board of Appeal also established the concept of an implied agreement. In the case underlying G 1/22, the mere fact of the joint filing of a subsequent PCT application is sufficient for the parties to apparently have entered into an implied agreement to the effect that an additional subsequent applicant may invoke the priority right conferred by the filing of the priority application by another subsequent applicant or other subsequent applicants (G 1/22, Headnote II).

## Outlook

The first cases in which the EPO Opposition Divisions and Boards of Appeal implement the new concepts introduced by the Enlarged Board of Appeal in G 1/22 are out; also other courts, such as the German Federal Supreme Court, the Federal Patent Court of Switzerland and the UPC have referred to these new concepts. To what extent these have been adopted, is discussed in the following.

## EPO: T 2360/19

While there have been a few instances in which the Boards of Appeal have followed G 1/22 where there was no attempt at rebuttal (e.g. T 2643/16), T 2360/19 is the first occasion on which the Boards of Appeal have dealt with an attempt to rebut the rebuttable assumption. This is perhaps not surprising: After all, in G 1/22, the Enlarged Board referred to T 844/18, which dealt with EP 2 771 468, the parent patent to the patents under appeal in T 2360/19, several times despite not being concerned with this patent family (see Reasons 29, 33, 39, 47, 58, 91, 128, and 137 of G 1/22). Similarly, the Broad Institute, one of the proprietors of EP 2 771 468 B1 and its divisional patents, submitted an Amicus curiae brief in G 1/22.

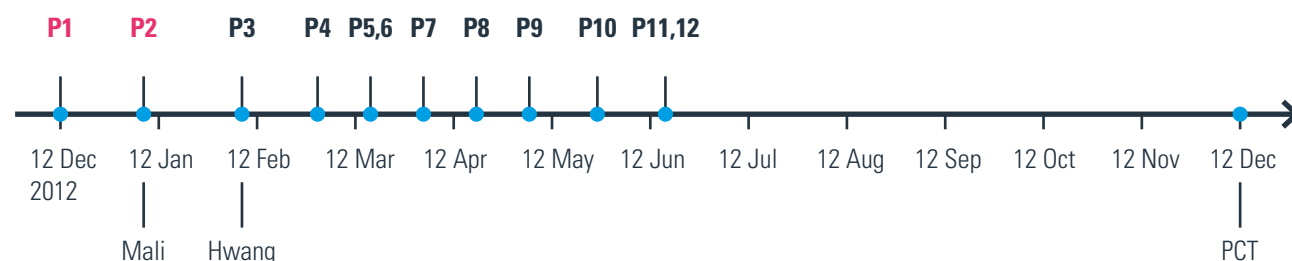
The priority situation in T 844/18 and T 2360/19, which pertain to the Broad Institute's, MIT's and Harvard College's (hereinafter collectively referred to as »the Broad«) key patent family directed to use of CRISPR/Cas9 in eukaryotes, is complex. The patents draw the priority of 12 priority applications, P1 to P12, as depicted below:

Of particular importance are the first (P1) and second (P2) priority applications, which were filed before (P1) or at the same time (P2) as a scientific publication by members of the same group, Mali et al. Science. 2013 Feb 15; 339(6121):823-6. Mali et al. discloses the use of CRISPR/Cas9 (with one NLS on Cas9) in eukaryotes. Loss of at least P1 and P2 would therefore result in a lack of novelty over Mali et al. in this respect. Crucially, P1 and P2 (along with P5 and P11) list Luciano Marraffini of the Rockefeller University as an applicant, while the PCT application lists neither Mr. Marraffini nor the Rockefeller University. Mr. Marraffini automatically assigned his right to P1 and P2 to the Rockefeller University per his employment contract, and neither he nor the Rockefeller University had formally assigned the right to P1 and P2 to the Broad.

