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Priority right - the basics

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- Can claim **priority** from an earlier patent/design/TM application
- A valid priority claim means that an application is treated as if it had been filed on the day of the earlier priority application (has an earlier **effective filing date**)
- Earlier effective filing date is used as the cut-off point for assessing patentability (e.g. novelty, inventiveness, etc.)
- Provides applicants up to 12 months to decide where to file foreign applications – key as additional filings can be expensive!
- Priority derives from the Paris Convention for the Protection of Industrial Property (“The Paris Convention”)

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Conventions and treaties



- Rules concerning claiming priority rights generally embodied in the relevant law of the jurisdiction concerned, which for many countries originates from the principles of the Paris Convention
 - Paris Convention and WTO set out a common legal framework which contracting states must comply with
 - 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
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Priority right - where does it apply?



- Priority can be claimed for (among other things):
 - Patent applications
 - Registered design applications
 - Trade mark applications
 - Utility models
 - The priority right belongs to the applicant or *successor in title*.
 - Can only claim priority from application that relates to **the same** invention, industrial design, or trade mark
 - Can claim priority from application in different country, provided both countries are party to Paris Convention (applies to most countries)
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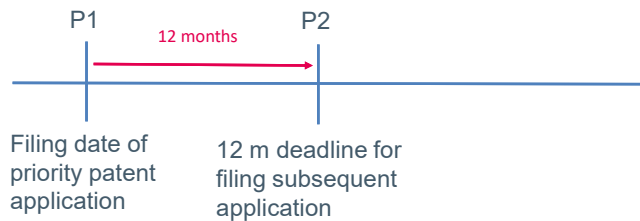
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Priority right - deadlines



- The deadline for **filing** priority claiming application is:
 - From filing of earlier **patent** application - 12 months
 - From filing of earlier **utility model** - 12 months
 - From filing of earlier **design** application - 6 months
 - From filing of earlier **trade mark** application - 6 months

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



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Priority right – how to get it (patents)



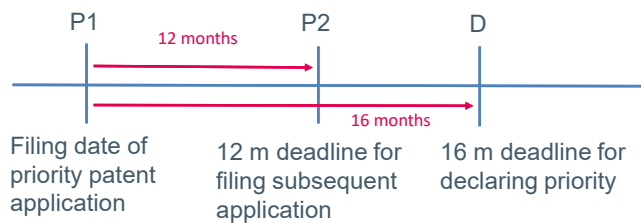
- Must file patent application within 12 month priority deadline
- Can claim priority from multiple applications, provided filed within 12 months of all priority applications
- When filing the subsequent application, the applicant must **claim the priority** of the first application in order to make use of the right of priority
- 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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Priority right – how to get it (patents)



- 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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Priority period



- 6 or 12 months from earliest priority date (depending on IP right)
- 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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Earlier application



- Patent applications can claim priority from earlier:
 - a patent application
 - utility model
 - utility certificate.
 - A patent application **may not** claim priority from a design application.
 - The subsequent application may be filed in same country as priority application or different country, provided both filed in countries party to Paris Convention
 - Most industrialised countries are party to either the Paris Convention for the Protection of Industrial Property or the World Trade Organisation (e.g. Taiwan), which are examples of such agreements.
 - 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 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)
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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 application, 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)
 - An application filed by party “A” is not entitled to claim priority from application filed by “A and B” (unless right to claim priority has transferred from B to A).
 - “A” is considered a different person to “A and B”.
 - Converse does not apply – an application filed in name of “A and B” can claim priority from application filed by “A” as all applicants from priority application are named on the subsequent application
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Ownership of the 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*) 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.
 - In each of these cases the patent was **revoked** in view of intervening prior art.
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Same applicant (*Edwards v Cook*)



