



Topic 9: **Priority Claims and Prior Art**

Lutz Mailänder

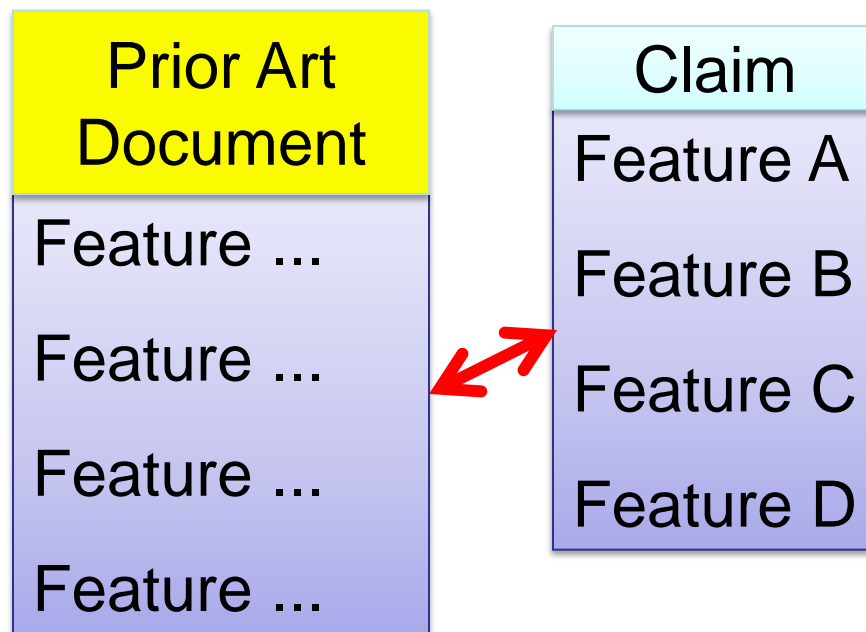
Head, International Cooperation on Examination and Training Section

Riyadh
February 1, 2018

Agenda

- Prior art in the presence of priorities
 - Multiple priorities
 - Priorities claiming a priority itself
- Validity of priorities

Novelty



- Subject matter described in a claim is not novel if

all features are known

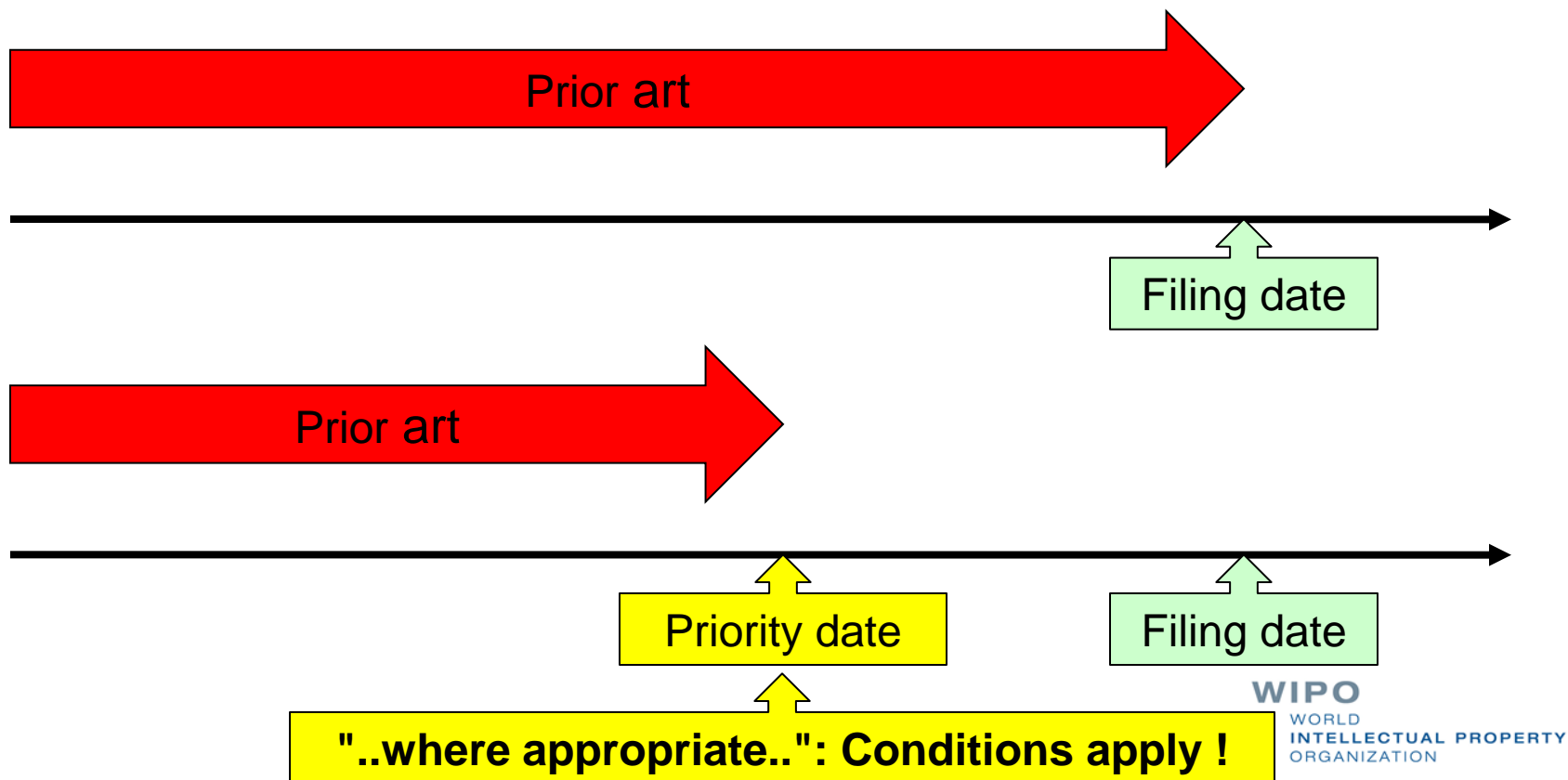
from a **single** piece of **prior art**, e.g. another patent

Prior Art

- "Prior art shall consist of everything **disclosed** to the public, anywhere in the world, by publication in tangible form or by oral disclosure, by use or in any other way, **prior to the filing date** or, where appropriate, the **priority date**, of the application claiming the invention."

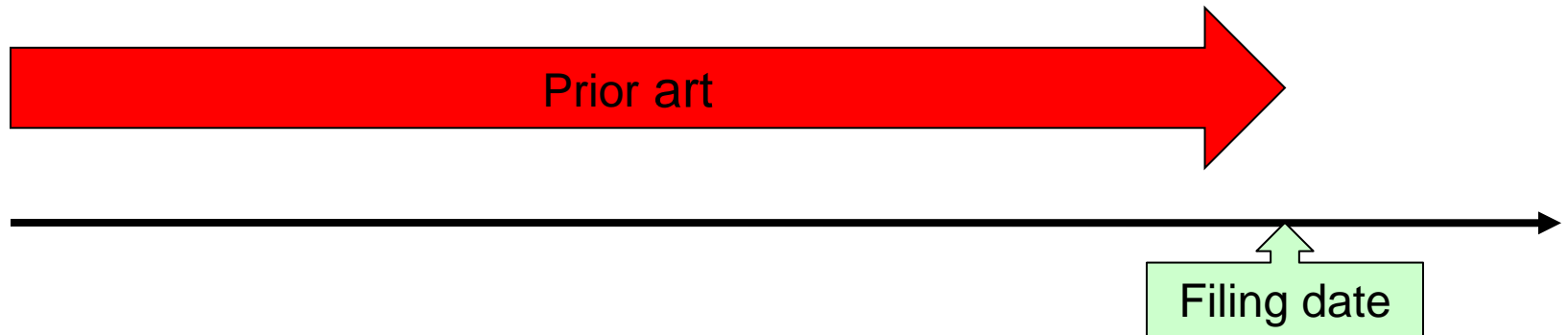
Prior Art

- Any information that is made **available to the public** until the application date or the **priority date** (provided priority is valid)



