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## ASSEMBLIES OF THE MEMBER STATES OF WIPO

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CERTIFICATION OF PRIORITY DOCUMENTS:  
AGREED APPLICATION OF ARTICLE 4D(3) OF THE PARIS CONVENTION  
FOR THE PROTECTION OF INDUSTRIAL PROPERTY

*Document prepared by the International Bureau*

#### INTRODUCTION

1. The rapid development of information technologies in recent years has resulted in radical changes in procedures for the filing and processing of patent applications and related documents. In particular, applicants now file and Offices process patent applications and other communications not only on paper, but increasingly in electronic form. The international legal framework for handling patent applications needs continuous adjustment to accommodate these developments. For example, Rule 89*bis* of the Regulations under the Patent Cooperation Treaty (PCT) and Part 7 of the PCT Administrative Instructions provide for the filing and processing of international applications and related documents and communications in electronic form and by electronic means.

2. One matter on which greater clarity under international arrangements would be desirable concerns the certification of priority documents where, under the PCT, priority documents are issued by the receiving Office and transmitted in electronic form to the International Bureau in accordance with PCT Rules 17 and 89*bis*.3. This document proposes that it would be useful to clarify, by way of a common understanding among Member States, that neither the Paris Convention for the Protection of Industrial Property (Paris Convention) nor the PCT prevent an Office from determining alternative forms of certification which appropriately correspond to the electronic environment. Subsequent to the adoption of such a common understanding, certain operational issues relating to the processing and certification

in electronic form of priority documents, consequential on such clarification, would need to be addressed.

3. The understanding would not only promote certainty in the application of legal obligations, but also ensure that the methods employed by Offices for certifying priority documents remain consistent with, and reap the full benefits of, systems for electronic filing and processing of patent applications. These benefits include the simple, timely and reliable exchange of priority documents in conjunction with a streamlining of the certification process for Offices. Such streamlined processes are advantageous, in particular since the handling under the PCT of growing volumes of paper is becoming more and more difficult for many Offices and the International Bureau to manage.

#### PARIS CONVENTION

4. Article 4 of the Paris Convention (reproduced in Annex I) provides for the right of priority. Article 4D(1) provides for any person claiming the priority of a previous application to make a declaration indicating the date of such filing and the country in which it was made. Article 4D(3) provides that the countries of the Paris Union may require any person claiming such priority to produce a copy of the application previously filed (the priority document), certified as correct by the authority which received such application.

5. The objective of certification is, of course, to ensure identity between the copy and the original application on which the priority claim is based. It is within the competence of the authority issuing the priority document to determine how it will effect certification. Different countries and their Offices have different practices in this regard. For example, an Office may decide to effect certification by a certificate in paper form or to certify in electronic form or by other electronic means. Article 4D(3) further provides that countries of the Paris Union may require that the priority document be accompanied by a certificate from the same authority showing the date of filing, and by a translation. However, the provision expressly states that no authentication of the priority document shall be required. Article 4D(4) provides that no other formalities may be required for the declaration of priority at the time of filing the application claiming priority.

6. The proposed understanding would clarify the principle, which is exactly the same principle that governs the issue of Paris Convention certification today in the paper context, that the competent authority issuing the priority document decides for itself what the Paris Convention certification will consist of.

#### PATENT COOPERATION TREATY (PCT)

7. Article 8(1) of the PCT provides that an international application may contain a declaration claiming the priority of one or more earlier applications filed in or for any country party to the Paris Convention. Article 8(2)(a) further states that the conditions for, and the effect of, any priority claim shall be as provided in Article 4 of the Stockholm Act of the Paris Convention. Further details are prescribed in PCT Rule 17 which provides that, subject to the exceptions provided in that Rule, a copy of the previous application, certified by the authority with which it was filed, has to be filed in respect of international applications for which priority is claimed (PCT Article 8 and Rule 17 are reproduced in Annex II).

