



Priority

CIPA Informals Foundation Lecture

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What is priority?

- An application can claim **priority** from an earlier **first** application.
- Patents, registered designs, trade mark and utility applications can all claim priority.
- A valid priority claim gives an earlier **effective filing date**.



Practical points:

- Earlier effective filing date is used as the cut-off point for prior art.
- Having priority right allows applicants time to decide where to file foreign applications (important as additional filings can be expensive).

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Relevant statutes and treaties

- Priority derives from the Paris Convention for the Protection of Industrial Property ('The Paris Convention').
- Paris Convention and WTO set out a common legal framework which contracting states must comply with.
- Most industrialised countries are party to either the Paris Convention for the Protection of Industrial Property or the World Trade Organisation (e.g. Taiwan).
- EPO and WIPO are not themselves states and are not party to Paris Convention or WTO, so claims to priority in earlier filed international patent applications or European patent applications are not governed by Paris Convention, but dependent on relevant patent law (e.g. Section 5(5)(b) UKPA, Art 87(2) EPC and Rule 4.10(a)(v)PCT).
- Principles of Paris Convention embodied in UK, European and international patent statutes:
 - Section 5 of the UK Patents Act
 - Art 8(2) PCT; and
 - Art 87 EPC.
- Unless otherwise stated, the requirements for priority rights being discussed are the same at the UKIPO and EPO.

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Basics for claiming priority?

1. Patent applications can claim priority from earlier patent application, utility model or utility certificate. A patent application **may not** claim priority from a design application.
 2. Can only claim priority from application that relates to **the same** invention, industrial design, or trade mark.
 3. The priority right belongs to the applicant or *successor in title*.
 4. The priority can only be claimed for the **first** application for that subject matter.
- Can claim priority from application in different country, provided both countries are party to Paris Convention (applies to most countries).
 - Can claim priority from an application that has been refused or abandoned.

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2. Same invention

- Same subject matter
 - 'Directly and unambiguously derivable from the disclosure of the invention from the priority document'.
 - Does not need to be the *claimed* subject matter of the priority document – 'application as a whole'.
- At UKIPO and at EPO, the test is typically the same as the test for assessment of added matter.
- At EPO, the test is set out clearly in Enlarged Board of Appeal Decision **G2/98**:
For priority to exist, the subject-matter of the claim must be **directly and unambiguously derivable by the skilled person from the content of the earlier application as a whole**.

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3. Same Applicant

- The earlier application must have been filed by the **same applicant** (or his predecessor in title) as the applicant for the later application.
- If a different applicant is to be named on the later filed application compared to the earlier, then the right to claim priority from the application must have **transferred** to this applicant prior to filing the later application.
- If multiple applicants –all applicants (or their successors) for the priority application must be named in subsequent application (T0788/05) and CRISPR (T 844/18)

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3. Same Applicant

Priority Applicants

Later Applicants

A + B



A + B



Same applicants named

A



A + B



All applicants from priority application have been named on subsequent application

A + B



A



Unless right to priority has been transferred from B to A

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3. Same Applicant: ownership of priority right

- Priority right is an independent right that may be assigned **independently** of rights in the application itself.
- Typically, national law governs whether priority rights are transferred effectively between parties. Different standards may apply in each jurisdiction.
- Several recent decisions by the EPO Boards of Appeal (e.g. T62/05) and national courts of EPC Contracting States (e.g. UK Patents Court -Edwards Life Sciences AG v Cook Biotech Inc, CRISPR) have held the priority claim of a patent to be invalid on the grounds that, at the filing date of the patent, the applicant did **not** have the right to claim priority.
- EPO case law has developed to interpret the right to claim priority as belonging simultaneously and jointly to all applicants named on the priority application
- In each of these cases the patent was **revoked** in view of intervening prior art.

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3. Same Applicant: Applicant missing - CRISPR

- CRISPR is a type of genetic engineer technique that allows targeted modification of genomes (and now RNA) in living organisms.
- Many applications being filed by different institutions – so priority rights become important for deciding if a patent application is novel/inventive (or not).
- Patent in question (**EP 2771468**) claimed priority to multiple earlier US applications.
- Several of the priority applications listed Luciano Marraffini (employed by Rockefeller University) as an inventor.
- Neither Marraffini/Rockefeller named as applicant in the PCT application.
- Marraffini had not assigned his rights **before** the filing date of the PCT application.
- Therefore, not all Applicants of the priority document were named on the PCT.
- So priority claim held to be invalid in Europe.
- Intervening prior art (published between priority and PCT filing) was then found to be novelty destroying.

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3. Same Applicant: Additional Applicant - KCI Licensing v Smith and Nephew Inc.