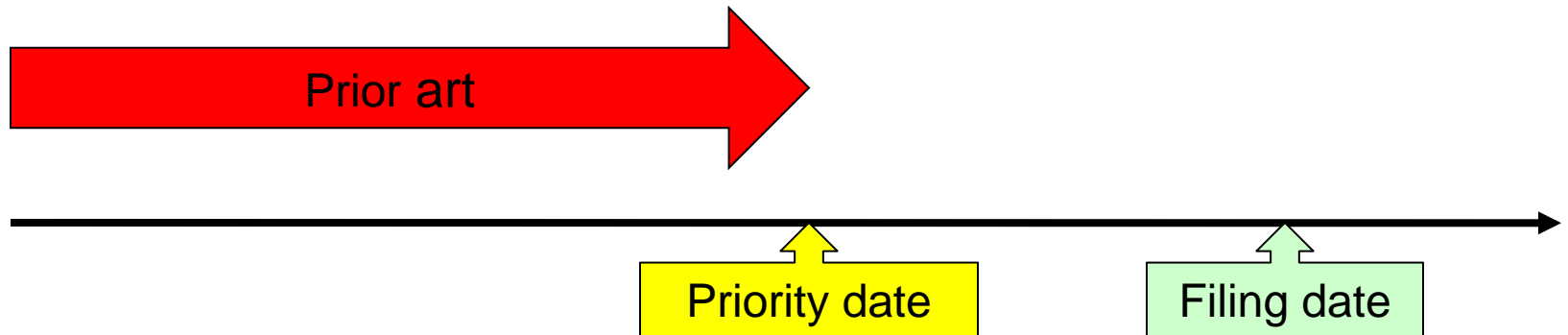
Example: difficulty with multiple priorities

- No priority, OFF



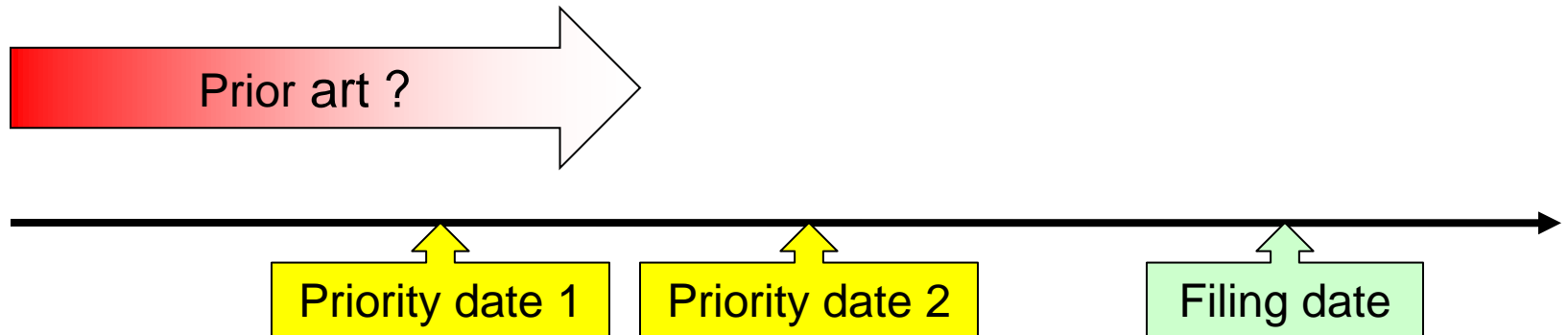
Example: difficulty with multiple priorities

- Single priority



Example: difficulty with multiple priorities

- Several priority dates > different prior art



Article 4 F Paris Convention

"No country of the Union may refuse a priority or a patent application on the ground

that the applicant claims **multiple priorities**, even if they originate in **different countries**, or on the ground

that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed,

provided that, in both cases, there is unity of invention within the meaning of the law of the country.

With respect to the elements not included in the application or applications whose priority is claimed, the filing of the subsequent application shall give rise to a right of priority under ordinary conditions."

Article 4 F Paris Convention

"No country of the Union may refuse a priority or a patent application on the ground

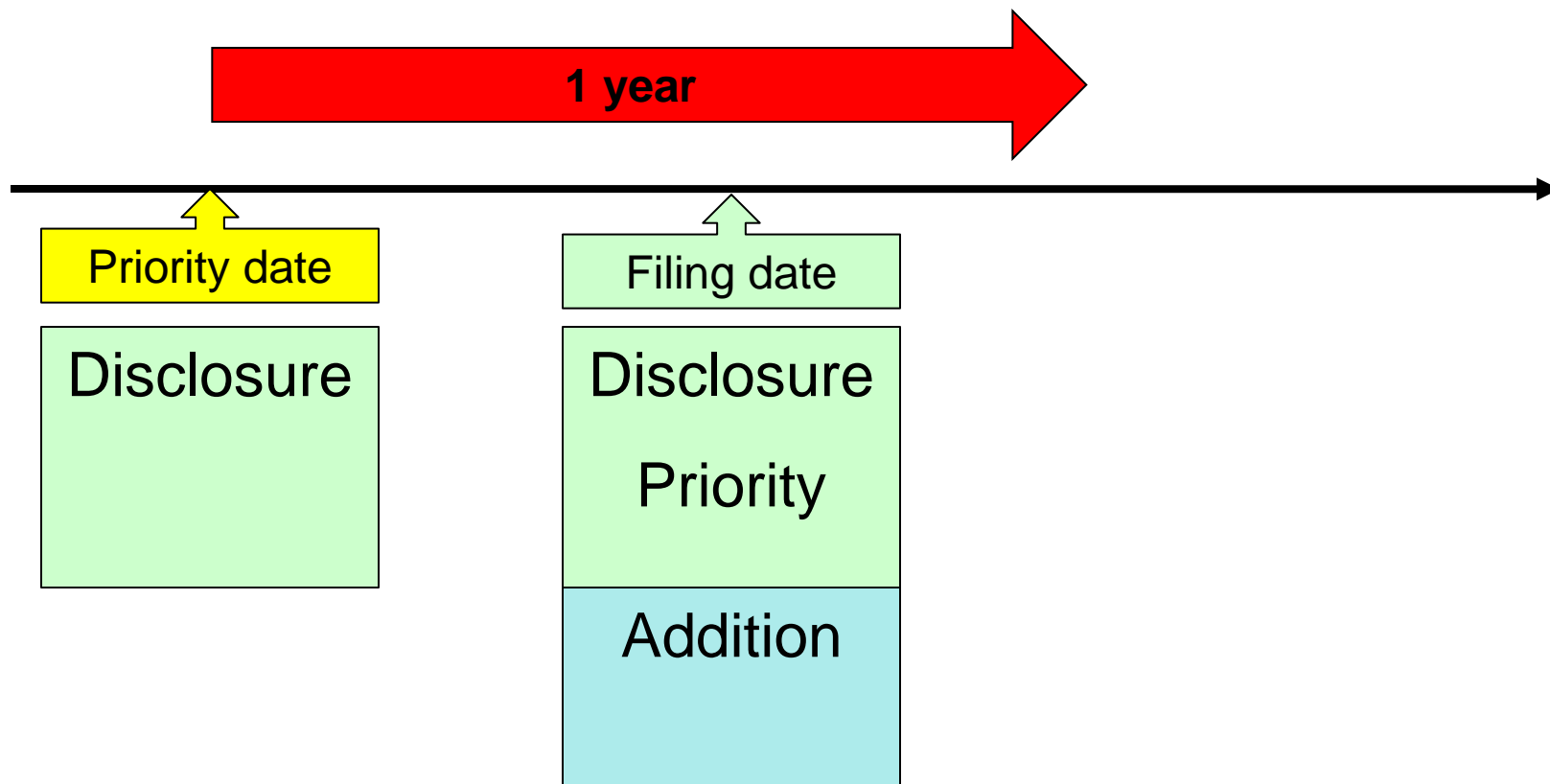
that the applicant claims multiple priorities, even if they originate in different countries, or on the ground

that an application claiming one or more priorities contains **one or more elements that were not included** in the application or applications whose priority is claimed,

