

June 2010

Harshness of UK Law on Priority Set to Remain Following Appeal Decision

We have previously reported on the pitfalls, in various European jurisdictions, of priority claims made by companies filing patent applications relying on priority applications not filed in the companies' own names, e.g. priority cases filed in the names of inventors. In our summary, we referred to a 2009 decision in the England and Wales High Court (Patents Court): *Edwards Lifesciences AG v. Cook Biotech Incorporated* ([2009] EWHC 1304 (Pat)).

In that case, Edwards sought to invalidate Cook's European Patent (UK) 1 255 510 protecting stent valves and claiming priority from a US patent application. One article raised with regard to inventive step against the Cook patent had been published after Cook's US priority application but before its PCT filing date. Edwards contended, and the High Court agreed, that Cook was not, however, entitled to its priority claim due to the fact that only two of the three inventors in whose names the priority application was filed had assigned his rights in the invention to Cook before the PCT filing date. The other two inventors assigned their rights to Cook after the PCT filing date.

The High Court's holding, by Justice Kitchin, regarding priority claims therefore confirmed for the purposes of UK patent law what the Board of Appeal of the EPO had held in case T 0788/05: priority can only be claimed by the identical applicant(s) of the relevant earlier application or his valid successor in title. This arises from the strict interpretation of the term "person" in the UK Patents Act, PCT, and Paris Convention (Stockholm revision). Consequently, any failure in transferring priority rights by the filing date of an application claiming those priority rights appears fatal to a valid priority claim and not rectifiable after the event.

Given the great relevance of this case to every day patent practice, Cook's appeal of the High Court decision to the Court of Appeal was greatly anticipated. The hearing of Cook's appeal took place yesterday, 9 June 2010, at the Court of Appeal of England and Wales before Lord Justices Jacob, Moore-Bick, and Etherton. A hope was that the judgment of Justice Kitchin at first instance might be softened by the Court of Appeal, particularly in terms of allowing post facto rectification of a missing transfer of priority rights.

Separate from the issue of priority, which had led to a finding of invalidity over an intervening publication (Pavcnik et al.), another finding of the High Court had been one of invalidity based on lack of inventive step over US Patent No. 5,411,522 ("Andersen"), a piece of prior art which predated both Cook's PCT filing date as well as its priority date. Because a holding of invalidity over Andersen would render the priority issue moot, the Appeal justices decided to hear submissions only on the validity of Cook's patent over Andersen, but on none of the other issues. Following a full morning's oral arguments, the Lord Justices told Cook verbally that its patent is invalid over Andersen. Therefore there was no need to consider the priority issue. A written decision is expected to be handed down shortly.

The Court of Appeal therefore appears to have avoided the issue of priority entirely. Consequently, the High Court judgment may stand as a troublesome precedent in the area of priority entitlement, unless perhaps any of the Appeal justices might make obiter comment on the issue in their written decision.

The practical suggestions made in our May 2010 Briefing Note <http://www.hgf.com/uploads/Cook%20Edwards%20Decision.pdf> therefore, continue to be of practical relevance.

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