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Valid priority based on implicit effect

In a recent decision, the German Federal Court of Justice (BGH) ruled that a patent claiming a technical effect that is not indicated in the priority application may still validly claim priority if the obtaining of the effect seems self-evident to a person skilled in the art when reworking the disclosed invention (BGH X ZR 107/04).

In nullity proceedings at first instance, the Federal Patent Court had declared entirely invalid the German part of a European patent, which claimed the priority of a Belgian patent application.

In the appeal procedure, the appellee requested the appeal be refused, partly relying on the allegation of a prior public use, which was allegedly prejudicial as to novelty since the patentee supposedly could not take advantage of the priority of the Belgian patent application. But the appeal was allowed, as the BGH held that the priority could be effectively claimed.

According to Article 87 (1) EPC, when applying for a patent, priority of a prior application may be claimed if both concern the same invention. This requirement is fulfilled, in the BGH's jurisdiction, if the combination of features claimed by the subsequent application is disclosed in the prior application as a whole as belonging to the invention.

In this case, the BGH held that a certain addendum to claim 1 defining a technical effect, which was not explicitly disclosed in the prior application, was not a novel feature detrimental to priority, but only described an effect that the skilled person would view as being aimed at by the prior application as well.

The specification of a technical effect in a claim may thus be limiting. If the prior application does not explicitly describe this specification, it has to be questioned whether it at least discloses the technical effect implicitly, for example because the skilled person would automatically presume that the prior application is also directed to obtaining this effect.