Following the »all applicants« approach, the Opposition Division held that there was no entitlement to P1 and P2 in parent patent EP 2 771 468 and divisional patents EP 2 784 162, EP 2 764 103 and EP 2 896 607. Due to Mali et al. becoming full prior art as a result, the Opposition Division revoked EP 2 771 468, EP 2 784 162, and EP 2 764 103 for lack of novelty and maintained EP 2 896 607 in a severely narrowed form. In T 844/18, which dealt with parent patent EP 2 771 468, the Board confirmed the Opposition Division's decision and finally revoked the patent.

Upon the referral to the Enlarged Board, the Broad requested consolidation of the appeal proceedings for divisional patents EP 2 784 162, EP 2 764 103 and EP 2 896 607 in T 2360/19 and a stay of proceedings while G 1/22 was pending. This request was granted by the Board, and evidently served the Broad well.

The Enlarged Board, referring to T 844/18, held in G 1/22 that »[a]n agreement (regardless of its form) can only be held against parties who were involved in the facts establishing the agreement. Co-applicants for the priority application who were not involved in the subsequent application may not be deemed to have consented to the reliance on the priority right by the other co-applicants for the priority application (a situation underlying e.g. T 844/18). **The subsequent applicant(s) may however still be entitled to claim priority since the rebuttable presumption of entitlement does not depend on whether the involved applicants acted as co-applicants at any stage**« (Reasons 128; emphasis added).



The Enlarged Board further stated, again referring to T 844/18, that *»[i]n specific contexts, a priority applicant missing from the subsequent application may have reasons to claim the title to the subsequent application (in proceedings before national courts) or may possess evidence to rebut the presumption of priority entitlement in proceedings before the EPO«* (G 1/22, Reasons 137).

That is, it appears that the Enlarged Board already hinted at how the matter of priority should have been handled in T 844/18, providing clear guidance to the Board handling T 2360/19.

The Opponents in T 2360/19 then attempted to rebut the rebuttable assumption based on a heated public disagreement in the United States in which Mr. Marraffini and the Rockefeller University sought to have Mr. Marraffini be named as one of the inventors and the Rockefeller University be named as one of the proprietors of the PCT application underlying the European patents at stake in T 2360/19. This inventorship and ownership dispute was resolved only in January 2018 by independent arbitration, which determined that Mr. Marraffini should not be named as an inventor and the Rockefeller University should be named as a proprietor. The dispute was not concerned with the right to priority, and the opponents argued that it followed that a) there was no explicit agreement about a transfer of priority rights, and b) it could not be presumed that there was an implicit transfer, either.

The Board however held that the priority dates of P1 and P2 were indeed validly claimed and referred to G 1/22 in this regard. The Board reiterated that the rebuttable presumption *»involves the reversal of the burden of proof, i.e. the party challenging the subsequent applicant's entitlement to priority has to prove that this entitlement is missing. Just raising speculative doubts - even if these are „serious« as in the words of the Enlarged Board (G 1/22, Reasons 110, 113) - is not sufficient: to put into question the subsequent applicant's entitlement to priority, (full) evidence would be needed* (see reasons 110, 126)« (T 2360/19, Reasons 9; emphasis added). The Board held that since the inventorship dispute was not concerned with priority entitlement, it indeed does not provide evidence that the Broad is entitled to the priority rights they claim. However, according to the Board, *»this is precisely what the presumption in G 1/22 states: that the appellants do not have to provide such evidence, but the opponents have to rebut the presumption«* (T 2360/19, Reasons 16).