- In *KCI Licensing v. Smith and Nephew Inc.*, a US priority application was filed with *KCI Licensing* as the sole applicant.
- A subsequent PCT application was filed by KCI in the name of *KCILicensing* and *Mediscus*, which claimed priority from the US application.
- There was no formal transfer of rights between *KCI* and *Mediscus* in the priority year.

Can the PCT application validly claim priority from the US priority application?

- *KCI* argued that, by consenting to the filing of the PCT application in the name of *KCI* and *Mediscus*, *KCI* had effectively agreed to transfer part of their entitlement to the invention.
- This argument was accepted and the priority claim was considered valid.
- European practice is consistent with this.

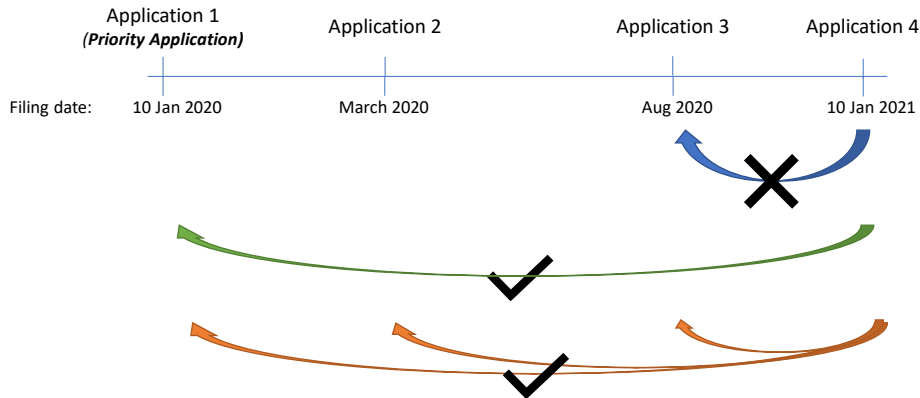
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4. First application

The earlier application from which priority is claimed must be the **first** application relating to that invention.

If not first application to the invention made by that applicant then the priority claim is invalid.

Can claim priority from **multiple** applications.

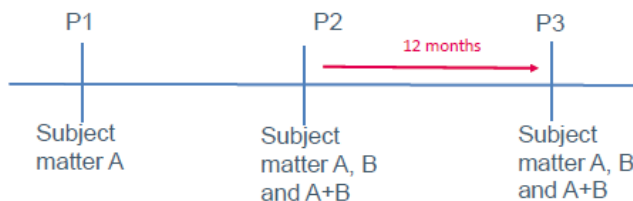


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An applicant files patent application P3, claiming priority from earlier patent application P2.

However, the existence of an even earlier patent application P1 by that same applicant filed more than 12 months before the filing date of P3 will invalidate the priority claim from P3 to P2 for any subject-matter common to P1 and P2.

In scenario below, claim to A in P3 not entitled to priority, but claim to B alone and A + B entitled.



The only way to claim valid priority to P2 for "A" subject matter is as follows:

- P1 must have been unconditionally withdrawn, abandoned or refused without being published or leaving any rights outstanding or having served as a priority application for any other application, and
- P2 must be filed in the same country as P1

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Reinstating priority: withdrawal without rights outstanding

Rights outstanding include:

- Residual right to claim priority to the withdrawn application later

Under UK law, if the earlier application is simply withdrawn, there remains a right under Section 14(10) and Section 117 to request correction of the withdrawal if it was made in error.

Similarly, if the earlier application is abandoned or refused then there may be an outstanding right to request reinstatement under Section 20A, or to appeal the refusal. In each case, it remains possible to claim priority from the earlier application.

Therefore, expressly withdraw P1 application **with no rights outstanding**.

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How long do I have to claim priority?

The deadline for **filing** a priority claiming application is:

- **Patent** application - 12 months
- **Utility model** - 12 months
- **Design** application - 6 months
- **Trade mark** application - 6 months

(based on Art 4C(1) Paris Convention)

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Patent priority right deadlines

- Period for filing later case expires at the end of the day containing the anniversary of the filing date of the earlier case(s) (based on Art 4C(2) Paris Convention)
- Due date extended by office closures to next office open day (e.g. due date falls on a weekend or other patent office closed day) (based on Art 4C(3) Paris Convention)
- If priority period missed, some states and conventions allow for re-establishment of the priority right provided the later application is filed within a certain time of the elapsed due date and provided certain other conditions are met (to be discussed later)

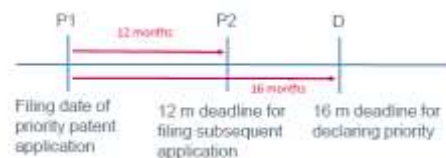
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Patent priority right deadlines

