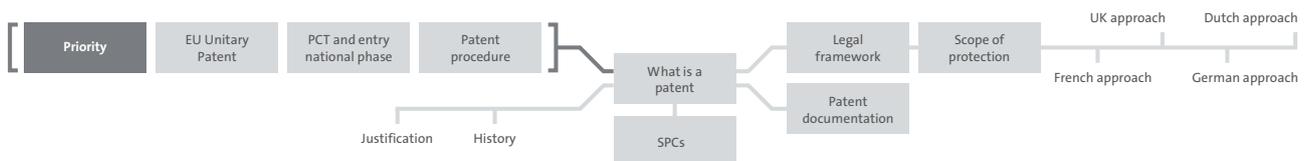


Priority

Essentials: Priority



Introduction

Due to the globalisation of markets and the increase in international trade, by the end of the 19th century there was a growing need for common international standards in applying for and protecting patents and other intellectual property rights. In particular, inventors who wanted to obtain patent protection for an invention in more than one country faced the problem that a patent application they filed in one country could be deemed to be novelty-destroying prior art in another country, if the application was filed subsequently in that other country. But national and translation requirements made it difficult for inventors to file patent applications for the same invention at the same time in more than one country. Consequently, whenever an invention was put on a particular market shortly after the first patent application was filed, the invention was no longer patentable in some of the other intended markets.

In order to solve this problem and to safeguard inventors' interests, the **Paris Convention** for the Protection of Industrial Property, concluded in 1883, introduced the concept of priority rights for patent applicants on an international level.

According to this **priority right**, anyone who files a patent application has the right to file an identical application in another signatory country of the Paris Convention within a certain time frame without being exposed to the risk that their own first application may be assessed as novelty-destroying in subsequent application procedures in other jurisdictions.

Consequently, the main effect of **priority right** is that, in terms of novelty, the filing date of the first application is considered to be the effective date for determining the state of the art of the subsequent applications within

Novelty

An invention can be patented only if it is new. An invention is not new and therefore not patentable if it was known to the public before the filing date, or before the priority date if priority of an earlier patent is claimed.

Paris Convention

The Paris Convention for the Protection of Industrial Property introduced the priority right for patents on an international level in 1883.

twelve months. The filing date of the first application is then defined as the priority date for any subsequent application for the same invention.

However, inventors need to be aware that priority right is a right limited by time. The time period for claiming priority for patent applications is twelve months. This period gives applicants the chance to identify market opportunities for their invention, continue development of the product or process and/or decide in which countries patent protection appears reasonable.

For inventors seeking patent protection for the same invention in more than one country, the principle of priority is very useful, as they do not have to file the application in all the countries concerned at the same time. As the first application is considered to have priority over subsequently filed applications and publications, the inventor will be considered as being the first to file in other countries, even if other applications are filed or relevant documents published in the meantime.

Definition

The priority date is the first date of filing of a patent application. It is essential for determining whether any subsequent application for the same invention can still be assessed as novel. It also makes it possible to determine whether the subject-matter of a patent application is prior art on a particular date.

The priority date is, however, not necessarily the same as the filing date.

The filing date of a patent application is the date the patent application was filed with the patent office, i.e. the date on which that application was legally accepted by that patent office. It is usually the date on which the documents are filed with the patent office. It may also be later, if there are formal errors in the application or certain documents are missing.

The filing date is usually the same as the priority date if the patent application is an original, non-provisional patent application, not a continuation application, and not previously filed in another country.

Legal basis

There are various types of priority right, with different legal bases.

1. Paris Convention

The Paris Convention is a multilateral arrangement between (currently) 175 contracting parties. One of its most important regulations is Article 4.

In essence, **Article 4** of the Paris Convention states that if an intellectual property right – in this case a patent – has been filed in one of the signatory countries, the applicant may claim priority for any subsequent identical application within twelve months, starting from the date of filing of the earlier application.

2. European Patent Convention

The European Patent Convention (EPC) is an international treaty that sets out a priority right system for first filings in or for states which are party to the Paris Convention or any member of the World Trade Organization (WTO). Article 87(1) EPC reads as follows:

"Any person who has duly filed, in or for

(a) any State party to the Paris Convention for the Protection of Industrial Property or

(b) any Member of the World Trade Organization,

an application for a patent, a utility model or a utility certificate, or his successor in title, shall enjoy, for the purpose of filing a European patent application in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application."

According to Article 88(2) EPC, it is even possible to claim multiple priorities of a patent application or a patent claim, meaning that an applicant may claim more than one priority based on previous applications in the same or different states and/or WTO members.

The effect of priority right according to the EPC is that the date of priority counts as the date of filing of the European patent application for the purposes of Article 54(2) and (3) and Article 60(2) (see Article 89 EPC).

