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RESTORATION OF PRIORITY RIGHTS

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Overview

Priority entitlement

Standards for determining existence of priority

Loss of priority

1) Causes of loss of priority
2) Legal consequences of loss of priority

Restoration of priority rights

1) Various rules in different jurisdictions
2) Requirements of Patent Law Treaty
3) FICPI‘s official position

Practice tips

Priority entitlement

Legal basis -- Article 4, Paris Convention

4A(1): Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, 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.

Is the “person” one in the countries of the Union?

-- A “national” or “resident” in a member country

What if not from a member country?

-- A person, though not from a member country, but from a country which provides priority to foreigners on reciprocity basis, may claim priority (very rare).

Is the type of the first application eligible?

Patent
Utility model (Innovation patent? Petty patent?)
Industrial design
Trademark

Is it possible to convert the type of protection when filing a subsequent application claiming priority from the earlier application?

√ Patent → Patent

√ Utility model → Utility model

√ Design → Design

√ Patent ←→ Utility model

√ Utility model → Design

× Patent → Design (?)

× Design → Patent

× Design → Utility model

Is the “person”, if different from that of the first application, his successor in title? (transfer of priority)

Is the subsequent application filed <u>during the fixed period</u>?

Article 4C(1)

*"The periods of priority referred to above shall be **<u>twelve months for patents</u>** and utility models, and **<u>six months for industrial designs and trademarks</u>**. "*

Patent → Patent	12M
Utility model → Utility model	12M
Patent ←→ Utility model	12M
Design → Design	6M
Utility model → Design	6M

Can a filing give rise to the right of priority?

Article 4A (2) & (3)

*Any filing that is **equivalent to a regular national filing** under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognized as giving rise to the right of priority.*

*By a regular national filing is meant **any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application.***

Qualification of “first application”

-- First regular national application—adequate to establish the application date

-- The subsequent fate of the first application (rejected, withdrawn, etc.) is immaterial to entitlement of priority

-- Certification from the patent authority accepting the first application may be needed for claiming priority.

-- Exceptions exist—Article 4C(4)
(rare in practice)

Article 4C(4)

"A subsequent application concerning the same subject as a previous first application within the meaning of paragraph (2), above, filed in the same country of the Union shall be considered as the first application, of which the filing date shall be the starting point of the period of priority, 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."

Is the invention for which priority is claimed the same subject as in the earlier application?

Article 4H

Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application in the country of origin, provided that ***the application documents as a whole specifically disclose such elements****.*

Legal test for determining “same subject” (China)

Whether the invention for which priority is claimed is **specifically** disclosed in the first application as a whole (same invention?)

-- It is **immaterial** whether the invention is **claimed** in the earlier application

-- It is **NOT** right to ask whether any “technical feature” can enjoy priority

Case study

Chinese Application No. 200880011218.X (national phase of PCT/US2008/053603) claims second medical use of gold nanoparticles comprising a polynucleotide

Two priorities claimed:	US60/900,648	filed 2007/02/09
	US60/956,205	filed 2007/08/16

Disputed point (claim language): ……”said binding moiety is **covalently** attached to said nanoparticles”

Examiner:

-- Only **gold thiol bond (Au-SH)** was disclosed in the priority applications, which cannot support the priority claim of the solution represented by the more generic term “covalently”, as it covers both gold thiol bond and **other bonds, such as Au-S bond**.

-- D1 (a research paper published 2007-11-23, within the priority period) discloses a solution with Au-S bond, thus is novelty-destroying.

Failed appeal to Patent Reexamination Board

Applicant forced to go back to gold thiol bond.

When there is an additional subject--

The issues of partial and/or multiple priorities arise

Loss of priority

Definition of loss of priority: legally entitled to priority, but the claim to it is denied due to failure to meet relevant deadlines (usually unintentionally)

Possible causes of loss of priority (failure to do any of the followings in time)

-- submit certified copy of the previous application

-- submit proof of priority right assignment

-- pay priority claim fee in full

……

-- file the subsequent application

Legal consequences of loss of priority

……“can be fatal to the validity of patent and design rights”

-- Actual filing date will be taken as “official” filing date

-- Thus, disclosure of the invention within the priority period could be taken as prior art and destroy novelty/inventiveness (as demonstrated in the case just talked)

