

Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

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SAME DAY PRIORITY CLAIMS

Document prepared by the International Bureau

SUMMARY

1. In the context of discussions on the issue of incorporation by reference of missing parts, the question has arisen whether a priority claim contained in an international application based on an earlier application which has the same filing date as the international application (“same day priority claim”) is a valid priority claim under the Paris Convention and thus the PCT.
2. The present document reproduces the content of a working document which formed the basis of discussions by Member States on this issue back in 1991 and outlines a number of options as to possible ways to address the apparent differences in interpretation of the Paris Convention as to whether same day priority claims are permitted.

BACKGROUND

3. The Working Group, at its sixth and seventh sessions, discussed how to address the apparently different interpretation by receiving Offices and designated/elected Offices of the provisions of Rules 4.18 and 20.5 and 20.6 with regard to the incorporation by reference of missing parts (see documents PCT/WG/6/20 and PCT/WG/7/19). In the context of those discussions, the question arose whether a same day priority claim is a valid priority claim under the Paris Convention and thus the PCT.

4. The responses received in reply to a questionnaire sent by the International Bureau to all Member States on the issue of incorporation by reference of missing parts, which also covered the issue of same day priority claims, showed that there is no consensus among Member States on this issue. While recognizing that the competent WIPO body for taking a decision on the matter would be the Assembly of the Paris Union, the Working Group at its seventh session nevertheless requested the International Bureau to prepare a working document on the issue of same day priority claims for consideration by the Working Group at its next (2015) session. To assist the International Bureau in the preparation of that working document, International Authorities are invited to comment on the issues set out in the present document.

SAME DAY PRIORITY CLAIMS

EARLIER DISCUSSION BY PCT UNION ASSEMBLY

5. The issue of same day priority claims has been previously discussed (albeit inconclusively) by PCT Member States during the eighteenth session of the PCT Union Assembly, held in Geneva in July 1991, based on a document prepared by the International Bureau (document PCT/A/18/XVIII/4). That document set out the following considerations:

“1. Under PCT Rule 4.10(d), if the filing date of an earlier application as indicated in the request does not fall within the period of one year preceding the international filing date, the applicant is invited either to cancel the declaration made under PCT Article 8(1) or, if the date of the earlier application was indicated erroneously, to correct the date so indicated. If the applicant fails to act accordingly within one month from the date of the invitation, the declaration made under PCT Article 8(1) is cancelled *ex officio*.

“2. The question has recently arisen as to whether an invitation under PCT Rule 4.10(d) must be issued if the relevant declaration under PCT Article 8(1) relates to another application whose filing date is the same as the international filing date.

“3. Under PCT Article 8(1), the priority may be claimed of “one or more earlier applications filed in or for any country party to the Paris Convention for the Protection of Industrial Property”. PCT Article 8(2)(a) makes it clear that, in general, “the conditions for, and the effect of, any priority claim declared under [PCT Article 8(1)] shall be as provided for in Article 4 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property”. That Article of the Paris Convention refers to “any subsequent filing” (Article 4B), “subsequent application” (Articles 4C(4), 4D(3) and 4F) and “previous application” (Article 4C(4)) as well as “previous filing” (Article 4D(1) and (5)). Furthermore, it is clear from Article 4A(1) of the Paris Convention that the right of priority is enjoyed only during the period fixed in that Convention, the relevant period being twelve months as fixed in Article 4C(1). It should be noted, however, that Article 4C(2) of the Paris Convention expressly provides that the period “shall start from the date of filing of the [priority] application” but that “the day of filing shall not be included in the period”. The Paris Convention contains no express reference to the possibility of claiming priority of an application filed earlier on the same day as the application claiming priority.

