

3.1.6 Enabling disclosure in the priority document

The decisions below highlight that the priority document must disclose the invention claimed in the subsequent application in such a way that it can be carried out by a person skilled in the art.

In T 81/87 (OJ 1990, 250) the board took the view that the argument that the skilled person would supplement the disclosure from his common general knowledge to make it work, should any difficulty be encountered, was no excuse when this was a feature of the definition of the invention, and was missing, not envisaged by the inventor and not implied by the description. In order to give rise to priority rights the essential elements, i.e. the features of the invention, in the priority document had to be either expressly disclosed or directly and unambiguously implied in the text as filed; missing elements recognised as essential only later on were not part of the disclosure, and gaps with regard to basic constituents could not be retrospectively filled by relying on knowledge acquired in this manner. It could become a misuse of the priority system if some parties in a competitive situation were allowed to jump ahead of others on the basis of mere expectations and by omitting the critical features of the invention altogether. This decision was followed in e.g. T 301/87, OJ 1990, 335, and in T 296/93, OJ 1995, 627.

The board in T 301/87 (OJ 1990, 335) considered that if an entity itself is disclosed to the skilled person, this does not necessarily mean that a component part is also disclosed for the purpose of priority if this cannot be envisaged directly and unambiguously as such, and requires considerable investigation to reveal its identity.

In T 296/93 (OJ 1995, 627) the board rejected the argument that the priority document was deficient in respect of relevant technical information necessary for reducing the claimed invention to practice by the person skilled in the art without undue burden. See also T 207/94 (OJ 1999, 273), T 767/93, T 20/04.

In T 919/93 the board found that certain passages in the European application as filed, essential for the application to meet the requirements of Art. 83 EPC 1973, had no counterpart in the priority document, which was thus not enabling for the claimed subject-matter.

In T 843/03 the board referred to the requirement that the priority document provide an enabling disclosure (T 81/87, OJ 1990, 250; T 193/95). It had been established in a number of board of appeal decisions that sufficiency of disclosure presupposes that the skilled person is able to obtain substantially all embodiments falling within the ambit of the claims and that he/she, in order to reach this goal, may not be confronted with an undue burden. Based on previous case law on the requirement of Art. 83 EPC 1973 (T 19/90, OJ 1990, 476) and on the novelty requirement (T 464/94) the board concluded that, when an applicant provided a technical disclosure and **prima facie evidence** as to certain technical elements in an application, **it was the EPO which had the burden of proof** when judging that something was not shown. The board held that the examining division had not taken the legally appropriate approach when deciding to the disadvantage of the applicant with the reason that "[...] no absolute fact can be deduced from figure 7 as to