8. In order to avoid potential uncertainty arising from the use of different means of certification of priority documents under the PCT, it is suggested that it would be useful to agree on an express understanding emphasizing that, in light of the increasing use of and reliance upon electronic exchange of documents, the receiving Office which issues the priority document decides for itself what the Paris Convention certification will consist of, including where the priority document is transmitted to the International Bureau in electronic form. The effect of such an understanding would be that, where a priority document so certified has been transmitted in electronic form to the International Bureau under PCT Rules 17 and 89*bis*.3, no designated or elected Office under the PCT would be able to require any further certification for the purposes of the national or regional phase. It should also be noted that this principle is exactly the same principle which governs the issue of Paris Convention certification today in the paper context. Where a designated or elected Office would prefer to continue to receive copies of certified priority documents in paper form, the International Bureau of WIPO would continue, on request by such an Office, to furnish copies in paper form of priority documents received by it.

#### PROPOSED AGREED UNDERSTANDING ON THE PROVISION OF PRIORITY DOCUMENTS UNDER THE PARIS CONVENTION AND THE PCT

9. In order to enhance certainty with respect to the growing use of electronic means for the provision, storage and dissemination of priority documents, it is proposed that the Assemblies of the Paris Union and the PCT Union agree upon the following explicit understanding:

“The Assemblies of the Paris Union and the PCT Union agree that the following principles shall apply to the application of Article 4D(3) of the Paris Convention, Article 8 of the PCT and Rule 17 of the PCT Regulations:

- (i) it is for the competent authority furnishing the priority document to determine what constitutes certification of a priority document and the date of filing, and how it will certify such a document;
- (ii) each Office will accept a single certification that applies to more than one priority document (“collective certification”), provided that such certification permits identification of all priority documents to which it relates;
- (iii) a non-exhaustive list of examples of forms of certification of priority documents agreed to be acceptable consists of the following:
  - certification in paper form;
  - certification in electronic character coded form;
  - an electronic image of a certification on paper;
  - the collective certification of multiple priority documents transmitted by an Office to another Office or to the International Bureau;
  - the collective certification of multiple priority documents contained in an Office database providing access to such documents to those entitled;

(iv) for the purpose of Article 8 and Rule 17 of the PCT, once a priority document has been issued and certified in accordance with the foregoing principles by the receiving Office, and transmitted to the International Bureau in electronic form, no designated or elected Office may require any different form of certification or any re-certification of that priority document; however, the International Bureau will continue, on request by any designated or elected Office, to furnish copies in paper form of priority documents held in connection with international applications under the PCT.”

*10. The Assemblies of the Paris Union and the PCT Union are invited to adopt the agreed understanding contained in paragraph 9, above.*

[Annexes follow]

ANNEX I

ARTICE 4 OF THE PARIS CONVENTION

Article 4

[A to I. *Patents, Utility Models, Industrial Designs, Marks, Inventors' Certificates: Right of Priority.* - G. *Patents: Division of the Application*]

A. - (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.

(2) 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.

(3) 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.

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. Rights acquired by third parties before the date of the first application that serves as the basis for the right of priority are reserved in accordance with the domestic legislation of each country of the Union

C. - (1) The periods of priority referred to above shall be twelve months for patents and utility models, and six months for industrial designs and trademarks.

(2) These periods shall start from the date of filing of the first application; the day of filing shall not be included in the period.

(3) If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.

(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.

D. - (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.

(2) These particulars shall be mentioned in the publications issued by the competent authority, and in particular in the patents and the specifications relating thereto.

(3) The countries of the Union may require any person making a declaration of priority to produce a copy of the application (description, drawings, etc.) previously filed. The copy, certified as correct by the authority which received such application, shall not require any authentication, and may in any case be filed, without fee, at any time within three months of the filing of the subsequent application. They may require it to be accompanied by a certificate from the same authority showing the date of filing, and by a translation.

(4) No other formalities may be required for the declaration of priority at the time of filing the application. Each country of the Union shall determine the consequences of failure to comply with the formalities prescribed by this Article, but such consequences shall in no case go beyond the loss of the right of priority.

(5) Subsequently, further proof may be required. Any person who avails himself of the priority of a previous application shall be required to specify the number of that application; this number shall be published as provided for by paragraph (2), above.

E. - (1) Where an industrial design is filed in a country by virtue of a right of priority based on the filing of a utility model, the period of priority shall be the same as that fixed for industrial designs.

(2) Furthermore, it is permissible to file a utility model in a country by virtue of a right of priority based on the filing of a patent application, and vice versa.