- Must file patent application within 12 month priority deadline
- Can claim priority from multiple applications, provided they were all filed within 12 months of the final application.
- Deadline for making **declaration of priority** - **16 months from earliest priority date**

There is therefore two deadlines:

- **12 month** deadline (from earliest priority date) for **filing** subsequent application
- **16 month** deadline (from earliest priority date) for making **declaration** of priority



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Partial priority

- Can claim multiple priorities for one claim.
- Subject matter will be given the priority date for the earliest application which discloses it.
- Example 1: metal A in application 1 Jan 2020, metal B in application 2 Mar 2020. Later application may claim metal, metal A, metal B and metal A & B but these will have different priority dates for deciding novelty/inventive step.
- Example 2: Combination of A & B cannot claim priority if no combination disclosed. i.e., no mosaics of priority documents. However, metal A and metal B are not novelty destroying of metal as the A and B part of the more general metal have partial priority.

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Common problems with claiming priority

- Whenever a priority-claiming application is filed in the name of a person different to the applicant of the priority application.
- When reliance is placed on rights passing by employment.
- When reliance is placed on an assignment that might not satisfy formal requirements everywhere patents may be sought.
- When the 12 month period is missed.
- Where the subject matter is not directly and unambiguously derivable by the skilled person from the content of the earlier application as a whole.
- Where the priority application is not the first application for the subject-matter

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When things go wrong: missing priority claim

- **Later application claiming priority is filed within the 12 month priority period but mention of priority document missing in filing.**
- Omission of Priority Claim -Section 5(2) UKPA
- If the later application is filed within the 12 month priority period, but a declaration is not made at the time of filing, it can be made (or another declaration can be added) up to 4 months late(16 months from earliest priority date) non-extendable, with form and fee (PF3) .

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When things go wrong: late filing

Later application is filed after the 12 month priority period:

- This is called a Late Filing –Section 5(2B) and 5(2C) of UK patents Act.
- If the 12 month priority period is missed, but filing occurs within 14 months from priority, a request for a late declaration of priority may be made:
 - if comptroller is satisfied late filing was **unintentional**;
 - up to 2 months late(14 months from earliest priority date) non-extendable;
 - form and fee (PF3);
 - supported by evidence (showing late filing was unintentional);
 - if no evidence is given on request for late declaration, evidence shall be requested by comptroller within specified period.
- The declaration and the request for a late declaration of priority may only be made:
 - If there is no request for early publication (or such a request has been withdrawn before preparations for publication have been completed); and
 - the declaration must be made at same time as request for a late declaration of priority
- or if the application is a PCT(GB) application you have one month from national phase entry to make late declaration

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Late filing PCT

If the application is filed after the 12 month priority period:

Same period as the UK (14 m from priority)

<http://www.wipo.int/pct/guide/en/gdvol1/pdf/gdvol1.pdf> (5.057-5.066)

No test (e.g. unintentional); however, the fact that the priority claim is retained in the international application does not mean in any way that the validity of such a priority claim in the national phase is assured.

EPO – same period to the UK (14 m from priority)

- However, much stricter requirement of “all due care” -higher bar than unintentional
- See Case law of the EPO boards of appeal, III, E.4, 4.2

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Formalities for claiming priority

Certain formalities required when claiming priority, e.g. for UK:

- A copy of the earlier application, either certified by the authority with which it was filed or otherwise verified, may need to be supplied within 16 months of the priority date
 - except where PDAS is accepted then simply use the code supplied by the priority filing office – UK, EPO, US, CN.... and IB (PDAS).
 - The WIPO Digital Access Service (DAS) is an electronic system allowing priority documents and similar documents to be securely exchanged between participating intellectual property (IP) offices.
- Translations of foreign-language priority applications (or declarations that the application is a complete translation of the priority application) will only be required where the matters disclosed in the earlier application are relevant to the determination of whether or not an invention, to which the application relates, is new or involves an inventive step.

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Tips

- Ensure priority application is an enabling disclosure.
- Check applicants carefully.
- Ensure ownership of priority has been sorted out **before** 12 month deadline.
- Don't remove subject matter from priority application when filing a later application - only add.
- Be mindful of deadlines!
- It is possible to regenerate priority period by withdrawing the first application and withdrawing all rights prior to publication.

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The logo for Script IP Patent Attorneys features the text "Script IP" in a large, dark serif font, with "Patent Attorneys" in a smaller, lighter sans-serif font below it. To the right of the text is a stylized blue feather icon. The entire logo is set against a background of faint, concentric circular lines and a large, dark, curved swoosh on the left side.

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Questions?

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