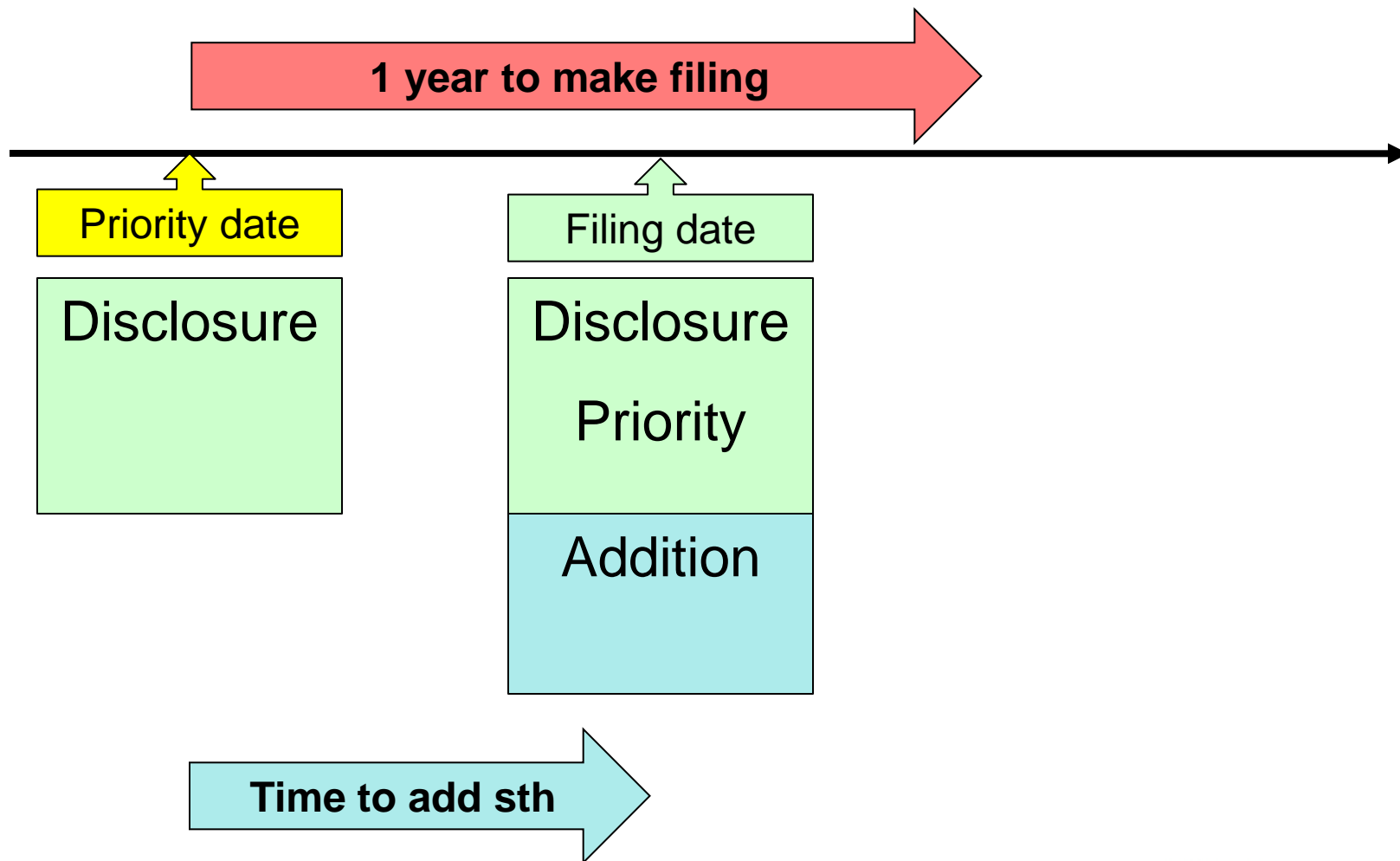
provided that, in both cases, there is unity of invention within the meaning of the law of the country.

With respect to the elements not included in the application or applications whose priority is claimed, the filing of the subsequent application shall give rise to a right of priority under ordinary conditions."

Priorities and additions of subject matter

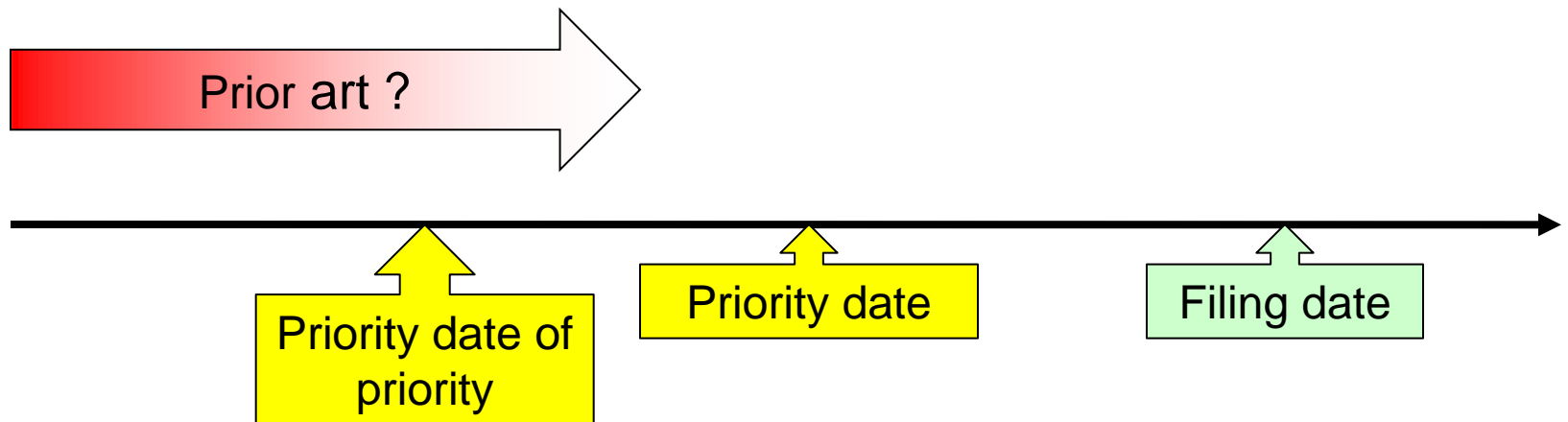


Priorities and additions of subject matter



Example: difficulty priority claiming priority

- Single priority which itself claims another priority



Article 4 F Paris Convention

"No country of the Union may refuse a priority or a patent application on the ground

