



Priority

CIPA Informals Foundation Lecture

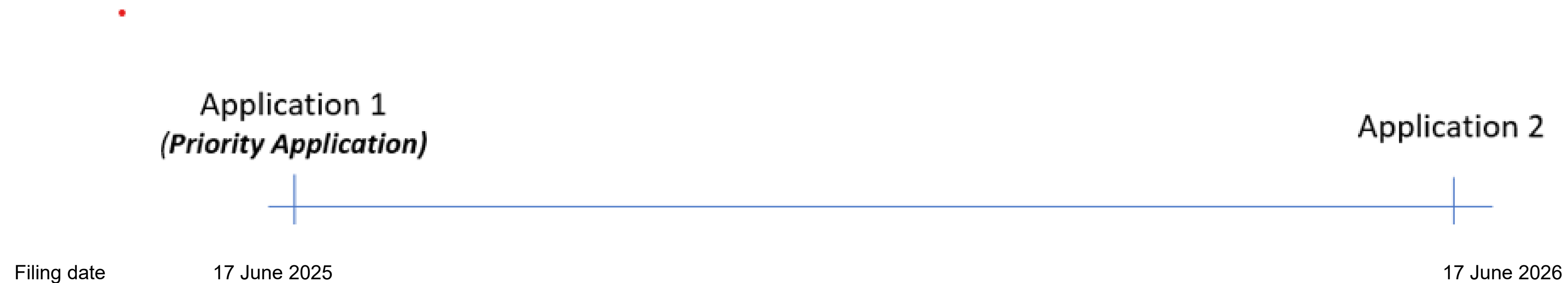


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What is Priority?

- An application can claim priority from an earlier application.
- A valid priority claim gives an earlier effective filing date.
- Priority is useful as:
 - Earlier effective filing date is used as the cut-off point for prior art.
 - Having a priority right allows applicants time to decide where to file foreign applications (important as filings can be expensive).
- Patents, registered designs, trade mark and utility applications can all claim priority.



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)

For patents there is also a deadline for making a **declaration of priority**.

So two deadlines for patents:

1. 12 months from the earliest priority date **for filing** the later application; and
2. 16 months from the earliest priority date for making a **declaration of priority**.



Calculating Priority Dates



- Period for filing later application expires at the end of the day containing the anniversary of the filing date of the earlier application (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) - care that this is the closure of the office concerned, don't assume the office has the same closure dates as you

What happens if I don't file within 12 months?

- Some states 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)

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). See list here https://www.wipo.int/pct/en/paris_wto_pct.html.
- EPO and WIPO are not states, but priority is covered in the relevant patent law (e.g. 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.

Basic Requirement for a Priority Claim

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) and/or members of the WTO.

Can claim priority from an application that has been refused or abandoned - Priority does not depend on the outcome of the earlier application.

Basic Requirement – Same invention

#2. The earlier application must relate to the same invention.

This means:

- Same subject matter
- Does not need to be the claimed subject matter of the priority document – ‘application as a whole’.
- How is it decided if the subject matter is the same?
 - 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.’

Basic Requirement – same applicant

#3. Same applicant.

- The priority right belongs to the applicant or successor in title.
- Same applicant (or successor in title) should be named on both applications.
- If a different applicant is to be named on the later application, then the right to claim priority must have **transferred** to this applicant **prior** to filing the later application.

Examples:

- ✓ 1. $A \rightarrow A$
- 2. $A_1 \rightarrow A_2$
- ✓ 3. $A + B \rightarrow A + B$
- 4. $A_1 + B \rightarrow A_2 + B$

5. $A \rightarrow A + B$ ✓
 $A + B \rightarrow A + B + C$

7. $A + B \rightarrow A$ ✗

UNLESS recorded transfer
of priority right to A from B

- 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. Different standards may apply.

Same applicant – applicant added

#2 A Case where an Applicant was added to the later application...