Restoration of priority rights

Restorability of priority varies from country to country – revealed by FICPI's survey

-- In many jurisdictions, there seems to be no issue of restorations

-- In some others, the application of the restoration provisions is particularly strict

-- In small number of jurisdictions, there are no restoration provisions at all

In China-

-- Priority **cannot** be restored after the priority period (12M) expires

-- For PCT, restoration of priority (after 12M but before 14M) in the international stage is not recognized

-- Otherwise (e.g. too late submission of certified copy of the earlier application), restoration of priority is possible with certain amount of penalty fees

Harmonizing efforts ongoing……

Article 13(2), Patent Law Treaty

[Delayed Filing of the Subsequent Application] Taking into consideration Article 15, a Contracting Party shall provide that, where an application ("the subsequent application") which claims or could have claimed the priority of an earlier application has a filing date which is later than the date on which the priority period expired, but within the time limit prescribed in the Regulations (Rule 14(4)(a), the Regulations: The time limit shall expire not less than two months from the date on which the priority period expired), the Office shall restore the right of priority, if:

(TO BE CONTINUED)

Article 13(2), Patent Law Treaty

(i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;

(ii) the request is filed within the time limit prescribed in the Regulations (Rule 14(4)(b), the Regulations: The time limit referred to in Article 13(2) (ii) shall be the time limit applied under subparagraph (a), or the time that any technical preparations for publication of the subsequent application have been completed, whichever expires earlier) ;

(iii) the request states the reasons for the failure to comply with the priority period; and

*(iv) the Office finds that the failure to file the subsequent application within the priority period occurred in spite of **due care** required by the circumstances having been taken or, at the option of the Contracting Party, was **unintentional**.*

Article 13(3)

[Failure to File a Copy of Earlier Application] A Contracting Party shall provide that, where a copy of an earlier application …… is not filed with the Office within the time limit prescribed in the Regulations ……., the Office shall restore the right of priority, if…… (continued with similar wording to Article 13(2))

Other requirements of PLT

Article 13 (4) *[Fees] A Contracting Party may require that a fee be paid in respect of a request under paragraphs (1) to (3).*

Article 13(5) *[Evidence] A Contracting Party may require that a declaration or other evidence in support of the reasons referred to in paragraph (2)(iii) be filed with the Office within a time limit fixed by the Office.*

Article 13(6) *[Opportunity to Make Observations in Case of Intended Refusal] A request under paragraphs (1) to (3) may not be refused, totally or in part, without the requesting party being given the opportunity to make observations on the intended refusal within a reasonable time limit.*

FICPI's official position
Resolution of the Executive Committee, Sorrento, Italy,
29 September – 02 October 2013

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Urges the authorities in territories where priority right restoration is not available to introduce provisions enabling such restoration, and

Further urges the authorities in territories where the criterion for restoration of priority rights is "in spite of all due care required by the circumstances" or similar, to **either**:

1. change the interpretation of this criterion to **take reasonable account of the intention of the proprietor in addition to the due care applied at the time when the failure occurred**, or

2. **change the criterion to the unintentional criterion**.

FICPI's considerations:

……despite the use of normally-satisfactory monitoring systems, some isolated mistakes can occur which result in failure to comply with formal requirements such as a time limit vis-a-vis an IP Office,

……very strict and often unrealistic interpretation of the "in spite of all due care required by the circumstances" criterion by IP offices and judicial authorities has resulted in losses of rights that are **out of proportion to the circumstances of the failure and are contrary to the intentions and reasonable expectations of the proprietor of the IP right**,

.....

FICPI’s considerations:

……a loss of priority in the case of patent and design rights can be fatal to the validity of those rights,

……the standard of unintentionality is applied under the laws of various territories,

……any provisions on restoration of priority rights should be subject to conditions that safeguard the legitimate interests of third parties.

FICPI’s emphases

-- aware of the various issues arising from the application of “due care” criterion

-- gives more weight to unintentionality

-- makes the rules more lenient to patent filers

Practice tips

Take-home message:

-- Be aware of the various laws/practices in different jurisdictions, especially regarding restorability of priority

-- Well manage important deadlines concerning priority

-- Seek advice/assistance from local counsel when any “non-restorable” deadline is missed

-- Preserve evidence of unintentionality and due care, if any, for possible future use as supporting evidence

Thank You!

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