“4. The provisions of the PCT and the Paris Convention referred to in the preceding paragraph appear to allow different interpretations. On one view, they could be interpreted as indicating that a “same day” filing does not fall under the scope of the priority provisions of the Paris Convention (and hence of the PCT). This view would regard the word “previous” as indicating that the application used as the basis for priority needs to have been filed on a previous day rather than at a previous time, and might be supported by Article 4C(2) of the Paris Convention according to which the day of filing (of the priority application) is not to be included in the priority period. Such a view would reflect the repeated references in the Paris Convention to the “date” of filing rather than the “time” of filing. It would also avoid difficulties which might arise in ascertaining which was the earlier of two applications filed in different geographical time zones.

“5. Moreover, while Article 4 of the Paris Convention makes a number of references to applications or filings using the words “previous” and “subsequent,” unqualified by a restriction referring to a previous or subsequent date, certain provisions in Article 4 of the Paris Convention seem to operate on the assumption that it is the date and not the precise time of filing which is important. For example, the second sentence of Article 4B of the Paris Convention only reserves the rights of third parties if they were acquired before the date (not the time) of the first application. In addition, if a claim for priority of an application filed on the same day were admitted, it is not clear what practical benefit could arise from such a situation, since prior art is generally citable against an application only if it became available earlier than the date of filing the application in respect of which patentability is being determined (cf. the relevant words of PCT Rule 33.1(a): “provided that the making available occurred prior to the international filing date”; the same approach has been adopted in Article 11(2)(b) of the draft Patent Law Treaty, see document PLT/DC/3, page 21).

“6. On another view, the words “earlier” and “previous” should be accorded their ordinary meanings so as to apply to any application filed at an earlier time. Under this interpretation, Article 4C(2) of the Paris Convention should be read as excluding the day of filing (of the priority application) from the priority period only for the purposes of computing the end, and not the beginning, of the period during which the priority right is to be enjoyed by the applicant.

“7. It is noted that, under PCT Article 27(5), “nothing in this Treaty and the Regulations is intended to be construed as prescribing anything that would limit the freedom of each Contracting State to prescribe such substantive conditions of patentability as it desires. In particular, any provision in this Treaty and the Regulations concerning the definition of prior art is exclusively for the purposes of the international procedure and, consequently, any Contracting State is free to apply, when determining the patentability of an invention claimed in an international application, the criteria of its national law in respect of prior art and other conditions of patentability not constituting requirements as to the form and contents of applications.”

“8. It seems that the provisions of PCT Article 27(5) can be interpreted as permitting national law to take into account, for the purposes of ascertaining the prior art, an application filed earlier on the same day as the application in respect of which patentability is being determined. If any Contracting State adopts such an interpretation in practice, the disallowance during the international phase of a claim of priority based on an application filed earlier the same day, would entail the rejection of the later application in that Contracting State if that Contracting State does not have a rule against self-collision and if neither application is withdrawn before publication. On the other hand, the International Bureau is not aware of any PCT Contracting State having adopted the above-mentioned interpretation. Nor is it aware of any provision of any national law which would afford any particular advantage to the applicant in a case where priority is claimed from a “same day” filing.

“9. In considering the questions raised in the specific context of PCT Rule 4.10(d), it must be borne in mind that a priority claim made in an international application serves two purposes. First, it has effect in the national phase as a priority claim under national law. Second, it serves as the basis of the computation of a wide variety of time limits under the PCT procedure. For neither of these purposes does any substantive assessment need to be made in the international phase of the validity of the priority claim, a matter which is ultimately for the national law, giving proper effect to the Paris Convention. On the other hand, to be permitted to stand as a priority claim under the PCT, there should be no evident conflict with the Paris Convention and there should also be as little uncertainty as possible.

“10. Should the Assembly agree with the second view outlined in paragraph 6 [of document PCT/A/18/XVIII/4], above, or should it at least not exclude it, it may be desirable to amend PCT Rule 4.10 so as to leave it open during the international phase whether, in case priority is claimed, the filing date of the earlier application may be the same as the international filing date. As a consequence, it would be up to the national law of each designated State to give an answer to that question.