The procedure for claiming priority for a European patent is laid down in Article 88 EPC and the Implementing Regulations.

Article 4 Paris Convention

(A)

Any person who has duly filed an application for a patent, [...], in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

(B)

Consequently, any subsequent filing in any of the other countries of the Union before the expiration of the periods referred to above shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the invention, the putting on sale of copies of the design, or the use of the mark, and such acts cannot give rise to any third-party right or any right of personal possession.

(C)

The periods of priority referred to above shall be twelve months for patents and utility models [...],

These periods shall start from the date of filing of the first application; the day of filing shall not be included in the period. [...].

Guidelines for Examination in the European Patent Office

www.epo.org/law-practice/legal-texts/guidelines.html

3. Patent Cooperation Treaty

The Patent Cooperation Treaty is an international patent law treaty. A PCT application establishes a single filing date in all contracting states and essentially leads to a standard national or regional patent application, which may be granted or rejected according to the applicable law in the relevant jurisdiction in which a patent is desired. As set out in **Article 8(1)** PCT, any such application may contain a declaration claiming a priority right based on an earlier patent application.

Article 8 PCT

Claiming priority

(1) The international application may contain a declaration, as prescribed in the Regulations, claiming the priority of one or more earlier applications filed in or for any country party to the Paris Convention for the Protection of Industrial Property.

4. Domestic priority rights

Some jurisdictions provide for a domestic priority right that allows inventors to claim the priority of a first application when filing a subsequent application within the same jurisdiction. For example, **Section 40** of the German patent law allows for the opportunity to claim a domestic priority.

Section 40(1)

German Patent Act

Within a period of 12 months from the filing date of an earlier patent or utility model application filed with the Patent Office, the applicant is entitled to a priority right with respect to the application for the same invention unless a domestic or foreign priority was already claimed for the earlier application.

Claiming priority

In order to claim priority rights, applicants must fulfil certain conditions. For a European patent, these conditions are laid down in Articles 87 and 88 EPC.

1. Timeline for claiming priority rights

Applications claiming priority of an earlier application must be filed within 12 months of the date of filing of the earlier application.

2. Substantive requirements

(a) Earlier application

In order to claim priority, an earlier application for the same patent must have been filed. An earlier application is any patent application which is duly filed with a patent office and whose application date is earlier than the application date of the subsequent application.

Applications for which a domestic or foreign priority has already been claimed are excluded.

(b) Identity of the applicant

The right to priority can only be claimed by the applicant who filed the priority application or their successor in title.

(c) Identity of invention

In order for a priority right to be claimed, there must also be identity of invention. “Identity of invention” or “same invention” is established if the earlier application substantially refers to the same invention as the subsequent invention. A literal identity of any subsequent application is not required. However, any changes in the subsequent application must still refer to the same invention as disclosed in the earlier application.

In other words, priority of an earlier application can only be claimed if the person skilled in the art can derive the subject-matter of the claim directly and unambiguously from the earlier application by using no more than his common general knowledge. This means that all the elements of the newly worded claim must have been disclosed, explicitly or implicitly, in the earlier application, i.e. it must be what is called an enabling disclosure.

According to the Enlarged Board of Appeal of the EPO in **G 2/98**, priority is effective “only if the skilled person can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole”.

Opinion of the Enlarged Board of Appeal of the EPO dated 31 May 2001, G 2/98
www.epo.org/law-practice/case-law-appeals/pdf/g980002ep1.pdf

In contrast, identity of invention is not possible if the invention disclosed in the subsequent application is characterised by additional features.

(d) Disclosure of characteristics

The right to priority is provided only for characteristics sufficiently disclosed in the patent application for them to be appreciated by a person skilled in the art.

The scope of the disclosure in the earlier application is determined from the application documents, i.e. the description, claims and drawings.

3. Formal requirements

In order to claim priority, the following must be provided:

- A declaration that priority is claimed.
- Information about the file number of the earlier application.
- A copy of the previous application.
- If necessary: a translation of the earlier application.

Summary

The major advantages and effects of priority right are:

- The filing date of the first application counts as the date by which the state of the art is assessed against the application.
- Applicants have, during the priority period of twelve months, time to evaluate the commercial potential of the invention, to continue developing it and to decide in which countries subsequent patent applications for the same invention should be filed.
- Applicants can postpone spending time and money on foreign patent application procedures until they have received a first report on the patentability of the invention.
- Applicants can make their invention public without generating novelty-destroying prior art in respect of any subsequent patent application within twelve months.
- Applicants can maintain the novelty of their inventions for subsequent patent applications filed elsewhere within twelve months, even if someone else has applied to patent the same or a similar invention in the meantime.