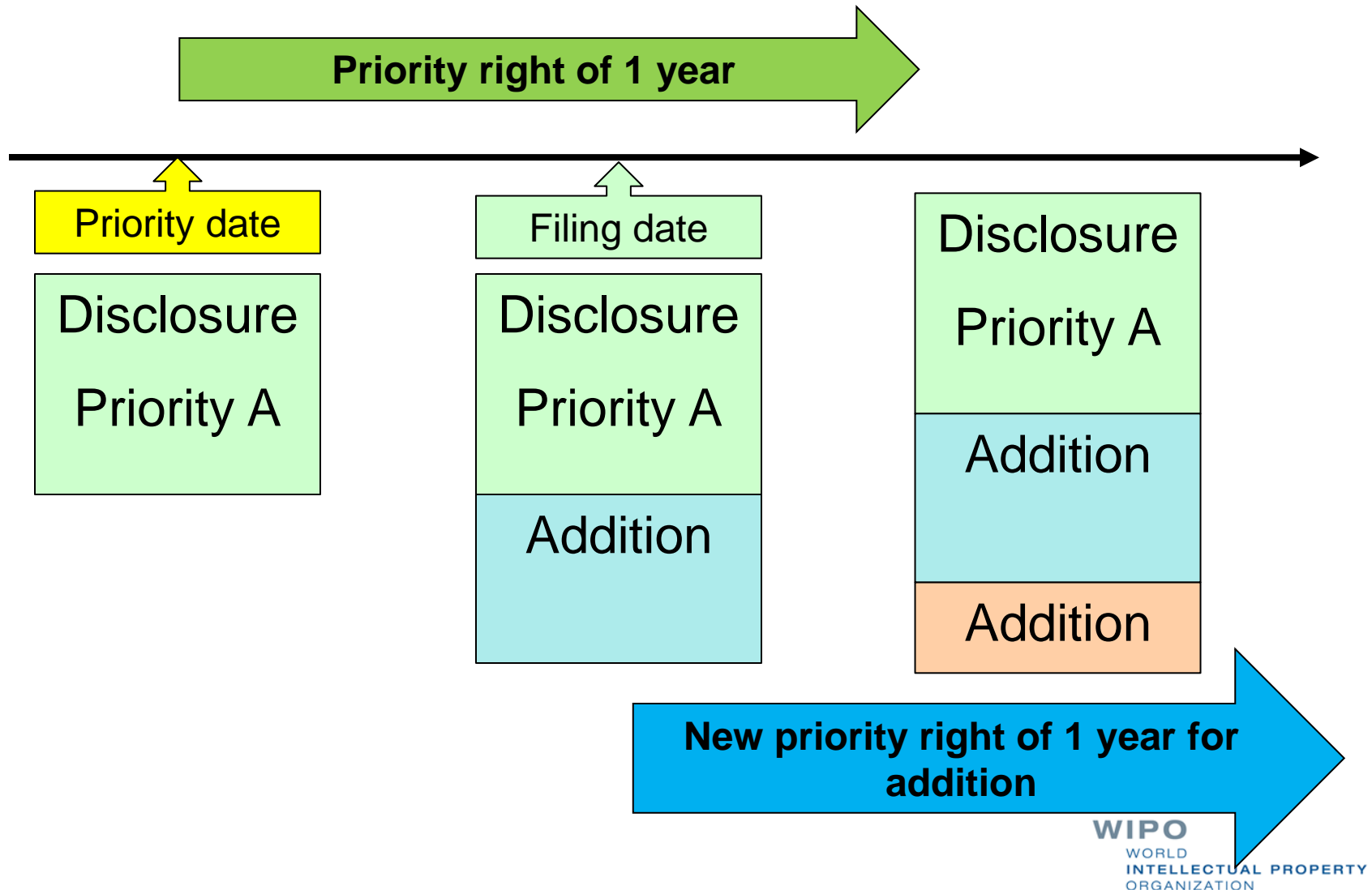
that the applicant claims multiple priorities, even if they originate in different countries, or on the ground

that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed,

provided that, in both cases, there is unity of invention within the meaning of the law of the country.

With respect to the **elements not included in the application** or applications whose priority is claimed, the filing of the subsequent application shall **give rise to a right of priority** under ordinary conditions."

Priorities and additions of subject matter



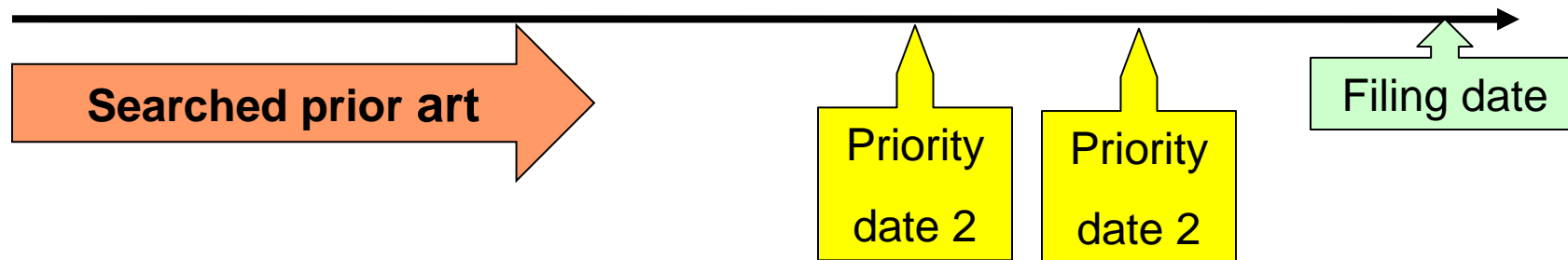
Article 4 F Paris Convention

- With other words:

Whenever subject matter is disclosed for the **first time** in an application, this creates a priority right for one year.

Prior art and priorities: Don't worry !

- If all relevant prior art documents are before the earliest priority date one need not worry about priorities even if there are several



- The categories P and E in ISRs indicate the prior art where validation of priorities is needed!

Conditions for claiming priority rights

■ **Date of filing the later application**

- Application to be filed within 12 months after **first** filing [PC Art. 4 C (1)]
- Requires explicit declaration indicating application details of earlier application [PC Art. 4 D (1)]

■ **Date of declaration of the priority claim**

- Differing national time limits for making priority claim declaration [PC Art. 4 D (1)]
- Usually to be claimed when filing the application
 - Sometimes grace period, e.g. 4 months for PCT [Rule 26bis.1]
- Usually not possible anymore after examination has commenced