- In *Edwards Lifesciences AG v Cook Biotech Incorporated* a US priority application was filed in the name of three inventors, with the rights from only **one** of those inventors passing to Cook.
 - Subsequently a PCT application was filed by Cook alone, and the Court was asked to decide whether Cook was entitled to claim priority.
 - Found that Cook was **not** entitled to claim priority from the earlier application because the "person" referred to by the Paris Convention is a reference to all three applicants together, and Cook alone (or the inventor from which they acquired their rights) had not duly filed an application within the meaning of Article 4A(1) of the Paris Convention.
 - The priority right resided with the three inventors (or their successors in title) jointly, and not separately. Cook had not acquired the right to claim priority so later application received only the later date
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Same invention (The “reverse Edwards”)



- 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 *KCI Licensing* and *Mediscus*, which claimed priority from the US application.
 - No formal transfer of rights between *KCI* and *Mediscus* had taken place 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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Same applicant (The “reverse Edwards”)



Situation consistent with EPO practice:

EPO Guidelines A-III, 6.1

*“However, in the case of **joint applicants filing the later European patent application**, it is sufficient if **one of the applicants is the applicant or successor in title to the applicant of the previous application**. There is no need for a special transfer of the priority right to the other applicant(s), since the later European application has been filed jointly. The same applies to the case where the **previous application itself was filed by joint applicants**, provided that **all these applicants, or their successor(s) in title, are amongst the joint applicants of the later European patent application**.”*

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Same applicant (Worked Example)



Scenario:

- Priority application filed by A+B
 - Priority claiming application filed by A + B + C
 - Is this ok?
 - What if priority claiming application was filed by only A + C?
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First filing



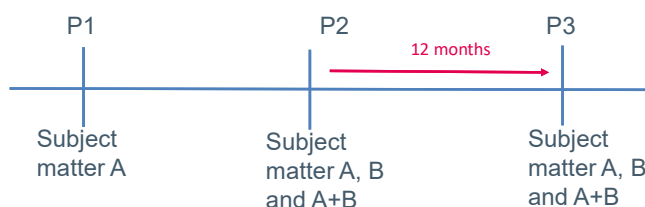
- The earlier application from which priority is claimed must be the:
 - first application relating to that invention
 - filed by the same applicant
 - If not first application to the invention made by that applicant then priority claim is invalid
 - If priority application not filed by same applicant (or successor in title) to priority claiming application then priority claim is invalid
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First filing - example



- 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.



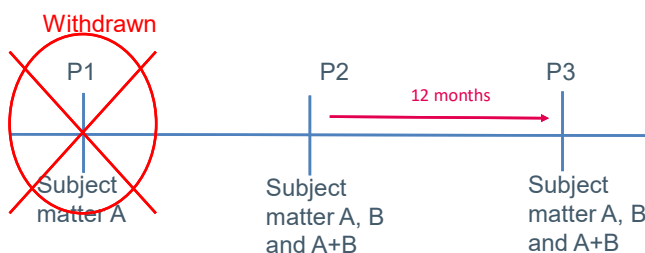
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Regeneration of priority



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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Regeneration of 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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The same invention



- Subject matter identical?
 - uncontroversial: is clearly the same matter so entitled
- Subject matter not identical?
- What test do we apply to determine whether the subject matter in a later filed application is entitled to the priority date of the earlier priority application?
- In UK and at EPO, 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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So when may we encounter problems?



Summary

- 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
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What to do when things go wrong - UK



Convention application timely filed within 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
 - form and fee (PF3)
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What to do when things go wrong - UK



Convention application filed later than 12 month priority period:

Late Filing – Section 5(2B) and 5(2C)

- 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
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What to do when things go wrong - UK



Convention application filed later than 12 month priority 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:

have one month from national phase entry to make late declaration

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What to do when things go wrong – EP / PCT



Convention application filed later than 12 month priority period:

- PCT – 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 – again, 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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Filing Formalities



- 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 to the satisfaction of the comptroller, should also be supplied within 16 months of the priority date – except CN, JP, US, AU, ES, KR, FI and IB (PDAS).
 - Translations of foreign-language certified copies of priority applications (or declarations that the application in suit is a complete translation into English 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 in suit relates, is new or involves an inventive step.
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Practical tips:

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

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