“11. A new paragraph (d-*bis*) could be added to PCT Rule 4.10 with the following wording:

“(d-*bis*) For the purposes of paragraph (d), the filing date of the earlier application shall be considered by the receiving Office and the International Bureau as falling within the period of one year preceding the international filing date even where the filing date of the earlier application is the same date as the international filing date.”

6. Unfortunately, the PCT Union Assembly at its eighteenth session in July 1991 did not decide on the issue. The report of the session (document PCT/A/XVIII/9, paragraph 19) states the following:

“19. Rule 4.10(d-*bis*). The Assembly decided not to adopt Rule 4.10(d-*bis*), as set out in document PCT/A/XVIII/4, since it could not be fully discussed in the present session of the Assembly due to lack of time, and noted that most delegations preferred to retain the present practice followed under Rule 4.10(d). The International Bureau informed the Assembly that the question of a priority claim based on an earlier application filed on the same day as the international application might be taken up at another time.”

TODAY'S SITUATION

7. In the view of the International Bureau, in general, the same considerations as those set out in document PCT/A/VIII/4, reproduced in paragraph 5, above, should guide the discussions on the issue today.

8. However, compared to the situation back in 1991, it would appear that certain assumptions which formed the basis for the considerations set out in paragraph 5 and 8 of document PCT/A/VIII/4 have changed. Notably, as the discussions on the issue of incorporation by reference of missing parts have revealed, today, a number of Offices of PCT Contracting States, in their capacity as both receiving Offices and designated Offices, have adopted the interpretation that same day priority claims are to be permitted under the Paris Convention and thus the PCT.

9. Moreover, today, PCT applicants relying on such an interpretation by a receiving Office do gain a “practical benefit” from such interpretation, as it allows them to incorporate by reference a missing element or part contained in such an “earlier” application filed on the same day as the international application (noting that the inclusion in the international application of a priority claim to such an earlier application is a requirement for validly requesting incorporation by reference of missing elements or parts).

10. On the other hand, the responses by Member States received in reply to the questionnaire clearly revealed that the interpretation of the Paris Convention that same day priority claims are to be permitted under the Paris Convention (and thus the PCT) is not shared by all Offices. Thus, today, applicants depend on the interpretation by the receiving Office with which the application is filed and by designated Offices and their applicable national laws as to the “fate” of any same day priority claim contained in the international application. The results can be summarized as follows:

	Position of Receiving Office	
	Allows Same Day Priority Claim	Does Not Allow Same Day Priority Claim
Effect in international phase <i>priority claim</i> <i>incorporation by reference</i> <i>international search</i>	Remains on file. Permitted (unless RO has notified under Rule 20.8(a)). Takes into account any incorporation by reference.	Declared void. Not possible. Takes place on the basis of the international application as actually filed.
Risks for applicants in national phase <i>priority claim</i> <i>incorporation by reference</i>	May be declared invalid in some designated Offices (causing administrative work for Office and applicant of no practical value), but has no substantive effect in the absence of incorporation by reference. May be found invalid, even in Offices normally allowing incorporation – either effective filing date would change or material incorporated by reference would be ignored.	Options for restoration of priority claim need to be followed up in each designated Office (no substantive effect – only necessary if incorporation by reference required to fix errors). Would need to be considered separately in each designated Office permitting both restoration of the same day priority claim and incorporation by reference.

11. If the position of the receiving Office is to interpret the Paris Convention in such a way that same day priority claims are to be allowed, any such same day priority claim will remain in the international application and may serve as the basis for requesting the receiving Office to incorporate by reference any missing element or part contained in the “earlier” (same day) application the priority of which is claimed. However, such an interpretation of the Paris Convention is not binding on designated Offices for the purposes of national phase procedures. Applicants thus face the considerable risk that such a same day priority claim will not be recognized by many designated Offices in the national phase.