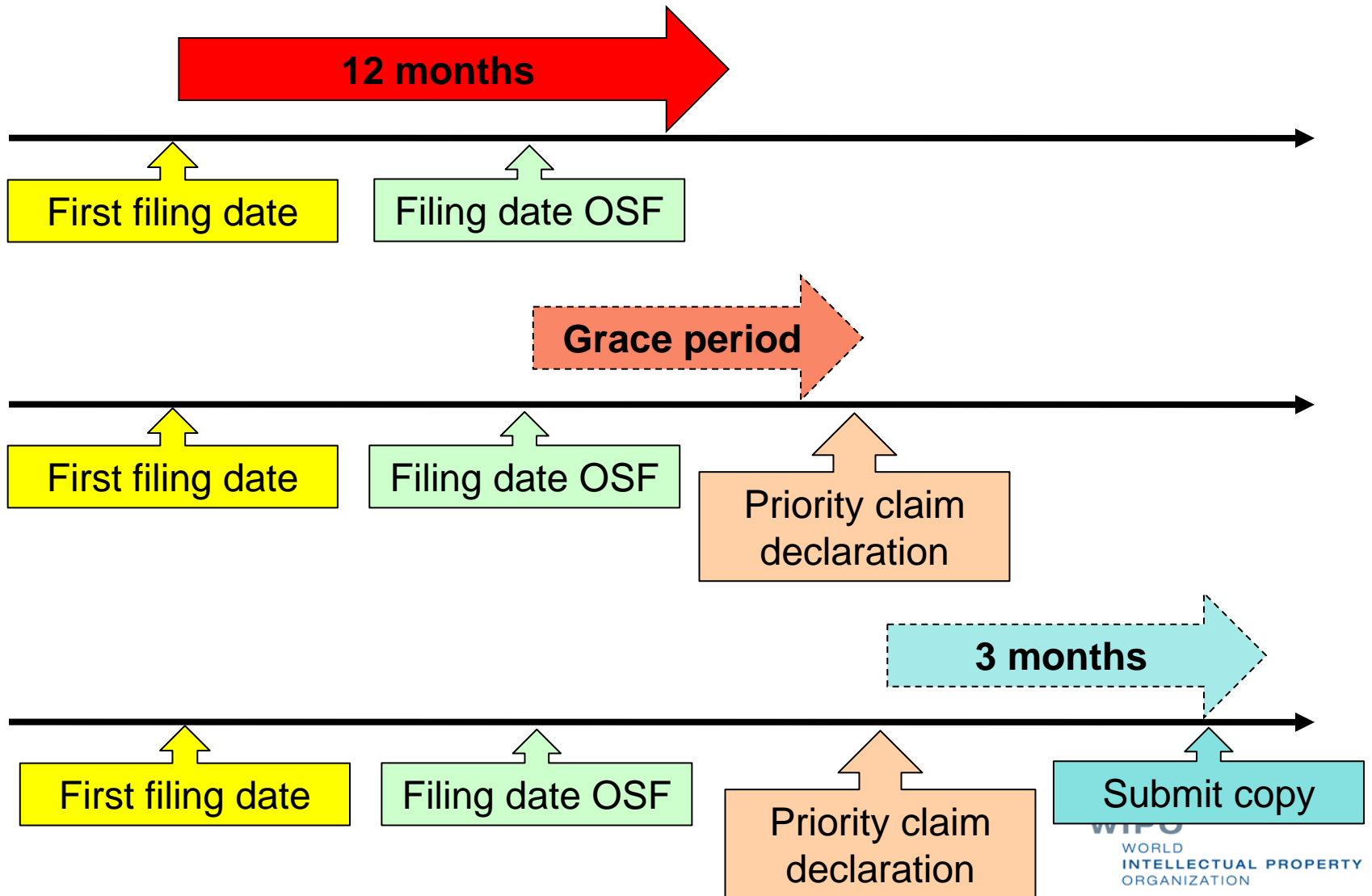
Article 4 D Paris Convention

"(1) Any person desiring to take advantage of the priority of a previous filing shall be required to make a **declaration** indicating the date of such filing and the country in which it was made. **Each country shall determine the latest date on which such declaration must be made.**"

Conditions for claiming priority rights

- Certified copy of first filing (+ translation) [PC Art. 4 (3)]
 - To be submitted within 3 months after filing date
 - For comparing the disclosures of the priority application(s) and the application claiming the priority(ies)
 - Some priority applications are never published, e.g. withdrawn before they are published
- Applicant names:
 - the right to the priority belongs to the applicant (or his successor in title), the names may change therefore
- Inventor names are usually at least partially the same because the right to the invention belongs to the inventor
- Additions or removal of subject matter are permitted

Overview of Timelines



PCT: Restauration of priority rights

Paris Convention:

- Application to be filed within 12 months after **first** filing [PC Art. 4 C (1)]

PCT:

- For international applications filed within 12+2 months after the first filing, restauration of the priority rights can be requested, if
 - The delay was not intentional, and/or
 - The delay occurred despite due care
- Receiving Offices may grant or reject restauration and require evidence for the reasons of delay
- National Offices, in the national phase, are not bound by the restauration

Conditions for applying priorities

■ Why certified copy? What if additions of subject matter?

- Some priority applications are never published, e.g. withdrawn before they are published
- Needed for comparison of disclosure of priority application and of application claiming the priority
- May be needed to confirm that claimed priority is indeed the first filing
 - There are further **conditions for acknowledging validity of priority date for examination**, i.e. whether priority date determines relevant prior art:
 - All technical features of a claimed subject matter need to be disclosed in priority document; and for the first time.

Article 4 F Paris Convention

"No country of the Union may refuse a priority or a patent application on the ground

that the applicant claims **multiple priorities**, even if they originate in **different countries**, or on the ground

that an application claiming one or more priorities contains **one or more elements that were not included** in the application or applications whose priority is claimed, provided that, in both cases, there is **unity of invention within the meaning of the law of the country**.

With respect to the **elements not included in the application or applications whose priority** is claimed, the filing of the subsequent application shall give rise to a right of priority under ordinary conditions."

■ For additions disclosed solely in the later application the priority of the later application can be claimed in further applications

Article 4 C Paris Convention

- "(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."