As a consequence, the Board found that there was *»no evidence that rebuts this presumption in the present case«* (see Reason 17) and that, since the inventorship dispute had in the meantime been settled, *»[i]f at all, there is evidence to the contrary, which supports the presumption*

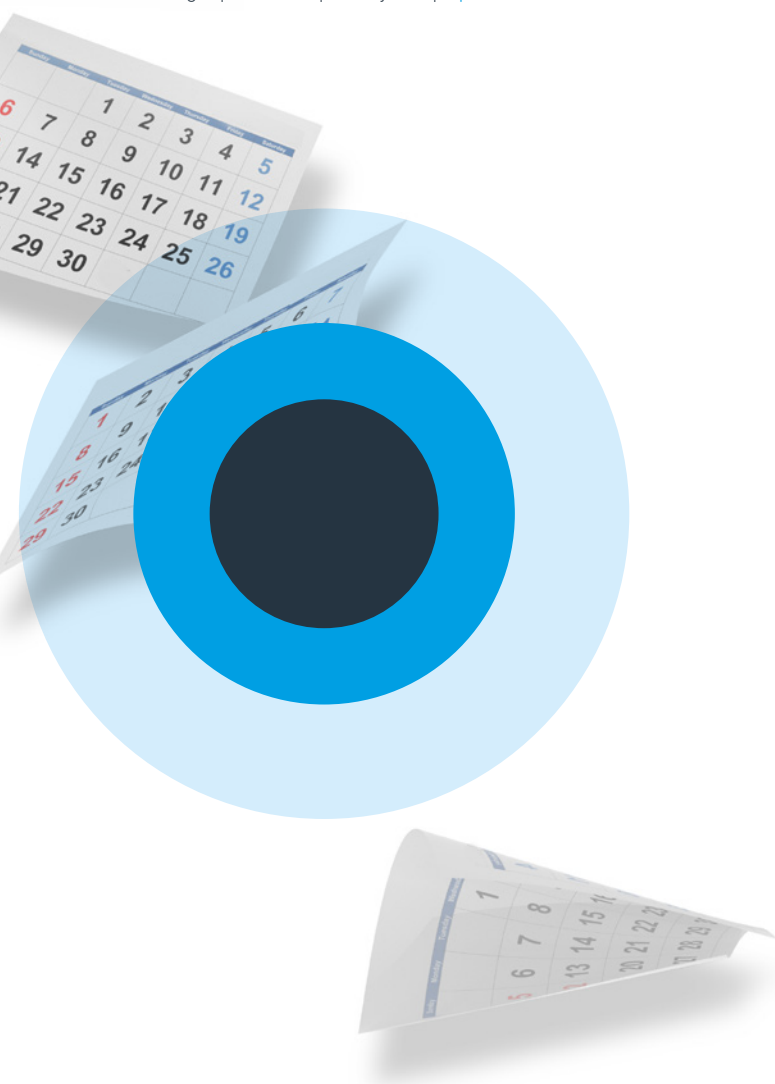
*of an implied transfer agreement«* (T 2360/19, Reasons 18). Interestingly, the Board held that the very fact that Mr. Marraffini and the Rockefeller University sought to be added as inventor and proprietor, respectively, made it *»not credible that Marraffini or the Rockefeller University would have acted in a way to invalidate the priority claim of a patent they were seeking to be named as inventor of, and owner of, respectively«* (T 2360/19, Reasons 21). Finally, the Board clarified that *»even in the absence of any evidence regarding the settlement of the inventorship dispute, the result would have been the same, based on the presumption of a valid priority claim, which has neither been rebutted by this nor any other evidence on file (see again G 1/22, reasons 100)«* (T 2360/19, Reasons 25). Therefore, the Board found the priority claims to be valid and remitted the case to the Opposition Division for further prosecution.

T 2360/19 thus seems to solidify that it will **essentially be impossible** to rebut the rebuttable presumption of validity, effectively removing „all applicant« objections from opponents' arsenals. This is especially evident from the fact that T 2360/19, in accordance with G 1/22, notes that priority entitlement may be decided in national proceedings but also outside the courts, by way of amicable settlement or arbitration, but that *»there is always a party who is entitled to claim priority and that this right is not „lost« somewhere in an inventorship dispute«* (T 2360/19, Reasons 26).