(UK) *KCI Licensing v. Smith and Nephew Inc*

- US priority application was filed with KCI Licensing as the sole applicant.
- Later PCT application was filed in the name of KCI Licensing and Mediscus, which claimed priority from the US application.
- There was no formal transfer of rights between KCI Licensing and Mediscus.

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

- KCI Licensing argued that, by consenting to the filing of the PCT application in the name of KCI Licensing and Mediscus, that KCI Licensing 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.

Same applicant – applicant missing

#2 A case where an applicant was missed from the later application...

- CRISPR is a type of genetic engineering technique.
- 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; BUT
- Neither Marraffini/Rockefeller were named as an applicant in the (later) PCT application; AND
- Marraffini/Rockefeller had not assigned the rights to the other applicants **before** the filing date of the later PCT application.
- Therefore, not all Applicants of the priority document were named on the later application.
- So priority claim held to be invalid by EPO. However, this has since been overturned in the related divisional cases
- The date for prior art reverts to the filing date (remember this can be up to 12 months later)

Same applicant –applicant missing in some PCT states

T1513/17 A case where a PCT was filed and the Applicant were the inventors for US only and not for EP

- Priority application was a US provisional so inventors had the right to claim priority, no assignment had been signed.
- So for EP could consider that the Applicants of the priority application (inventors) were missing
- Or could consider that inventors were among the Applicants for the PCT (albeit not for the European part) and therefore could be considered as joint applicants, as the PCT application is a single application having unitary character.
- Decided the latter and this was confirmed following a referral to the enlarged boards - G1/22 and G2/22

Two questions were referred: whether the European Patent Office (EPO) has the power to decide on entitlement to a priority right, and how the “joint applicants approach” is to be applied to PCT applications where different applicants are listed for different states (stems from T1513/17 and T2719/19).

I. Does the EPC confer jurisdiction on the EPO to determine whether a party validly claims to be a successor in title as referred to in Article 87(1)(b) EPC?

If question I is answered in the affirmative

Can a party B validly rely on the priority right claimed in a PCT-application for the purpose of claiming priority rights under Article 87(1) EPC in the case where

- 1) a PCT-application designates party A as applicant for the US only and party B as applicant for other designated States, including regional European patent protection and
- 2) the PCT-application claims priority from an earlier patent application that designates party A as the applicant and
- 3) the priority claimed in the PCT-application is in compliance with Article 4 of the Paris Convention?

It was decided that yes the EPO is competent to determine priority and the ‘joint applicant’s approach’ where if A is an applicant for a priority application and A + B for the later application, priority is considered to be valid (there is a presumption that A has consented so in effect assigned the right of priority), should be applied for PCT applications even where Applicant A (with the right to claim priority) is only an Applicant for a subset of the PCT states.

G1/22 and G2/22

It was also decided that there was a rebuttable presumption that the applicant has a right to claim priority, so the onus now goes to an opponent to show that they do not. It was due to this that priority was deemed to be validly claimed in the divisional applications in the CRISPR case.

Will this be followed in national law?

