

T844/18 Oral Proceedings 13th– 17th January 2020; Setting the Scene (Day 0)

During the week of 13th January 2020, Board of Appeal 3.3.08 at the EPO will hear oral arguments in the matter of the appeal of the revocation of European Patent 2771468.

[EP2771468](#) (“the Patent”) was granted in the names of The Broad Institute, Inc., Massachusetts Institute of Technology, and President and Fellows of Harvard College (“the Patentees”). The grant of the Patent was subsequently opposed by nine parties (“the Opponents”), and at the end of those opposition proceedings the Patent was revoked.

The Board of Appeal proceedings are of general importance and interest for at least two main reasons.

Firstly, the Patentees are one of a handful of groups who are each trying to claim that they were the first to provide useful gene editing technologies using CRISPR techniques; those groups have been very active in various patent jurisdictions, trying to defend and justify their claims, meaning that, for example, there has been some confusion among third parties regarding who they should seek to license this valuable and promising technology from. So there is considerable interest in the fates of the Patents and Applications that the various groups, including the Patentees, have filed.

Secondly, the Patent was revoked because the Opposition Division decided that the earliest dates associated with the Patent had not been validly claimed; in order to overturn this part of the decision, the Board of Appeal would have to accept the Patentees’ arguments that the EPO have been incorrectly assessing such priority claims. Such an acceptance could have important implications for how such matters are assessed for other Patents, with the validity of many other Patents potentially dependent on the assessment.

The Key Facts

The Patent claims priority from the filing of 12 earlier US provisional applications. The 2 earliest of those applications (“P1” and “P2”) named a group of people as inventors and, since the applications were filed before the America Invents Act came into effect in the US, those inventors were also the applicants for the applications. Luciano Marraffini was one of those inventor/applicants.

However, when the international application, which resulted in the Patent in Europe, was filed, Luciano Marraffini was not named as an applicant. In addition, none of the applicants that *were* named on the international application appeared to own Luciano Marraffini’s priority rights in P1 and P2, and the Patentees for the granted Patent could not provide evidence to show that the priority rights had indeed been duly transferred by the filing date of the international application.

[Article 87\(1\) EPC](#) is relevant to this situation. The EPO have, over time, interpreted this provision to mean that when an application (the “subsequent application”) is filed that claims priority to one or more earlier applications, the applicants for the subsequent application must own the priority rights in the earlier application(s) on the day that the subsequent application is filed. In addition, they must own the priority rights belonging to each and every one of the applicants named on the earlier application(s).

The Opposition Division decided that the applicants did not own the priority rights as required for the earliest priority claims of the Patent, so that the Patentees could not rely on the filing dates of P1 and P2 as the date on which the patent should be assessed. This meant that scientific articles, which

had been published after P1 and P2 were filed, became relevant and took away the novelty of the invention in the Patent. The Patent was revoked for this lack of novelty.

The Patentees' Arguments and Requests

The Patentees appealed the revocation by the Opposition Division. They have submitted three main arguments to the Board of Appeal in writing in support of the validity of the priority claims in the Patent:

1. The EPO should not generally assess whether applicants are entitled to priority rights, but instead should leave this to national courts;
2. If the first argument is not accepted, then anyway the "any" person who may file according to Article 87 EPC should be read as "any one" person, individually, so that there is no need to own the priority rights of *all* the applicants named in the priority application(s); and
3. If neither of the first two arguments are accepted, then it should be accepted that according to US law, since Marraffini did not contribute to the aspect of the invention claimed in the Patent, he is not an "any person" who has duly filed the US priority applications with respect to that subject-matter. Therefore the correct applicants were named in the international application for the purposes of the priority claim.

The Patentees have also asked for questions, based on these arguments, to be referred to the Enlarged Board of Appeal.

Board of Appeal's Approach

The Board of Appeal has set aside 4 ½ days for the oral proceedings.

In their preliminary opinion that was added to the register on 30th October 2019, the Board have said that the first ½ day of the proceedings will be devoted to establishing the requests of each party. The Board has also said that it only intends to hear arguments with respect to priority and novelty, and that if they decide to overturn the Opposition Division's decision, then they will remit the case to the Opposition Division for further prosecution.

They have summarised the core issue of the proceedings as follows:

"A and B are applicants for the priority application. A alone is the applicant of the subsequent application. Is this priority claim valid even without any assignment of priority right from B to A?"

The appellants say that the answer is "yes" and the respondents that it is "no".

They have accepted that they will need to weigh up various factors, including public policy concerns, in reaching a decision, and that they will decide at the oral proceedings whether questions need to be referred to the Enlarged Board.