F. - 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.

G. - (1) If the examination reveals that an application for a patent contains more than one invention, the applicant may divide the application into a certain number of divisional applications and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any.

(2) The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorized.

H. - 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.

I. - (1) Applications for inventors' certificates filed in a country in which applicants have the right to apply at their own option either for a patent or for an inventor's certificate shall give rise to the right of priority provided for by this Article, under the same conditions and with the same effects as applications for patents.

(2) In a country in which applicants have the right to apply at their own option either for a patent or for an inventor's certificate, an applicant for an inventor's certificate shall, in accordance with the provisions of this Article relating to patent applications, enjoy a right of priority based on an application for a patent, a utility model, or an inventor's certificate.

[Annex II follows]

ANNEX II

PCT Article 8

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.

(2) (a) Subject to the provisions of subparagraph (b), the conditions for, and the effect of, any priority claim declared under paragraph (1) shall be as provided in Article 4 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property.

(b) The international application for which the priority of one or more earlier applications filed in or for a Contracting State is claimed may contain the designation of that State. Where, in the international application, the priority of one or more national applications filed in or for a designated State is claimed, or where the priority of an international application having designated only one State is claimed, the conditions for, and the effect of, the priority claim in that State shall be governed by the national law of that State.



PCT Rule 17

The Priority Document

17.1 *Obligation to Submit Copy of Earlier National or International Application*

(a) Where the priority of an earlier national or international application is claimed under Article 8, a copy of that earlier application, certified by the authority with which it was filed (“the priority document”), shall, unless that priority document has already been filed with the receiving Office together with the international application in which the priority claim is made, and subject to paragraphs (b) and (b-*bis*), be submitted by the applicant to the International Bureau or to the receiving Office not later than 16 months after the priority date, provided that any copy of the said earlier application which is received by the International Bureau after the expiration of that time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the date of international publication of the international application.

(b) Where the priority document is issued by the receiving Office, the applicant may, instead of submitting the priority document, request the receiving Office to prepare and transmit the priority document to the International Bureau. Such request shall be made not later than 16 months after the priority date and may be subjected by the receiving Office to the payment of a fee.

(b-*bis*) Where the priority document is, in accordance with the Administrative Instructions, available to the receiving Office or to the International Bureau from a digital library, the applicant may, as the case may be, instead of submitting the priority document:

- (i) request the receiving Office to obtain the priority document from such digital library and transmit it to the International Bureau; or
- (ii) request the International Bureau to obtain the priority document from such digital library.

Such request shall be made not later than 16 months after the priority date and may be subjected by the receiving Office or the International Bureau to the payment of a fee.

(c) If the requirements of none of the three preceding paragraphs are complied with, any designated Office may, subject to paragraph (d), disregard the priority claim, provided that no designated Office shall disregard the priority claim before giving the applicant an opportunity to furnish the priority document within a time limit which shall be reasonable under the circumstances.

(d) No designated Office shall disregard the priority claim under paragraph (c) if the earlier application referred to in paragraph (a) was filed with it in its capacity as national Office or if the priority document is, in accordance with the Administrative Instructions, available to it from a digital library.

17.2 *Availability of Copies*

(a) Where the applicant has complied with Rule 17.1(a), (b) or (b-*bis*) the International Bureau shall, at the specific request of the designated Office, promptly but not prior to the international publication of the international application, furnish a copy of the priority document to that Office. No such Office shall ask the applicant himself to furnish it with a copy. The applicant shall not be required to furnish a translation to the designated Office before the expiration of the applicable time limit under Article 22. Where the applicant makes an express request to the designated Office under Article 23(2) prior to the international publication of the international application, the International Bureau shall, at the specific request of the designated Office, furnish a copy of the priority document to that Office promptly after receiving it.

(b) The International Bureau shall not make copies of the priority document available to the public prior to the international publication of the international application.

(c) Where the international application has been published under Article 21, the International Bureau shall furnish a copy of the priority document to any person upon request and subject to reimbursement of the cost unless, prior to that publication:

- (i) the international application was withdrawn,
- (ii) the relevant priority claim was withdrawn or considered, under Rule 26*bis*.2(b), not to have been made.

[End of Annex II and of document]