I.7. Priority right under the PCT

I.7.1. Priority claim

Art.8(1) PCT

Priority can be claimed from one or more applications made in or for Paris Convention countries according to the regulations.

Art.8(2)(a) PCT

The conditions and the effects of any priority claim under Art.8(1) PCT are as provided for in Art.4 of the Stockholm Act of the Paris Convention.

Note: The International Bureau (WIPO) which administers the PCT is not a "state" within the meaning defined in the charter of the United Nations. Consequently, the International Bureau cannot adhere to the Paris Convention. For this reason the PCT sets up the same patent priority requirements as in the Paris Convention by referring in Art.8(2)(a) PCT to Art.4 of the Stockholm Act of the Paris Convention.

Note: A similar situation exists in the EPC, since the EPO cannot adhere to the Paris Convention either. In the case of the EPC the provisions governing priority of European patent applications are copied from Art.4 Paris Convention into Art.87 EPC (see the decision T301/87, reasons for the decision 7.5).

Who may claim priority

Art.4A(1) PC (the Paris Convention) states that the person who filed the earlier application or his successor in title has the right to claim priority from that earlier application. This means that an applicant may claim a priority from an earlier application filed by a different applicant only if he has acquired the right to do this. This also applies in the PCT. The Official PCT Request form contains a box where, if relevant, the applicant may indicate how he acquired the right to claim priority (e.g. by transfer, assignment, agreement, change of name). The event leading to the applicant acquiring the right to claim priority must have occurred before the International filing date.

Types of application used as priority

Art.8(1) PCT

Priority can be claimed from one or more applications.

Note: The Paris Convention, Art.4(A), defines the conditions for claiming priority from patents, utility models, industrial designs and trademarks. The Paris Convention explicitly indicates that a utility model may serve as a priority for a patent and vice versa (Art.4E(2) PC), but it is silent about whether other forms of protection can serve as a priority for a patent application. However, Art.2(t) PCT indicates that the term "application" means an application for the protection of an INVENTION, and that the term "application" is construed as a reference to an application for:

- patents for inventions
- inventors' certificates
- utility certificates
- utility models
- patents of addition
- certificates of addition
- inventors' certificates of addition
- utility certificates of addition

It therefore appears that any of these forms of protection of INVENTIONS may give rise to a right of priority under Art.8(1) PCT. Note that industrial designs and trademarks are NOT in this list.

J15/80

The EPO does not accept an application for an Industrial design as an application giving rise to a priority right.

States of priority

Art.8(1) PCT

Priority can be claimed from one or more applications made in or for* Paris Convention countries according to the regulations.

* Note: An application made in a state is a national application filed to obtain a national patent in that state.

* Note: An application made for a state is an application where the state in question is designated via the PCT or via a regional patent treaty (ARIPO, Eurasian Patent Convention, EPC, OAPI) or under bi- or multi-lateral agreements (e.g. Switzerland and Liechtenstein - OJ 1980, 407).

Priority from WTO members

R4.10(a) PCT

Priority can also be claimed from an application filed in a member of the World Trade Organisation (WTO) which is not a party to the Paris Convention.

Note: Careful reading of this rule reveals that the members of the WTO in which priority applications recognised under this rule may be filed need not be states as such.

However, all members of the WTO are states with the exception of The European Community and Taiwan. Taiwan is not recognised as a state by the UN and so
cannot adhere to the Paris Convention, since it is currently considered by the UN to be a province of People's Republic of China. However, Taiwan is a member of the WTO.

Note: Strictly speaking this new rule (valid from 01.Jan.2000) is bending Art.8 PCT very far indeed, since this article only allows priorities to be claimed for applications deriving from members of the Paris Convention. In the end it is the article which should prevail over a contradictory rule (Art.58(5) PCT).

Reservations: Non-recognition of WTO priorities

R4.10(d) PCT Where the legislation of designated offices does not allow them to accept priority claims according to this new R4.10(a) PCT, these offices can apply the previous version of R4.10(a) PCT.