Checking validity of priorities

Claiming priority

Applicant

Recording priority if conditions are met

Formality examiner

Validating priority per claim

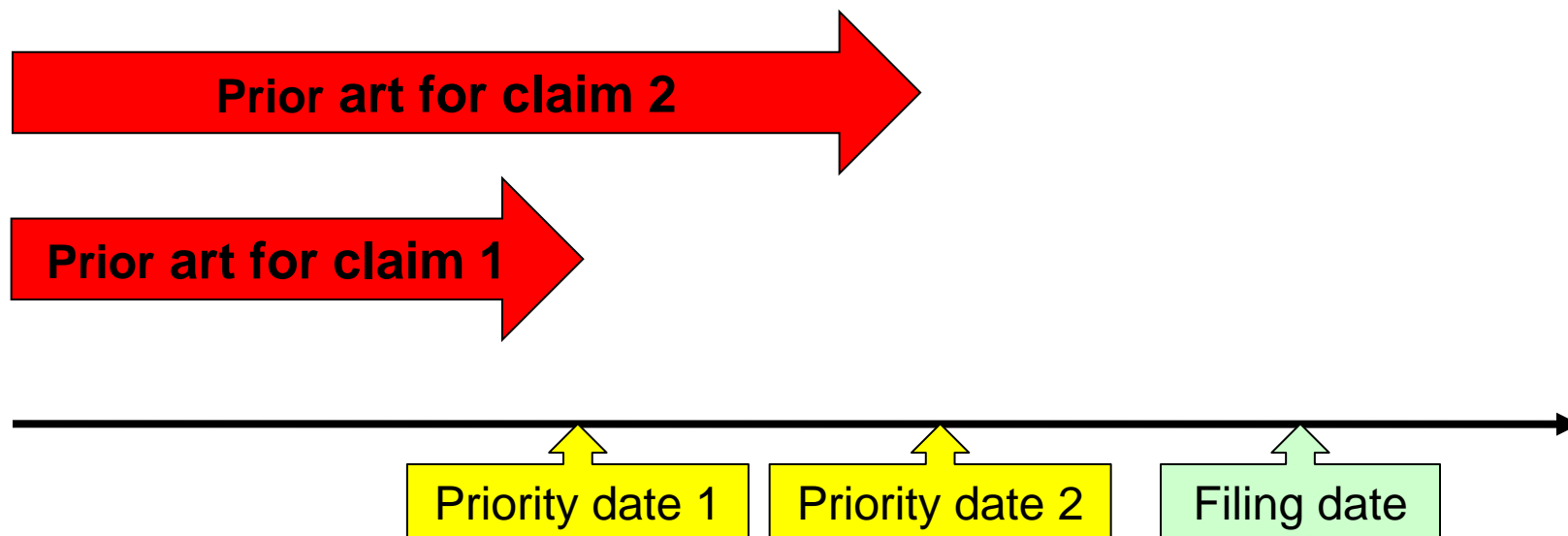
Examiner

Applying validly claimed priority(ies) per claim

Examiner

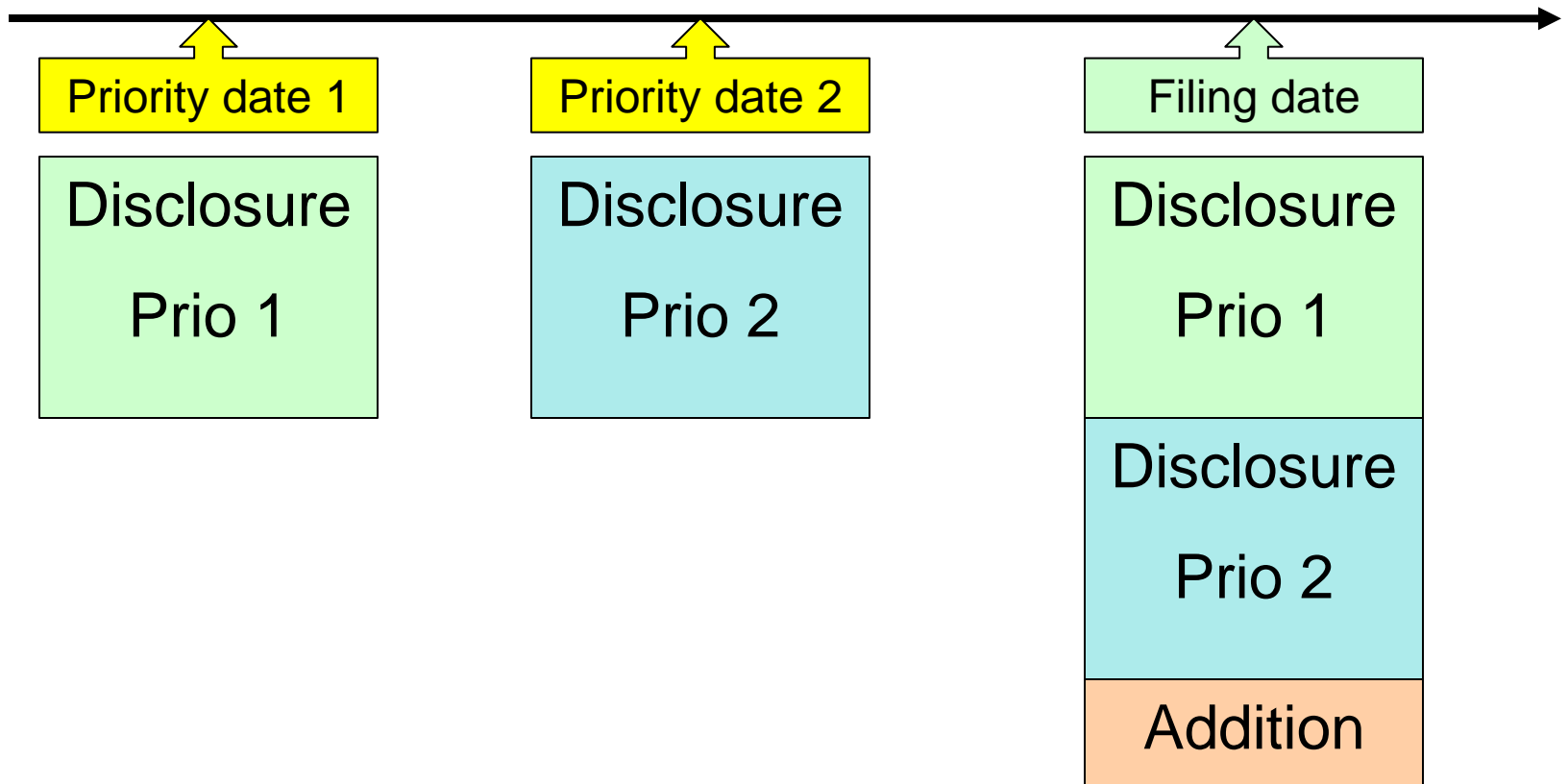
Difficulties with multiple priorities

- **For each claim** check which of the claimed subject matter is disclosed in which priority; and if disclosed for the first time
- If claimed matter derives from different priority documents, different respective priority dates apply for determination of prior art



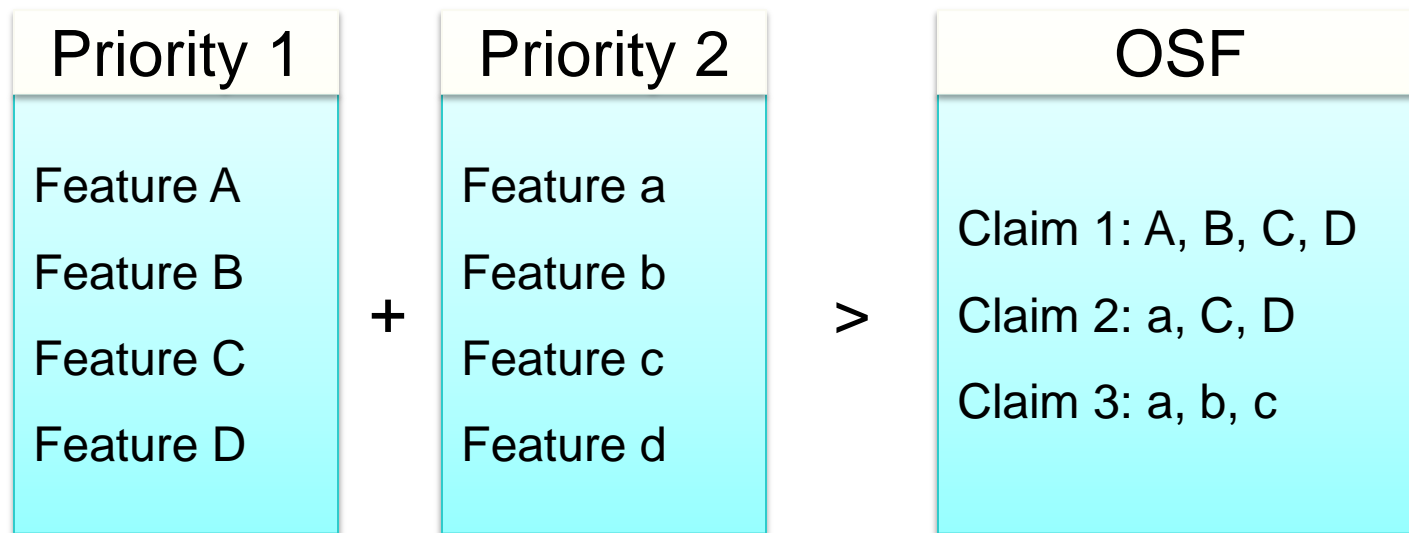
Multiple priorities

- Application claiming two different priorities



Difficulties with multiple priorities

- Combining different priority documents implies combination of different technical features