## Germany

The German Federal Supreme Court referred to G 1/22 for the first time in the decision Sorafenib-Tosylat (X ZR 83/21) of November 2023. The headnote says that the joint filing of a PCT application in which the applicant of the priority application is named for one or more designated states, and another applicant (more precisely »person«) is named for one or more other designated states, implies an agreement of the applicants (more precisely »parties involved«) that the other applicant (more precisely »person«) is entitled to claim priority. The Senate expressly adopted G 1/22 and the strong, rebuttable presumption established therein in this regard, stating that the G-decision is well founded (margin no. 110, 111).

In line with this, the headnote of the decision Sorafenib-Tosylat says that in nullity proceedings the burden of proof regarding the requirements for a valid priority claim is with the Plaintiff. This shifts away from previous German case law according to which the burden of proof for lack of entitlement to priority was with the Plaintiff (BeckRS 2013, 13744; GRUR 2022, 353).



The German Federal Supreme Court further states in its decision that **contracts the Defendant (Proprietor) had submitted do not exclude that individual agreements, possibly conclusively, exist** (margin no. 116). This is in line with established German case law that no formal transfer of a priority right is required (X ZR 49/12 – Fahrzeugscheibe; X ZR 14/17 – Drahtloses Kommunikationsnetz).

However, here, the German Federal Supreme Court did not expressly refer to the autonomy of the EPC as regards the formal priority right nor indicate potential constellations indeed allowing to rebut the presumption. In this regard, concerns have been raised in the literature to what extent the Federal Supreme Court actually adopts the new EPO practice (GRUR Patent 2024, 236, margin no. 19). Specifically, **it remains to be seen whether the German Federal Supreme Court will indeed interpret the burden of proof being with the Plaintiff as corresponding to the EPO's strong rebuttable presumption for the validity of the priority entitlement.** The Enlarged Board expressly - and correctly - notes the national courts' freedom in this regard, in particular that national courts are not bound by the EPO's assessment (G 1/22, Reasons 115).

In the later decision Happy Bit (X ZR 74/21) of January 2024, the German Federal Supreme Court confirmed the Sorafenib-Tosylat decision and presented a similar reasoning.

## Switzerland

Switzerland has also since followed G 1/22 in decision O2022\_007 of 5 March 2024 by the Federal Patent Court of Switzerland (Mepha Pharma AG vs Bristol-Myers Squibb Holdings Ireland Unlimited Company), albeit not in all points. In this case, the proprietor of the priority application was a different entity than the proprietor of the later patent.

The Swiss Federal Patent Court addressed G 1/22's reversal of the burden of proof established in Reasons 110 and 113 in detail and determined that, while any decisions by the Boards of Appeal of the EPO are not binding for Swiss courts but should be considered when interpreting Swiss law, the reversal cannot be applied to Switzerland: **»The burden of proof that WO 652 validly claims the priority of the first application US 165 therefore lies with the defendant as the holder of the property rights«** (Reasons 29; emphasis added). Apparently, Switzerland thus maintains that the burden of proof for establishing entitlement to priority remains with the proprietor, contrary to G 1/22. This appears to be a consequence of Art. 20(1) of the Swiss Patent Act, expressly requiring the proprietor to prove the existence of the priority right in the case of legal proceedings.

However, in an interesting twist, the Swiss Federal Patent Court then went on to establish that *»while the assessment of evidence by the Enlarged Board of Appeal is not binding for Swiss courts (E. 29), Swiss courts can of course follow the considerations of the Enlarged Board of Appeal if they are convincing.«* (Reason 30).

That is, despite holding that the reversal of the burden of proof cannot be in agreement with Swiss law, the Swiss Federal Patent Court **still applies the Enlarged Board's rebuttable assumption** (which the Enlarged Board intends to entail the reversal of the burden of proof). Indeed, the Swiss Federal Patent Court holds: *»Rather, it can be assumed that BMS Pharma provided the documents in the knowledge that BMS Company needed them to claim the priority of the initial application US 165 and agreed to this use«* and that *»[t]his is not one of the »rare exceptional cases« referred to by the Enlarged Board of Appeal which would overturn the conclusion that the subsequent applicant, who had access to the priority documents, acted with the consent of the first applicant«* (see Reason 30, emphasis added).