R4.10(a) PCT (valid until 31.Dec.1999) This older rule did not refer to the WTO.

Note: This reservation has been used by the EPO (Art.87 EPC limits priority claims to members of the Paris Convention). The EPO is the only office to have a current reservation under R4.10(d) PCT (the Japanese office had a reservation under this rule, but this has since been lifted).

G2/02 & G3/02 These decisions of the EPO Enlarged Board of Appeal confirmed that the EPO does not recognise priority from applications filed in respect of TRIPS/WTO members, which are not also signatories to the Paris Convention.

Request and the priority claim

R4.1(b)(i) PCT The priority claim must be in the Request.

Contents of priority claim

R4.10(a) PCT The priority claim on the Request must indicate:

(i) The date of the priority filing, which should be no earlier than 12 months* before the International filing date.

* Note: This is already an implicit requirement of Art.8(2)(a) PCT deriving from its reference to Art.4 of the Paris Convention (which fixes the priority period for patents at a maximum of 12 months).

(ii) The file number of the priority

(iii) If the priority is a national application the state of filing (where the Paris Convention applies) or the member of the WTO (where the Paris Convention does not apply).

(iv) If the priority is a regional application, the regional authority entrusted with granting regional patents under the relevant treaty (e.g. the EPO, ARIPO, OAPI, Eurasian Patent Office).

(v) If the priority is an earlier International application, the Receiving Office.

Note: For correction of deficiencies in the content of the priority claim see the section "I.7.5 - Correction or addition of a priority claim".

Duplicated protection

Art.8(2)(b) PCT The applicant can designate the same state as that in which or for which the priority was filed. However if:

- the International application claims at least one priority from a designated state, or,

- the International application claims the priority of a previous International application where only one state was designated,

then the conditions for and effect of the priority claim are governed by national law of that state.

Note: The EPC has a similar provision - Art.139(3) EPC, which states that where a European application or patent has the same filing or priority date as a national application or patent, then the issue of double patenting is dealt with by the national law of the state where the priority application was filed.

Avoiding duplicated protection

Note: In certain cases the applicant can avoid designating the state of the priority in order to avoid duplicating patent rights, see the section: "I.4.3 - Excluded designation of state of priority"

Supplying the priority document

Note: The requirements below apply in respect of priority claims made according to Art.8 PCT, by the applicant in respect of his International application in the PCT.

Where to file the priority document

The applicant must file a certified copy of the priority document (certified by the office where it was filed) to the International Bureau or the Receiving Office.
RO-GL 181 - Where the priority document is filed at the Receiving Office, this office will forward it to the International Bureau on request of the applicant.

**Time limit**

R17.1(a) PCT The applicant must file the certified copy of the priority document at the International Bureau or the Receiving Office within 16 months of the earliest priority claimed, but if the document is supplied to the International Bureau before International publication, it is considered filed on time.

*Note: Effectively the time limit for filing the priority document is up to the publication of the International application (18 months after the earliest claimed priority - Art.21(2)(a) PCT).*

However, note that this only applies if the International Bureau receives a copy of the priority document before publication. If the applicant supplies the priority document to the Receiving Office after 16 months and very soon before publication, and the Receiving Office does not forward this to the International Bureau before publication, then the time limit for supply of the priority document according to R17.1(a) PCT is not deemed respected.

**Priority document issued by Receiving Office**

R17.1(b) PCT Where the priority document was issued by the Receiving Office, the applicant may simply request the Receiving Office to forward a copy of the priority document to the International Bureau. This request must be made within 16 months of the priority. The Receiving Office may require a fee for this service.

PCT-AG I, 99 The request form contains a box where the applicant can make his request to the Receiving Office to transmit a copy of the priority document to the International Bureau (in Box VI).

Where the EPO is Receiving Office, it will forward the priority document on request by the applicant and charges a fee for this.

