Moritz Hönig | Alfred Köpf

Priority: Shield and Sword (of Damocles) – Decision T844/18 («CRISPR/Cas9»)

Das EPÜ und die Paris Verbandsübereinkunft erfordern für eine gültige Inanspruchnahme der Priorität unter anderem, dass der Anmelder der Folgeanmeldung auch Anmelder der früheren, prioritätsbegründenden Anmeldung oder dessen Rechtnachfolger ist. Das EPA hat bei der Beurteilung dieses Kriteriums eine besonders strenge Praxis entwickelt, welche verlangt, dass alle in der früheren Prioritätsanmeldung benannten Anmelder oder deren Rechtsnachfolger in der späteren Anmeldung als Anmelder genannt sein müssen. Obwohl dieser so genannte «Alle Anmelder»-Ansatz in den meisten nationalen Jurisdiktionen weitgehend übernommen wurde, ist er Gegenstand kontroverser Diskussionen und heftiger Kritik. Das EPA hat seine strenge Praxis kürzlich in einem viel beachteten Fall im Zusammenhang mit der revolutionären CRISPR/Cas9-Technologie bekräftigt, für die im Jahr 2020 der Nobelpreis für Chemie verliehen wurde.

La CBE et la Convention d'Union de Paris requièrent pour la validité d'une revendication de priorité notamment que le demandeur de la demande ultérieure soit également le demandeur de la demande antérieure fondant la priorité ou son ayant cause. Dans son interprétation de ce critère, l'OEB a développé une pratique particulièrement stricte et requiert que tous les demandeurs mentionnés dans la demande antérieure fondant la priorité ou leurs ayants cause soient désignés en tant que demandeurs dans la demande ultérieure. Bien que l'approche «mention de tous les demandeurs» ait été reprise dans une large mesure par la plupart des juridictions nationales, elle fait l'objet de débats et de vives critiques. L'OEB a récemment affirmé sa pratique stricte dans un cas très suivi concernant la technologie révolutionnaire CRISPR/Cas9, pour laquelle le prix Nobel de chimie a été décerné en 2020.

I. Introduction

The priority concept is one of the cornerstones of the Paris Convention for the Protection of Industrial Property and is implemented in one form or another in virtually every patent system in the world. Especially in fast-moving and disruptive technical fields, the priority right is an essential element in any patent prosecution strategy.

In order to beat competitors in the race for an early priority date, applicants struggle with the tradeoff between a perfectly finished application and a fast filing. The latter often makes amendments and revisions necessary within the priority year which poses a first threat to the priority claim. In particular, the strict requirement of «the same invention» established by the EPO's Enlarged Board of Appeal[1] can lead to lost or partial priorities. In case of the latter, decision G1/15 delivered an «antidote to poisonous priority»[2]. However, change of control situations, collaborations, additional inventors and other common dynamics in disruptive fields present further pitfalls faced by applicants, which have to be avoided.

The present article focuses on the above-mentioned issues regarding the applicants, for which the EPO has established the so-called «all applicants» approach. This approach requires that all applicants of a priority application, or their successors in title, must be named as applicants on the subsequent application in order to validly claim its priority.

The «all applicants» approach has been the subject of intense controversy for years and has been widely criticized for being unduly restrictive for patent applicants and for effectively transforming the priority right from an enabling right available to patent proprietors into a weapon that may be used against them.[3] The controversy reached a dramatic climax early in 2020, when an EPO Board of Appeal held four-day long oral proceedings in deciding about a European patent relating to the revolutionary CRISPR/Cas9 technology, for which the Nobel Prize in Chemistry would be awarded later that year.

II. CRISPR/Cas9 Technology

Originally discovered in the context of the adaptive immune system of bacteria, the CRISPR/Cas9 system has been developed into a biotechnological tool that has revolutionized numerous fields, from agriculture to medicine, from

Moritz Hönig, Dr. sc. ETH, Patent Engineer, Zurich.

Alfred Köpf, Dr. sc. nat. ETH, European and Swiss Patent Attorney, Zurich.

The english translation of the lead and summary is included online only.

1 EPO Enlarged Board of Appeal decision G 2/98 with Swiss Chairman P. Messerli.

2 R. Shelton at ‹www.vennershipley.co.uk/wp-content/uploads/2020/07/An_antidote-3.pdf›.

3 For exemplary blogs discussing different views, see A. Merelle Ward at ‹ipkitten.blogspot.com/2019/05/fordham-27-report-14-priority.html›; and M. Wilming at ‹https://www.patentlitigation.ch/the-epo-assesses-all-aspects-of-entitlement-to-priority-rightly-so/›.