

were essential merely because they were present in claim 1 of the priority document. The board concluded that the priority claimed was valid. This decision was followed in T 321/06.

According to the board in T 134/94, granted claim 1 was not entitled to priority. The priority document disclosed a **process** which worked under specific conditions indicated as features (a) to (d). Requirements (a) and (c) did not appear in granted claim 1; the invention defined by it was not the same as that defined in the priority document. According to the board, the respondent's position that the priority claim should be acknowledged whenever the disclosure of the priority document would destroy the novelty of the claims of the later application or patent ("novelty test") had no basis either in the EPC or in the EPO case law.

In T 552/94 the patent's claim 1 lacked four features which according to the priority document were indispensable for carrying out the invention. Citing T 134/94 and T 1082/93, the board found that without those features the invention according to claim 1 could not be the same as that described in the priority document, and the requirements of Art. 87(1) EPC 1973 were therefore not met.

In T 59/11 the board, assessing the requirement of the "same invention" according to the criteria of G 2/98 (OJ 2001, 413), concluded that there was no basis in the priority document as a whole for the omission of features (a) to (d) from claim 1 in question. Rejecting arguments put forward by the proprietor, the board stated that the existence of a common problem to be solved in a claim under consideration and the document from which its priority was claimed was not decisive in finding a priority validly claimed or not. Nor was an identification of features which were not essential to solving this common problem and their deletion an accepted approach to justify a valid priority claim.

According to T 250/12, following G 2/98 (OJ 2001, 413, points 8.3 and 9 of the Reasons), the essentiality of a feature is not per se an appropriate criterion for judging the validity of a priority claim. Applying the standard laid down in G 2/98 for assessing the "same invention" requirement, the board noted that each of the independent claims of the first priority application contained the contested feature relating to the adjacent location of the third and second contact portions (or their corresponding terminals or apparatus side terminals). Moreover, the priority application as a whole did not provide any basis for considering the above feature as optional. Thus, a skilled person would immediately deduce from the first priority application that the feature formed part of the invention disclosed therein. Since this feature was deleted from the present independent claims, the subject-matter of those claims could not be clearly and unambiguously derived from the first priority application, and the claimed priority was not valid.

See also e.g. T 1890/09.