RO-GL 187 Where the applicant makes the request to the Receiving Office for forwarding of a copy of the priority document to the International Bureau, but does not pay the necessary fee (where this is required by the Receiving Office), the Receiving Office will invite him to pay it within the 16 month time limit of R17.1(b) PCT if this has not yet expired. Where the applicant does not pay this fee within the 16 month time limit, then the request for inclusion of the priority document is considered not to have been made.

A.I. 323(b) & A.I. 323(d) Where the priority document is deemed not to have been filed on time (because the applicant did not pay the fee to the Receiving Office), then the Receiving Office informs the International Bureau and the applicant.

RO-GL 190 If, however, the applicant pays the fee:

- later than 16 months after the priority (the time limit according to R17.1(b) PCT),
- but before the Receiving Office has sent to the notification of deemed loss of priority to the International Bureau, then the Receiving Office may forward a copy of the priority document to the International Bureau. If the document arrives at the International Bureau before publication, the time limit according to R17.1(a) PCT is deemed respected.

**Digital library**

R17.1(b-bis) PCT If the priority document is available to the Receiving Office or to the International Bureau from a digital library in accordance with the Administrative Instructions, the applicant can, subject to any fee required by the Receiving Office, make the following requests within 16 months at the Receiving Office or the International Bureau:

(i) request the Receiving Office to obtain the priority document from the digital library

(ii) request the International Bureau to obtain the priority document from the digital library

*Note: To the authors’ knowledge as yet there are no such digital libraries (situation Jan.2006).*

**Sanction for failure to file - national phase**

R17.1(c) PCT If the requirements of R17.1(a) PCT, R17.1(b) PCT or R17.1(b-bis) PCT are not met [i.e. the priority document was not made available in time] then, subject to R17.1(d) PCT*, the designated state can disregard the priority claim.

*Note: According to *R17.1(d) PCT the designated office must give the applicant a second chance to file the priority document in the national or regional phase before it can disregard the priority claim. This rule also states that if the priority document is available to the designated office via a*
digital library according to the Administrative Instructions, then that office cannot disregard the priority claim. However, to the authors’ knowledge as yet there are no such digital libraries (situation Jan. 2006).

Note: According to the EPC, the applicant gets his second chance to supply the priority document in the European regional phase according to R111(2) EPC. See the section: "IV.11.3.3 - The applicant did not supply the priority document in the International phase"

In certain cases the applicant does not need to file the priority document in the European regional phase at all - see the section: "IV.11.3.4 - Cases where the applicant never needs to file the priority document".

**Sanction for failure to file - at IPEA**

R66.7(a) PCT If the IPEA needs a copy of the priority document, then it requests it from the International Bureau.

R66.7(a) PCT Where none of the criteria below are satisfied, the priority claim can be ignored by the IPEA in preparing the preliminary examination report:

- the applicant has complied with R17.1 PCT and made a copy available to the International Bureau (by sending it himself to the IB under R17.1(a) PCT or by requesting the Receiving Office to do this for him under R17.1(b) PCT)
- the priority document is available to the IPEA from a digital library according to the Administrative Instructions [none exist yet]
- the priority document was filed with the IPEA* (e.g. the priority is a European application and the EPO is the IPEA).

* Note: In cases where the IPEA was the office of the priority, the IPEA cannot deem the priority claim to be invalid because the applicant did not supply a copy of the priority document under R17.1 PCT, because a copy is available to it. However, this does not exempt the applicant from the need to file the priority document at designated offices when it passes into the national / regional phase if this was not supplied to the International Bureau according to R17.1 PCT.

**Translation for IPEA**

R66.7(b) PCT If the priority document is not in a language accepted by the IPEA, then the IPEA may invite the applicant to file a translation into one of the languages it accepts within two months of the invitation [this may be done where the priority is relevant for the assessment of the novelty and/or inventive step of the claimed invention].

If the translation is not supplied on time, the priority claim may be ignored in the International Preliminary Examination.