12. In turn, this could lead those designated Offices to determine that the requirements for incorporation by reference of any missing element or part contained in the “earlier” (same day) application have not been complied with, since the priority had been invalidly claimed in the international application. Consequently, such Offices will, in accordance with Rule 82~~ter~~.1(b), treat such an international application as if the international filing date had been accorded under Rule 20.3(b)(i) or 20.5(b), or corrected under Rule 20.5(c), as applicable. The international filing date accorded to the application at such Offices will therefore be the date on which the receiving Office had received the missing element or part, potentially affecting the patentability of the invention claimed in the international application.

13. If, on the other hand, the position of the receiving Office is to interpret the Paris Convention that same day priority claims are *not* to be allowed, any such same day priority claim will be considered not to have been made (“considered void”) by the receiving Office in accordance with Rule 26*bis*.2. This in turn causes considerable problems for applicants in respect of the national phase procedures before designated Offices which do *not* share that interpretation, that is, before designated Offices which do allow same day priority claims. In order to use an “earlier” (same day) application as a basis for incorporation by reference of missing elements or parts, applicants first have to pursue restoration of the same day priority claim which had been considered void by the receiving Office under the applicable national law of each designated Office concerned. Only after restoration of the priority claim could the applicant then pursue the issue of incorporation by reference of any missing element or part contained in that “earlier” (same day) application, if possible, under the applicable national law of each designated Office concerned.

14. The number of same day priority claims made is relatively small (just over 200 in 2013), the largest numbers coming (in decreasing order) from the receiving Offices of the Republic of Korea, the United States of America and China. Of these, it appears that, in 2013, only two cases have been the subject of confirmations of incorporation by reference (and a number of others from other years). Consequently, it can be seen that the scale of the issue is small and should not put a major burden on receiving Offices or designated Offices, whatever the outcome of the present discussions on the validity of same day priority claims. Nevertheless, the instrument of “incorporation by reference” is genuinely used and important to a few applicants.

OPTIONS

15. The following paragraphs look into the four main possible options which appear to exist as to how to address the apparent differences in interpretation of the Paris Convention by Offices of PCT Member States as to whether same day priority claims are permitted.

Option 1: Refer the Matter to the Paris Union Assembly

16. The first possible option for PCT Member States as to how to address the issue of same day priority claims would be for the PCT Union Assembly to refer the matter to the Paris Union Assembly with a view to seeking a common interpretation of Article 4 of the Paris Convention by all Paris Union Member States. It has to be noted, though, that the widely divergent views expressed by PCT Contracting States in reply to the questionnaire on both the legal question and the underlying policy issues suggest that achieving such an agreement would require further clarifications and discussions.

17. The PCT Union Assembly would have the possibility of making a recommendation to the Paris Union Assembly on this matter when making the referral, but this would not be mandatory.

18. If the matter were to be referred to the Paris Union Assembly, one possibility for the Paris Union Assembly would be to adopt a common Understanding as to how to interpret the Paris Convention with regard to same day priority claims. However, while such an agreement on how to interpret the Paris Convention among Paris Union Member States, if achieved, may be recognized as an instrument to develop interpretation of international law, it would appear that any such Understanding would not have the same binding “Treaty” nature for any Member State as a formally revised Act of the Paris Convention ratified or acceded to by that State (namely, the obligation to adopt, in accordance with their applicable constitutions, the measures necessary to ensure the application of Article 4 as so amended).

19. The alternative to adopting a common Understanding would be for the Paris Union to formally amend Article 4 of the Paris Convention. For any such formal amendment of the Paris Convention, a Revision Conference would have to be convened, and a unanimous vote of all of all States participating in a Revision Conference would be required¹. Furthermore, noting that the issue of how to interpret Article 4 of the Paris Convention, in particular its provisions regarding the “priority period” set out in Article 4(C), also concerns industrial designs and trademarks, pursuant to Article 13(2)(b) of the Paris Convention², any decision of the Paris Union Assembly could only be taken after having taken the advice of the Coordination Committee, as the issue would clearly also be “of interest” to the Hague Union and the Madrid Union, respectively.

