

3. Identity of invention

In accordance with Art. 87 EPC a European patent application is only entitled to priority in respect of "the same invention" as was disclosed in the previous application. See also Art. 88(2) to (4) EPC.

3.1. Disclosure in the previous application of the invention claimed in the subsequent application

3.1.1 G 2/98 – interpretation of "the same invention"

In G 2/98 (OJ 2001, 413), the Enlarged Board of Appeal, ruling on points of law referred by the President regarding the interpretation of Art. 87(1) EPC 1973, addressed the concept of "the same invention" in this provision. It first considered whether interpreting "the same invention" narrowly was consistent with the relevant Paris Convention and EPC 1973 provisions. A narrow interpretation meant that the subject-matter of a claim which defined the invention in a European patent application – i.e. the specific combination of features in that claim – had to be at least implicitly disclosed in the application whose priority was claimed. The Enlarged Board held that a broad interpretation, distinguishing between those technical features which related to the function and effect of the invention and those which did not – with the result that an invention could still be considered "the same" even if a feature were amended, deleted or added – was inappropriate and prejudicial to a proper exercise of priority rights. To ensure a practice fully consistent, *inter alia*, with equal treatment for applicants and third parties, legal certainty and the principles for assessing novelty and inventive step, "the same invention" had to be interpreted narrowly and in a manner equating it to "the same subject-matter" in Art. 87(4) EPC 1973. This interpretation was underpinned by the Paris Convention and the EPC 1973, and was entirely consistent with opinion G 3/93 (OJ 1995, 18).

The Enlarged Board therefore ruled that the requirement for claiming priority of "the same invention", referred to in Art. 87(1) EPC 1973, means that priority of a previous application in respect of a claim in a European patent application in accordance with Art. 88 EPC 1973 is to be acknowledged only if the skilled person can derive the subject-matter of the claim **directly and unambiguously**, using common general knowledge, from the previous application as a whole. The subject-matter of the claim defining the invention in the European application has to be understood as "the specific combination of features present in the claim".

3.1.2 G 2/98 and the concept of disclosure – interpretation in the same way as for Art. 123(2) EPC

It may be noted that following G 2/98 (OJ 2001, 413) the older case law which devised the "**disclosure**" test still applies (see e.g. T 184/84, T 81/87, OJ 1990, 250, T 469/92, T 269/93, T 77/97). In T 311/93 and T 77/97 in particular, the boards applied the criterion of at least implicit disclosure used for the disclosure test under Art. 123(2) EPC 1973. On the other hand, G 2/98 rejected the approach taken in T 73/88 ("Snackfood", OJ 1992, 557; cf. also e.g. T 16/87, OJ 1992, 212; T 582/91; T 255/91, OJ 1993, 318;