**Public access to priority document**

R17.2(c) PCT After publication of the International application, the International Bureau will, on request, furnish to any person a copy of the priority document, provided that:

- the person pays for the service
- the application was not withdrawn before publication*
- the priority was not withdrawn or deemed withdrawn before publication

* Note: If the application is withdrawn before publication, but after the end of the technical preparations for publication (15 days before 18 months after the priority - PCT-AG I, 305), then it is possible that the application is still published under Art.21 PCT, even though it was withdrawn before publication. The supply of the priority document is, of course, also conditional on the applicant filing it at the International Bureau in the International phase under R17.1 PCT.

**I.7.3. Time limits calculated from the priority**

Note: Many time limits in the PCT are calculated from the priority date. For example, the PCT time limit for passage into the national phase is 30 months after the priority date (Art.22 PCT / Art.39 PCT).

Art.2(xi)(b) PCT If more than one priority is claimed under Art.8 PCT, then time limits are calculated from the earliest priority.

Art.2(xi)(c) PCT If no priority is claimed, then time limits calculated from the priority start on the International filing date.

R90bis.3(d) PCT If the priority date shifts due to the abandonment of one or more priority claims under either R90bis.3(a) PCT or R90bis.3(b) PCT, then time limits which are still running which are calculated from the original priority date, are shifted to start from the new priority date.

R90bis.3(e) PCT - Where a priority is abandoned - for the effect on the
Part I

publication see the section "I.7.4 - Withdrawal of priority claim"

R26bis.1(c) PCT Where the correction or addition of a priority date causes the original priority date to change, and time limits calculated from the original priority date have not yet expired, then the time limits are calculated from the amended priority date.

[See the section "I.7.5 - Correction or addition of a priority claim"]

I.7.4. Withdrawal of priority claim

Note: Since some time limits are calculated from the priority date, withdrawal of the priority is a means to extend these time limits, where they have not yet elapsed. For example, to delay publication of the application (Art.21(2)(a) PCT).

R90bis.3(a) PCT The applicant can withdraw the priority claim in the International phase.

R90bis.3(b) PCT Where there is more than one priority claim, the applicant can withdraw as in R90bis.3(a) PCT one or more of those priority claims.

Time limit

R90bis.3(a) PCT The withdrawal must be made within 30 months of the priority date.

Notice of withdrawal

R90bis.3(c) PCT The notice of withdrawal of the priority is addressed to the International Bureau or to the Receiving Office, and where Art.39(1) PCT applies (i.e. where the applicant has opted for International Preliminary Examination), it may also be sent to the IPEA.

R90bis.5(a) PCT Where there is more than one applicant, the notice of withdrawal of the priority claim according to R90bis.3 PCT must be signed by all applicants. Where one applicant has been appointed as common representative by default according to R90.2(b) PCT*, then the notice of withdrawal must be signed by all applicants [it cannot simply be signed by that common representative].

* Note: See the section "V.2.3 - The common representative". Where the common representative has been actively appointed by all applicants according to R90.2(a) PCT, then he can sign the notice of withdrawal of the priority claim.

Time limits calculated from the priority

R90bis.3(d) PCT Where the abandonment of the priority leads to a change in the priority date* any time limits not already expired when the abandonment takes place, are then calculated from the new priority date.

Note: Unlike the situation with the correction to an earlier priority date (see the section "I.7.5 - Correction or addition of a priority claim"), this procedure holds no danger that the applicant will miss any currently running time limits, since any time limits still running from the abandoned priority can only be extended.

* Note: Art.2(xi)(b) PCT - Since in cases of multiple priority claims, the earliest priority date is used to calculate time limits, the priority date will only change if the earliest or the only priority is abandoned. If a later priority is abandoned, according to Art.2(xi)(b) PCT it is still the earliest one which is used to calculate time limits.

Late withdrawal and publication

Note: Normally the International application is published 18 months after the earliest priority date (Art.21(2)(a) PCT & Art.2(xi) PCT). If the earliest claimed priority is withdrawn before publication, the publication will be postponed to 18 months after the filing date (if no other priority is claimed) and to 18 months after the next earliest priority date (if later priorities dates are claimed). This is with the proviso that the withdrawal is made sufficiently early - see below:

R90bis.3(e) PCT However, where the priority is withdrawn by the applicant and the withdrawal reaches the International Bureau* after the completion of the technical preparations for publication, the publication may go ahead calculating the time limit according to Art.21(2)(a) PCT from the abandoned priority date (18 months after the abandoned priority).