20. Any revised Act of the Convention so agreed would have to be ratified or acceded to by a number of States already members to an earlier Act of the Paris Convention—the exact number to be determined by the Revision Conference—before it would enter into force. Once such revised Act of the Paris Convention would have entered into force, it would no doubt take years, if not decades, for a majority of States currently members of the Stockholm Act of the Paris Convention to ratify or accede to that revised Act (to take the Stockholm Act as an example: today, more than 40 years after entry into force of the Stockholm Act, 10 out of 176 States have still not fully ratified that Act or acceded to it and thus remain fully or partly bound by earlier Acts of the Paris Convention). Of course, for those States which would not ratify or accede to the revised Act, any earlier Acts of the Paris Convention which a State had ratified or to which a State had acceded to would remain valid.

21. Clearly, thus, a formal revision of the Paris Convention would be a cumbersome and lengthy procedure and might be considered disproportionate to the size of the problem.

Option 2: Have the PCT Union Assembly Decide on the Matter

22. A second possible option might be to seek an agreement among PCT Member States on how to interpret the Paris Convention with regard to same day priority claims, with effect for international applications. In this context, several questions arise.

Competency of PCT Assembly

23. The first question is whether the PCT Union Assembly would be competent to deal with this matter. The answer to that question appears to be largely a matter of interpretation. On the one hand, PCT Article 53(2)(a)(ii), according to which the PCT Assembly “shall deal with all matters concerning ... the implementation of this Treaty”, could be interpreted as providing the basis for any decision by the PCT Assembly on this matter, given that the PCT Treaty and the Regulations contain certain provisions dealing with priority matters.

¹ While Article 18 of the Paris Convention is silent on the question as to the majority required to amend any of the Articles of the Paris Convention other than Articles 13 to 17 (with regard to those Article, see Article 17 of the Paris Convention), Bodenhausen, in his “Guide to the Application of the Paris Convention for the Protection of Industrial Property” (WIPO Publication No. 611), speaks of the “established rule considered by the various Revision Conferences that a unanimous vote of all States participating in such Conferences ... was necessary for revision of all of the provisions of the Convention (under the Stockholm text, with the exception of Articles 13 to 17: see Article 17). This established rule must be considered binding on the Union until changed by a contrary provision adopted under the same rule.”

² Article 13(2)(b) of the Paris Convention: “With respect to matters which are of interest also to other Unions administered by the Organization, the Assembly shall make its decisions after having heard the advice of the Coordination Committee of the Organization.”

24. On the other hand, with regard to the main issues concerning the right of priority, namely, the conditions for and the effect of any priority claim contained in an international application, PCT Article 8(2)(a) simply refers to Article 4 of the Paris Convention. It could thus be argued that the issue at hand does not concern the implementation of the PCT but only the implementation of the Paris Convention, and that it should thus only be dealt with by the Paris Union Assembly (see Article 13(2)(a)(i) of the Paris Convention). That argument appears to be further supported by the fact that the requirement for all PCT Member States to respect and apply the provisions of the Paris Convention does not appear to be based on the fact that they are Member States of the PCT but on the fact that they are (and must be, see PCT Article 62(1)) Member States of the Paris Union.

25. As referred to in paragraph 19, above, as the issue of how to interpret Article 4 of the Paris Convention, notably its provisions regarding the “priority period” set out in Article 4(C), also concerns industrial designs and trademarks and is therefore of interest to the Hague Union and the Madrid Union, respectively, pursuant to PCT Article 53(2)(b) (the text of which is identical to Article 13(2)(b) of the Paris Convention), any decision of the PCT Assembly could only be taken after having taken the advice of the Coordination Committee.

Scope of PCT Assembly Decision

26. The second question which arises in this context—if the PCT Union Assembly were to be seen as competent to address the question as to how to interpret Article 4 of the Paris Convention with regard to same day priority claims in the context of the PCT—is whether the PCT Union Assembly could address that issue with effect for both the international phase and the national phase of the PCT procedure (that is, with effect not only for receiving Offices but also designated/elected Offices before which an international application has entered the national phase), or whether it would be limited to address that issue with effect for the international phase only.

