

4. First application in respect of the invention

In principle, only the first application filed in a state party to the Paris Convention or a member of the WTO can form the basis of a priority right. In the EPC this is made clear in Art. 87(1) and (4) EPC.

Therefore, if apart from the application whose priority is being claimed in the subsequent European application, an earlier previous application was also filed, in order to check the validity of the priority claim it must be established whether the invention claimed in the subsequent application was already disclosed in the earlier previous application – see in this chapter II.D.4.1. Decisions also focusing on the identity of the applicants are dealt with in this chapter II.D.4.2.

In T 477/06 the board held first that since Euro-PCT application D8 had been deemed withdrawn due to non-payment of the designation fees (R. 23a EPC 1973), it was not prior art under Art. 54(3), (4) EPC 1973 for the application in suit. However, it had been filed by the same applicant and earlier than the priority application. In view of the fact that claimed subject-matter was anticipated by this earlier application, the priority application was not the first application within the terms of Art. 87(1) and (4) EPC 1973 (cf. Art. 8(2)(b) PCT), so that the priority claim was not valid. Hence, the application in suit enjoyed priority only from the date of filing and D8 was prior art under Art. 54(2) EPC 1973. See also T 1222/11 in chapter II.D.4.1. below.

For the case of a priority held invalid because it was **not** shown, for the purpose of Art. 87(4) EPC 1973, that at the date of filing of the application from which priority was claimed, a previous first application filed by the applicant in respect of the same invention had been **withdrawn**, see T 1056/01 (reported in chapter III.G.4.3.5).

4.1. Identity of invention

To establish whether the invention claimed in the subsequent European application was already disclosed in the earlier previous application, the same principles have to be applied as when establishing identity of invention between the application forming the basis of priority and the application claiming priority. The question is whether the person skilled in the art could derive the subject-matter of the claim of the subsequent application directly and unambiguously, using common general knowledge, from the earlier previous application or only from the later one (cf. G 2/98, OJ 2001, 413).

In T 323/90 the board concluded that the alleged first application disclosed a different invention from that in the European application and the application from which priority had been claimed: the claimed process (for increasing the filling power of tobacco lamina filler) differed as regards both the moisture content of the tobacco for processing and the first step in the process.

In T 400/90 priority had been claimed from a US application in respect of a European application concerning an electromagnetic flowmeter. According to the opponents, an earlier US application filed by the same applicant outside the priority period disclosed all