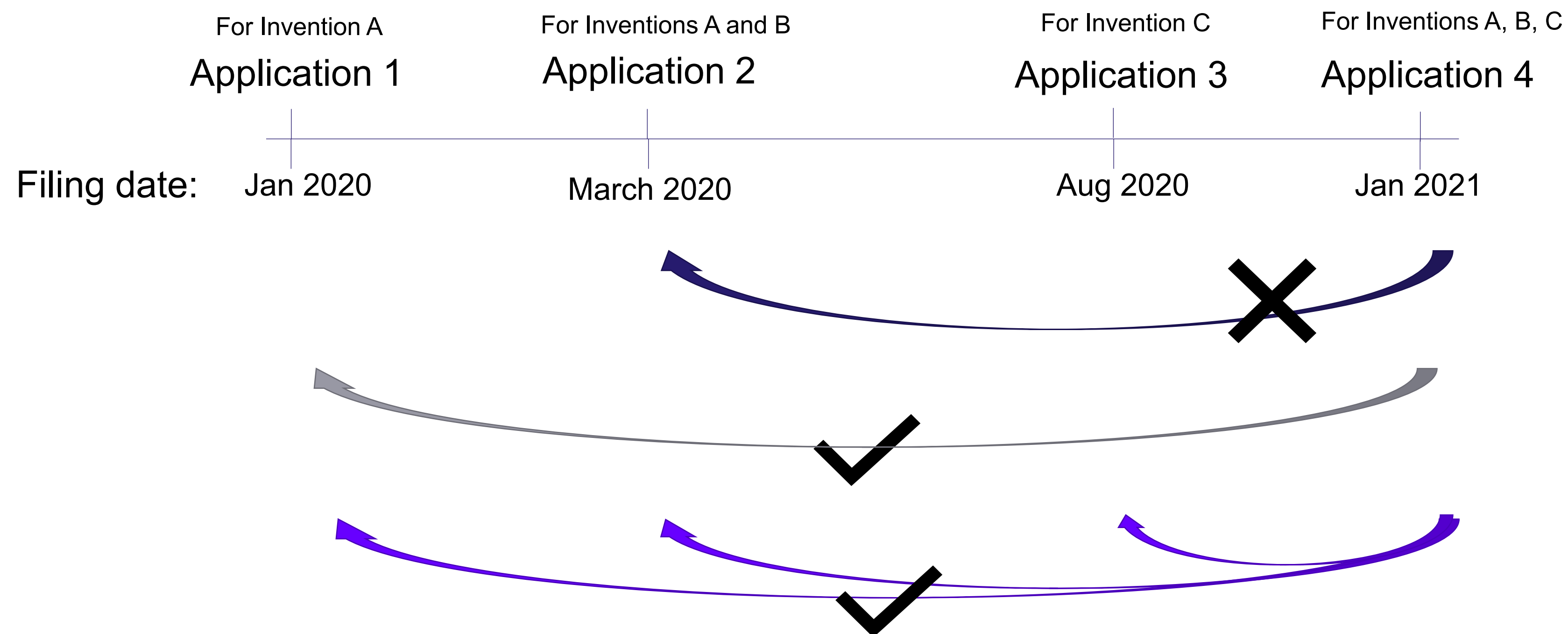
The UPC followed this in *Meril v Edwards Lifesciences*.

The Panel cited the G1/22 and G2/22 decisions and applied the ‘rebuttable presumption’ standard, finding that because of the evidence of transfer presented by the defendant, and the lack of specific evidence provided by the claimant to suggest that the original applicants intended to retain the priority rights instead of transferring them with the rights to the title of the patent, or that the priority rights had been assigned to another party presented by the claimants, the presumption of validity was not rebutted.

First application

#4. The priority can only be claimed for the **first** application for that subject matter.

- If not the first application for the **same** invention made by that applicant then the priority claim is invalid.
- Can claim priority from multiple applications



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: embodiment A in document 1, embodiment B in document 2. Later application can claim embodiments A & B but these will have different priority dates for deciding novelty/inventive step.