27. That question appears to boil down to the question as to whether the provisions in the PCT Treaty and the Regulations dealing with priority issues, in particular the provisions of PCT Article 8(2)(a), are “requirements relating to the form or contents of the international application” (PCT Article 27(1)), or whether they are provisions relating to “substantive conditions of patentability ... concerning the definition of prior art” (PCT Article 27(5)). In the case of the former (“form or contents”), the PCT Union Assembly—if considered competent—could adopt a common interpretation of the Paris Convention with effect for both the international and the national phases of the PCT procedure, in line with PCT Article 27(1). In the case of the latter (“substance”), however, the PCT Union Assembly could adopt such an interpretation only with regard to the international phase of the PCT procedure and would have to leave the matter, as far as the national phase is concerned, to the national law applicable by the designated Offices concerned, noting the clear wording of PCT Article 27(5).

28. Again, the answer to the above question appears to be largely a matter of interpretation. The “Notes” on PCT Article 27(1) (see “Notes on the Patent Cooperation Treaty”, document PCT/PCD/4, dated December 10, 1970, reproduced in the Records of the Washington Diplomatic Conference on the PCT, WIPO Publication 313, 1970) imply that some of the requirements set out in PCT Article 8 are “requirements relating to form and contents”.³ This, does not, however, imply that *all* of the provisions of PCT Article 8 are “requirements relating to form and contents” of an international application.

³ “The requirements relating to form and contents are principally provided for in Articles 3 (The International Application), 4 (The Request), 5 (The Description), 6 (The Claims), 7 (The Drawings), and 8 (Claiming Priority), and the Rules pertaining to these Articles (mainly Rules 3 to 13). The words “form or contents” are used merely to emphasize something that could go without saying, namely, that requirements of substantive patent law (criteria of patentability, etc.) are not meant.”

29. PCT Article 8(1), which relates to the “declaration” of priority and refers to the PCT Regulations with regard to further details, beyond what is provided for in Article 4(D) of the Paris Convention, indeed appears to concern “requirements relating to form and contents”, notably issues such as where to make the declaration (in the request) and the contents of any such declaration (see PCT Rule 4.10).

30. PCT Article 8(2)(a), on the other hand, does not set out any details relating to “form or contents” of an international application but simply refers to Article 4 of the Paris Convention with regard to the “conditions for, and the effect of, any priority claim” contained in the international application. Bodenhausen, in his “Guide to the Application of the Paris Convention for the Protection of Industrial Property” (WIPO Publication No. 611, Chapter II, pages 13 and 14), classifies the provisions relating to the right of priority set out in Article 4 of the Paris Convention as belonging to the “category of provisions of the Convention [which] contains rules of substantive law regarding rights and obligations of private parties” and which “constitute a very important body of common rules regarding the protection of industrial property, rule which, either directly, or indirectly through the intermediary of national legislation, have to be respected and applied by all Member States”. In view of this classification as “rules of substantive law regarding rights and obligations of private parties”, it would appear difficult to categorize all of the provisions of PCT Article 8(2)(a), which simply refer to those “rules”, as being provisions “relating to form or contents” of an international application within the meaning of PCT Article 27(1).

31. PCT Article 8(2)(b), furthermore, expressly refers to the applicable law of a designated State with regard to the conditions for, and the effect of, a priority claim in that State where the international application claims the priority of one or more national applications filed in or for a designated State, or where the priority of an international application having designated only one State is claimed. Again, this would appear to support the argument that not *all* of the provisions of PCT Article 8 can be interpreted as relating to “form and contents” of an international application.