PCT-AG I, 305 The technical preparations are usually over by the 15th day prior to publication (which occurs 18 months after the earliest priority date - Art.21(2)(a) PCT).

* Note: The withdrawal of the priority may be filed directly at the International Bureau, or at the Receiving Office or the IPEA (R90bis.3(c) PCT), the latter two will forward the withdrawal to the International Bureau.

It is the date that the withdrawal arrives at the International Bureau which decides if it is in time to delay International publication, since it is the International Bureau which is responsible for the publication according to Art.21(1) PCT.
Consequently, if the applicant wants to delay publication of the International application and the end of the technical preparations for publication is close, then he should file the withdrawal of the priority directly at the International Bureau.

**National processing**

R90bis.6(a) PCT The withdrawal of the priority claim has no effect in states were the national / regional processing of the application has already started.

*Note: This may happen where the applicant requests early entry into the national / regional phase according to Art.23(2) PCT or Art.40(2) PCT in respect of certain designated offices only, and subsequently withdraws the priority claim before 30 months after the originally claimed priority date. This then shifts the 30 month time limit for entering the national / regional phase forward to 30 months from the next priority date*, but only for those offices for which the national / regional phase has not yet begun (i.e. those not subject to the early entry into the national / regional phase).

* This may be the International filing date itself, where no other priorities are claimed - Art.2(ii)(c) PCT.

**Withdrawal for certain states only**

J6/00 The applicant cannot withdraw the earliest priority claim in respect of certain designated states and not in respect of others in the PCT. Such a withdrawal of priority is considered invalid by the EPO as designated office. The time limit for entering the European regional phase remains 31 months from the priority date, which the applicant attempted to partially abandon.

**Inventor does not sign notice of withdrawal**

PCT-AG I, 441, 442 The Guide indicates that the withdrawal of a priority, cannot be effected without the signature of the inventor-applicant for the USA, unless the conditions of R90bis.5(b) PCT are satisfied [see below]

R90bis.5(b) PCT If the following conditions all apply:

- two or more applicants file an application
- they designate a state which requires national applications to be filed by the inventor (the USA)
- an inventor-applicant for that state is not available to sign even after a diligent effort then the notice of withdrawal of the priority only needs to be signed by the other applicants as long as one or more of the following conditions are satisfied:

- a satisfactory explanation is given to the International Bureau, Receiving Office or IPEA** as to why that applicant (i.e. the inventor) did not sign, or,
- the requirements of R4.15(b) PCT* have already been met

* Note: This means that a satisfactory explanation has already been supplied explaining to the Receiving Office why that inventor-applicant did not sign the Request.

** Note: Presumably, this explanation must be furnished to whichever of these offices the applicant filed the notice of withdrawal.

**Designation of USA withdrawn**

R90bis.2(a) PCT The applicants can withdraw the designation of the USA (or of any designated state).

Note: For this withdrawal to be effective, the inventor's signature will normally be required - see the section "I.4.6 - Withdrawal of designations".

PCT-AG I, 459 After the designation of the USA is withdrawn, the inventor is no longer a co-applicant.

Note: Consequently, in the above case, where the designation of the USA has already been withdrawn, it would appear that the inventor (who is no longer an applicant) does not need to sign the notice of withdrawal of the priority.

**Power of attorney waiver**

R90.4(e) PCT & R90.5(d) PCT The power of attorney waiver does not apply with regard to withdrawals.

Note: In the case of a withdrawal, any agent can only sign the notice of withdrawal if he supplies a power of attorney (R90.4(a) PCT) or a copy of a general power of attorney (R90.5(a) PCT), or if he has been appointed by the applicant signing the Request or the Demand. For more details, see the section "V.2.4.3 - Power of attorney waiver".