It remains to be seen, however, if, and if so, how, Switzerland will apply the rebuttable presumption in an *»all applicants«* approach where one or more applicants are missing, but others remain.



## UPC

In the decision concerning the proceedings UPC\_CFI\_255/2023 and UPC\_CFI\_15/2023 dated 19 July 2024, the Court of the First Instance of the Central Division (Paris seat) dealt with a priority issue. In the case underlying this decision, allegedly only the rights to the invention/patent were expressly assigned from the applicant of the priority application to the applicants of the subsequent application, but not the right to priority.

The Panel recognized that the priority right is distinct from the right to the subsequent patent (application). As such, the priority right is not automatically transferred with the transfer of the right to the title, but requires a specific dispositive act (margin no. 87 of the decision). The Panel concluded that there is a rebuttable presumption to priority in favor of the subsequent applicant (margin no. 90), as *»all these facts establish a rebuttable presumption of the entitlement to priority in favor of the subsequent applicant, provided the latter can demonstrate the acquisition of the right to the title.«* In this case, since the Plaintiff *»has not provided any evidence to suggest that the priority rights were the subject of a separate dispositive act in favor of third parties or that the original applicants intended to retain them instead of transferring them along with the rights to the title, the presumption is not rebutted«* (margin no. 91). The Panel acknowledged that agreements regarding the transfer to the right to the invention rarely address a transfer of the priority right, which is implicitly treated as a mere ancillary right to the right to the subsequent application (margin no. 88).

Here, it appears that the UPC looked more closely at the priority issue than the EPO would have done, as the rebuttable presumption was only established since the Proprietor could prove the acquisition of the right to the invention/patent. It remains to be seen whether the UPC will indeed adopt the same, strong rebuttable presumption as established by the EPO.

## Discussion and Summary

Although a number of jurisdictions appear to »like« the EPO approach, it remains to be seen whether these and other courts will indeed implement the criteria for rebutting the strong presumption in the same, very strict way as the EPO. For example, under German law, the matter may boil down to the question whether the Plaintiff has fulfilled their burden of proof, rather than whether a strong presumption has been rebutted. Also, national courts (possibly not the UPC) dealing with issues regarding entitlement to the invention may take another approach regarding the entitlement to the priority right as well.

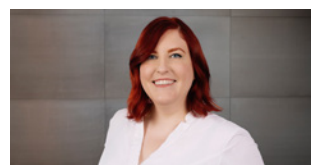
Before the EPO, it may practically be impossible to invalidate the formal priority claim, as successfully rebutting the presumption may realistically be limited to situations involving acting under bad faith, e.g. involving a criminal act in the sense of stealing information on priority documents and filing thereof. The EPO's drivenness on validity of the formal priority has the consequence that the likelihood for a patent to be revoked for lack of patentability is reduced. Hence, **more patents are expected to survive EPO opposition proceedings.**

For patents that have survived EPO opposition proceedings due to the EPO's presumption that the formal priority claim is valid, there may be another, more »promising« opportunity to challenge the validity, namely in subsequent invalidity proceedings before the UPC or before national courts (against national parts of the EP patent). Hence, it may turn out that EP patents actually having »formal priority issues« are more successfully attackable in other invalidation proceedings than EPO opposition proceedings.

From another point of view, this may mean that, prior to G 1/22, the situation may have occurred that an EP patent was revoked because of (prior art only relevant due to) lack of the formal priority right in EPO opposition proceedings. The revocation of the patent by the EPO would have rendered any national, possibly more lenient practice on formal priority issues void. However, by way of the new concepts of G 1/22, the **EPO allows national courts/the UPC to hand down a final decision on the formal priority claim.** This may result in a shift of substantive examination of the validity of the formal priority claim to proceedings outside the EPO.



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