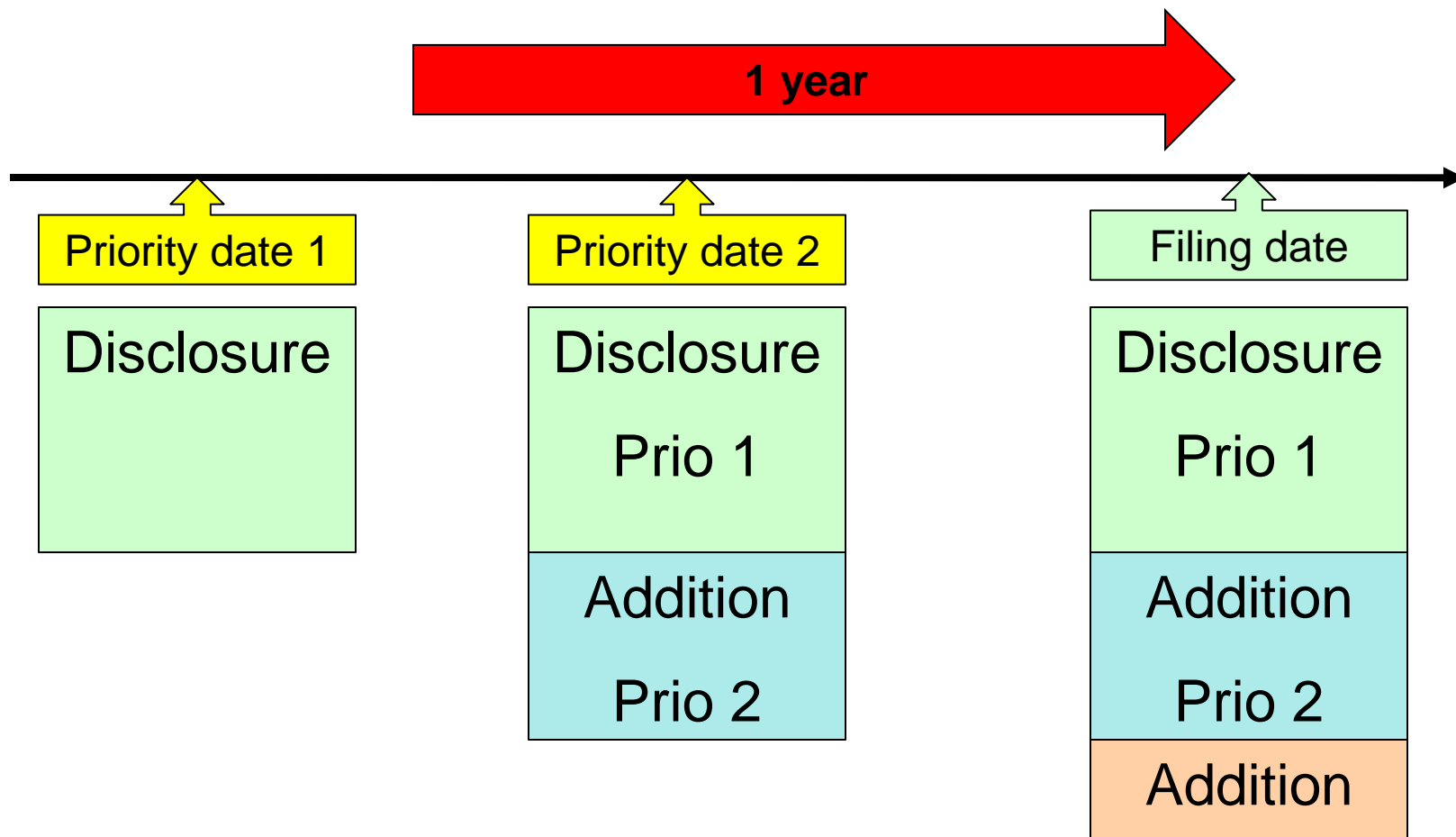
Rule of thumb

- If the claimed subject matter is **fully disclosed in the priority document**, then the priority date determines the relevant prior art,
 - provided the claimed priority document is indeed the first filing of the claimed subject matter.
- > If the claimed subject matter is **not fully** disclosed in the priority document, the priority date cannot be applied, that is: the filing date (or another priority date) determines the relevant prior art
- > If the priority document itself claims a priority, it is to be checked if the claimed subject matter was indeed disclosed in the priority document for the first time (taking into account Art 4C(4)).
- This rule is applied claim by claim

Checking if claimed priority is first filing

- If the claimed priority itself claims a priority:
 - Priority is valid
 - if the still earlier priority was never published, **and**
 - is withdrawn, abandoned, refused, and no rights are alive anymore, **and**
 - has not yet served as a basis for claiming a right of priority
 - Else, priority is valid for additions of art in priority document, i.e. only for features not yet disclosed in the priority of the priority (Paris Convention Art. 4 F)
- EPO does not acknowledge US continuations and continuations in part (except for additions) as first filings (EPC Examination Guidelines F VI 1.4)

Priorities and additions of subject matter

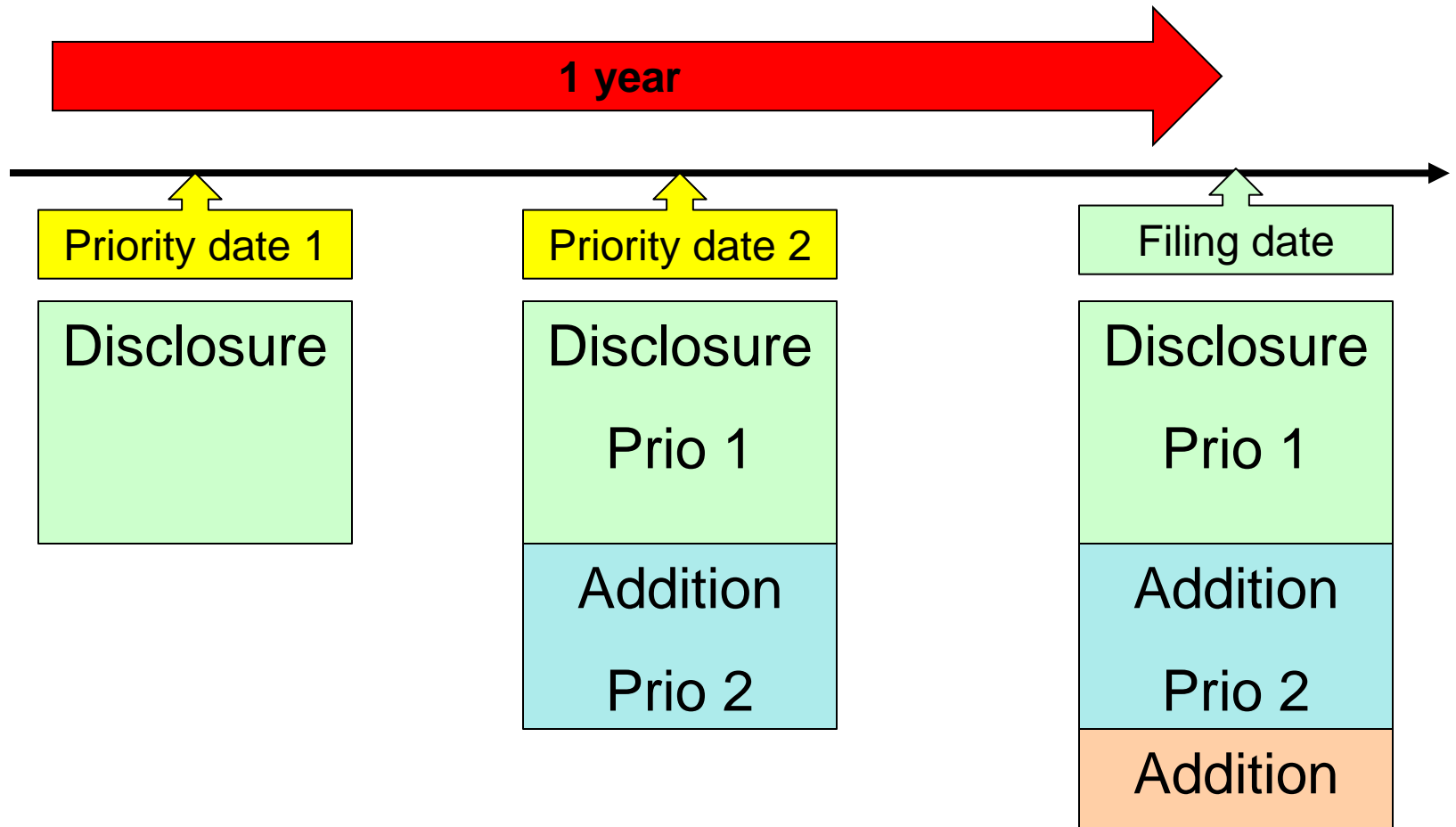


Exercise

What are the relevant dates for the determination of prior art if

- the application claims priority 1 and 2, or
- the application claims priority 2 which claims priority 1

