

### 5.3.1 Development of the case law after G 2/98 in respect of generically formulated "OR" claims

In the period that followed G 2/98 (OJ 2001, 413), the above-mentioned proviso of the Enlarged Board in respect of generic "OR" claims gave rise to divergences in the jurisprudence of the boards. These led to a further ruling by the Enlarged Board in G 1/15 (OJ 2017, A82); see also chapter II.D.5.3.2 below).

In some of those cases, subject-matter disclosed in the priority document and falling within the generically formulated claim of the subsequent European application was denied (partial) priority because the terms of the proviso were found not to be met. Such approach could sometimes lead to a "collision" under Art. 54(3) EPC with another member of the same European patent family (particularly in situations involving what is sometimes referred to as a "toxic priority" or "poisonous divisional" – see also T 557/13 of 17 July 2015, OJ 2016, A87, summarised in the next section). In G 1/15 (OJ 2017, A82), the Enlarged Board observed that in a number of decisions the words of the proviso had been understood as a further test to be complied with for a claim to partial priority to be accepted, an interpretation which the Enlarged Board rejected. Accordingly, G 1/15 has overruled the approach taken in T 1127/00, T 1443/05, T 1877/08, T 476/09, and other decisions mentioned in G 1/15, point 2.2 of the Reasons.

However, other decisions issued after G 2/98 acknowledged partial priority in comparable circumstances.

Thus, in T 665/00, the board found that the subject-matter of an alleged public prior use within the priority interval was described in the priority document and also fell within the scope of the claims of the disputed patent, but that the priority document did not necessarily describe all the subject-matters claimed. Referring to Art. 88(3) EPC 1973 and G 2/98 (OJ 2001, 413), the board held that different elements of a patent application could enjoy different priority dates and that this was also applicable to a single claim encompassing alternatives and being, thus, separable into a plurality of subject-matters. Of the different alternatives contained in claim 10 (relating to a powder containing hollow microspheres the specific mass of which was described by the generic term "less than 0.1 g/cm<sup>3</sup>"), the non-compacted powders containing "Expancel DE" microspheres were covered by the claimed date of priority. The claimed prior use, which came after the priority date and involved a product containing the same "Expancel DE" microspheres, could therefore not be novelty-destroying. See also T 135/01.

The meaning of the proviso of G 2/98 in relation to the "OR" claim situation was the subject of extensive obiter remarks in T 1222/11. According to the board, the condition "provided that it gives rise to the claiming of a limited number of clearly defined alternative subject-matters" should be given a different meaning from that attributed to it in T 1877/08, T 476/09, T 1443/05 and T 1127/00. This condition could not be meant to set out the manner in which the subject-matter of the "OR" claim must be defined. This would, at least in relation to generic terms, be at variance with the disclosure test based on the principle of an unambiguous and direct disclosure (cf. G 3/89, OJ 1993, 117). For the purpose of the assessment required by Art. 88(3) EPC, the board considered that the wording of the