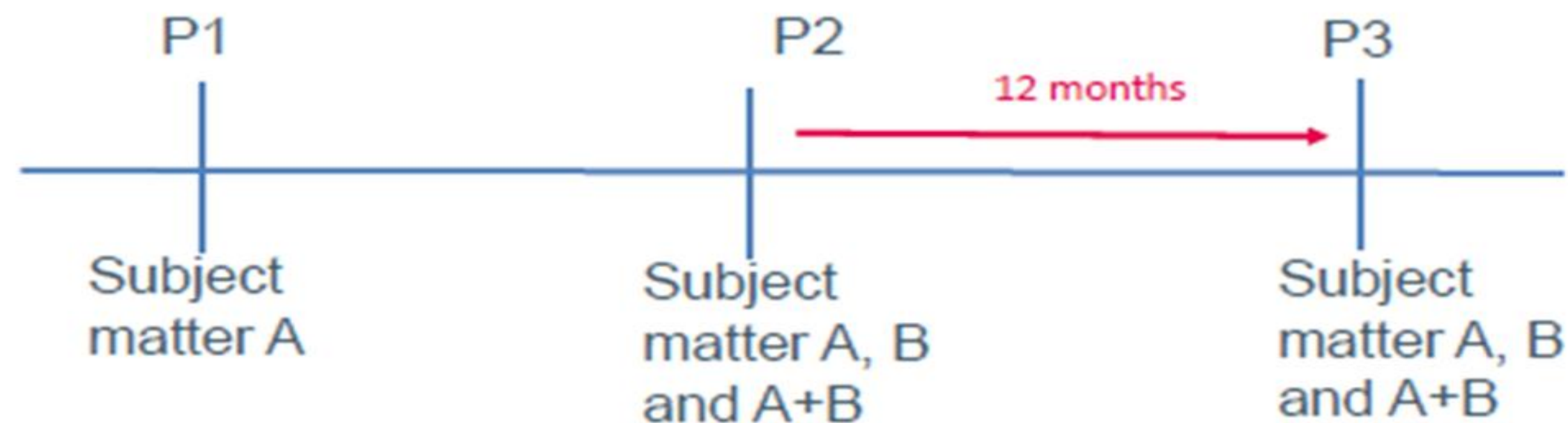
Example 2: feature A in document 1, feature B in document 2. Later application cannot claim priority for a combination of A & B if no combination disclosed. i.e., no mosaics of priority documents.

Partial Priority

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.



Regenerating a Priority Date

Paris Convention Article 4C(4):

‘A subsequent application concerning the same subject as a previous first application ... filed in the same country of the Union shall be considered as the first application, ... if, at the time of filing the subsequent application, the said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.’

- Rights outstanding include a residual right to claim priority to the withdrawn application.
- Under UK law, if the earlier application is simply withdrawn, there remains a right under Section 14(10) and Section 117 of the UK Patents Act 1977 to request correction of the withdrawal if it was made in error.
- Under UK Law if the earlier application is abandoned or refused then there may be an outstanding right to request reinstatement under Section 20A the UK Patents Act 1977, or to appeal the refusal.
- In each case, it remains possible to claim priority from the earlier application.
- Therefore, you need to withdraw priority application and state that it is done leaving no rights outstanding.

Common Problems with Priority Claims

- When care isn't taken as to filing the later application with the correct applicants.
- 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

When things go wrong (UK)

Later application filed after the 12 month priority period?

This is called a Late Filing –Section 5(2B) and 5(2C) of UK Patents Act 1977.

If the 12 month priority period is missed, but filing occurs within **14 months** from priority date, a request for a late declaration of priority may be made if:

- the comptroller is satisfied late filing was **unintentional** (must provide evidence)
- filling in form 3 and paying fee.

Will only be allowed 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.

When things go wrong (PCT and EPO)

Later application filed outside 12 month priority period?

PCT:

- Same period as the UK (14 months from priority)
- <http://www.wipo.int/pct/guide/en/gdvol1/pdf/gdvol1.pdf> (5.057-5.066)
- **No test** (e.g. no assessment of whether it was unintentional); however, the fact that the priority claim is retained in the international application does not mean that the validity of such a priority claim in the national phase is assured.

EPO

- Same period as the UK (14 months from priority)
- Stricter requirement of “**all due care**” - higher bar than unintentional
- See Case law of the EPO boards of appeal, III, E.4, 4.2

Practical Tips

- Ensure priority application is an enabling disclosure.
- Check applicants carefully.
- Ensure ownership of priority has been sorted out **BEFORE** filing later application.
- Ensure no earlier application for the same subject-matter
- 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, but must be done prior to publication.

Questions?

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