Priorities and additions of subject matter



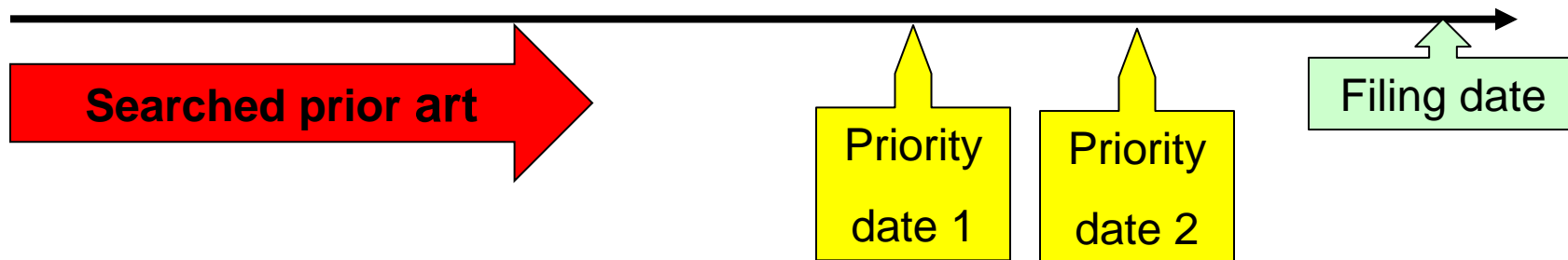
Exercise

What are the relevant dates for the determination of prior art if

- (i) the application claims priority 1 and 2, or
- (ii) the application claims only priority 2 which claims priority 1
- (iii) the application claims priority 1 and 2 and priority 2 itself claims priority 1

Prior art and priorities

- When all relevant prior art documents are before the earliest priority date one need not worry about priorities even if there are several



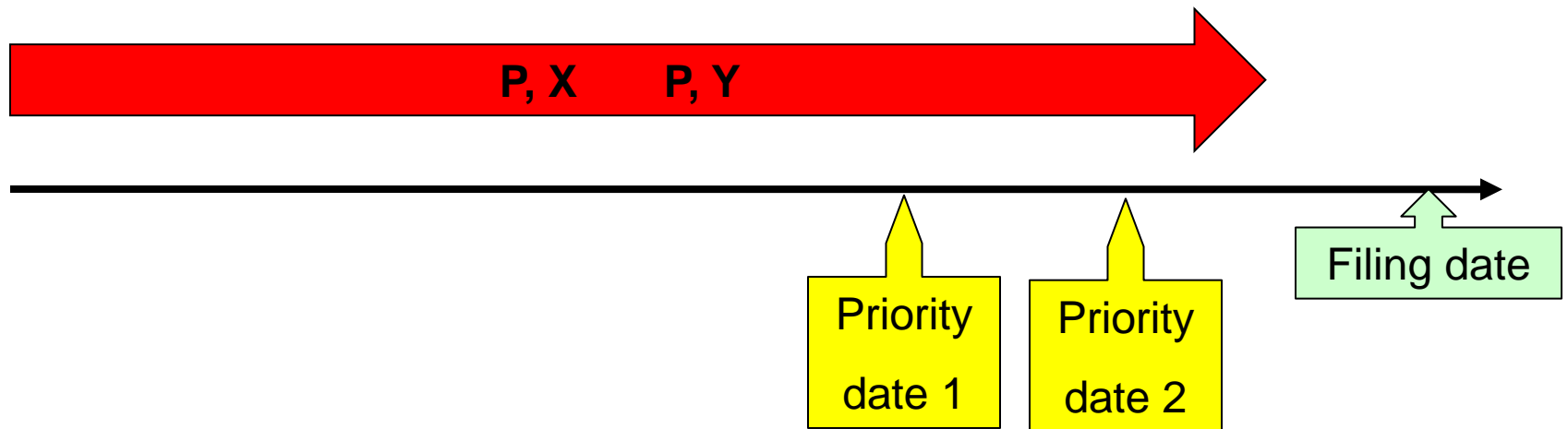
[PCT SE Guidelines 6.06 (i)]

Categories of citations

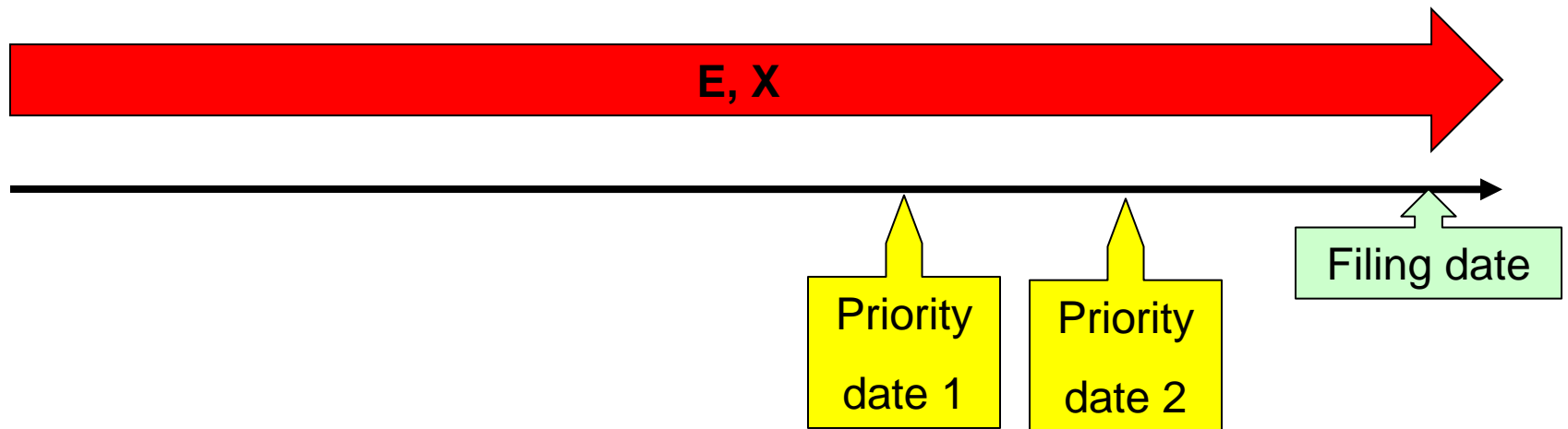
- X particularly relevant if taken alone (novelty)
- Y particularly relevant if combined with another document of the same category (inventive step)
- A technological background
- O non written disclosure
- P intermediate document, i.e. published between the earliest priority date and the filing date
- T theory or principle underlying the invention
- E earlier document but published on or after the filing date
- D document cited in the application

See 16.59ff of the PCT Examination Guidelines

Category P prior art



Category E prior art



Citations of type X, E

Relevance depending on national legislation, e.g.:

EPC Art 54 (Novelty)

(1) An invention shall be considered to be new if it does not form part of the state of the art.

(2) The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.

(3) Additionally, the content of **European patent applications** as filed, the dates of filing of which are prior to the date referred to in paragraph 2 and which were **published on or after that date**, shall be considered as comprised in the state of the art.

Citations of type X, E

PCT Regulations Rule 33.1

- (c) Any published application or any patent whose **publication date** is the **same as, or later than**, but whose **filing date**, or, where applicable, claimed **priority date**, is **earlier than the international filing date** of the international application searched, and which would constitute relevant prior art for the purposes of [Article 15\(2\)](#) had it been published prior to the international filing date, **shall be specially mentioned** in the international search report.

Thank you

lutz.mailander@wipo.int