

The board referred the following questions to the Enlarged Board of Appeal (referral now pending as **G 1/22** and **G 2/22**):

I. Does the EPC confer jurisdiction on the EPO to determine whether a party validly claims to be a successor in title as referred to in Article 87(1)(b) EPC?

II. If question I is answered in the affirmative, can a party B validly rely on the priority right claimed in a PCT application for the purpose of claiming priority rights under Article 87(1) EPC in the case where:

1) a PCT application designates party A as applicant for the US only and party B as applicant for other designated States, including regional European patent protection and

2) the PCT application claims priority from an earlier patent application that designates party A as the applicant and

3) the priority claimed in the PCT application is in compliance with Article 4 of the Paris Convention?

2.3. National deposit of industrial design

In J 15/80 (OJ 1981, 213) it was held that a priority right based on the deposit of an industrial design was not recognised for a European patent application. As the EPC was a special agreement within the meaning of Art. 19 of the Paris Convention, a general understanding by the EPC contracting states that the deposit of an industrial design clearly gave a priority right for a national patent application could, by application of Art. 4 Paris Convention, lead to an interpretation of Art. 87(1) EPC 1973 going beyond its terms. However, in the absence of such a general understanding there was no reason to read Art. 87(1) EPC 1973 more broadly than its express terms and scope required. In the board's opinion, a right of priority under the Paris Convention existed if the prior application was for the protection of an invention as such and contained a disclosure of it. The deposit of an industrial design in essence protected aesthetic appearance. Although the deposited design might incorporate an invention, according to national design laws the deposit would not protect the invention as such.

2.4. Exhibition priority

In T 382/07 it was held that an exhibition priority could not be validly claimed for a European application or patent. The board stated that the possibility of recognising exhibition priorities internationally followed from Art. 11 Paris Convention. Its provisions allowed Paris Union member countries to recognise exhibition priorities in their domestic law under certain conditions but did not oblige them to do so. Entitlement to claim an exhibition priority was to be decided on the basis of the national law of the country where protection and priority were claimed, i.e. for a European application or patent the EPC, and not the law of the country where the exhibition took place or a first application claiming the exhibition priority was filed. Since the EPC did not recognise exhibition priorities, any