32. It would therefore seem reasonable to argue that the question as to what constitutes a prior art disclosure for the purposes of novelty, for instance, is a substantive condition of patentability, that an earlier disclosure on the same day as the patent filing could amount to prior art (as paragraph 8 of document PCT/A/18/XVIII/4 has argued), and that the provisions dealing with the “periods of priority” set out in Article 4(C) of the Paris Convention, incorporated by reference into the PCT by virtue of PCT Article 8(2)(a), are thus indeed provisions setting out “substantive conditions of patentability ... concerning the definition of prior art” within the meaning of PCT Article 27(5).

33. If so, the PCT Union Assembly could not address that issue of how to interpret Article 4 of the Paris Convention with effect for both the international phase and the national phase of the PCT procedure. Rather, it would be—in accordance with Article 27(5)—within the freedom of each PCT Contracting State to prescribe, when determining the patentability of an invention claimed in an international application, the criteria of its national law as to how to define the term “period of priority” and thus the “fate” of same day priority claims, at least for as long as there was no common interpretation and a corresponding amendment of Article 4 of the Paris Convention agreed upon by the Paris Union Assembly (in which case, of course, all PCT Contracting States would have to respect and apply Article 4 of the Paris Convention as so amended, noting that they are, and must be, Member States of the Paris Union (see PCT Article 62(1)).

34. Another way to look at the question at hand would be to argue that the provisions of PCT Article 8(2)(a) simply don't fit into the categories "form or contents" or "substance" within the meaning of PCT Articles 27(1) and (5), respectively, and that PCT Article 8(2)(a) should simply be seen as what it is, namely, a simple reference to the provisions of the Paris Convention. If one were to follow this line of argument, the most plausible action in the case of doubt on how to give proper effect to a provision of the Paris Convention would appear to be to refer that matter to the Paris Union Assembly as the (only) competent decision-making body.

Desirability of PCT Assembly Decision

35. The third and final question arising in this context is whether it would even be desirable—in the absence of an agreed common interpretation and a corresponding amendment of Article 4 of the Paris Convention by the Paris Union Assembly, and if one were to agree that the PCT Union Assembly would be competent to address the issue of how to interpret the Paris Convention with regard to same day priority claims, and to do so with effect for both the international and the national phase of the PCT procedure—to seek such an agreement by PCT Member States only, that is, by only a "subset" of all Member States of the Paris Union Assembly.

36. Noting the importance of the consideration set out in paragraph 9 of document PCT/A/18/XVIII/4 (reproduced in paragraph 5, above) that "there should be no evident conflict with the Paris Convention and there should also be as little uncertainty as possible", it would appear that having only a subset of all Paris Union Assembly members agree on a common interpretation of the Paris Convention would do little to overcome the uncertainty whether or not there is a conflict with the Paris Convention, for as long as the Paris Union Assembly has not agreed on a common interpretation of the Paris Convention with regard to same day priority claims.

37. Moreover, having only a subset of all Paris Union Assembly members agree on a common interpretation of the Paris Convention, even if with effect for both the international phase and the national phase of the PCT procedure, would do little to reduce the complexity of the international patent system for both applicants and Offices, as it would not address the issue in a comprehensive manner for both national (Paris Convention) and international (PCT) filings, and independently of the capacity (national or international) in which an Office acted. Such a comprehensive solution could only be achieved by an agreed common interpretation of the Paris Convention by the Paris Union Assembly.

Option 3: Amend the PCT Regulations to Prepare Ground for Decision on the Matter by Designated Offices in the National Phase

38. A third possible option—in line with the considerations set out in paragraphs 9 of document PCT/A/18/XVIII/4, reproduced in paragraph 5, above, as to the need for a substantive assessment in the international phase of the validity of a priority claim—would be to at least put an end to the differing practices of receiving Offices with regard to same day priority claims. The PCT Regulations could be amended to expressly require receiving Offices to *not* cancel any same day priority claim, so as to prepare the ground for decisions on the matter to be taken by designated Offices in the national phase of the PCT procedure, under the applicable national laws, similar to what had been proposed and discussed back in 1991. All applicants would thus be on an "equal footing" with regard to the validity of same day priority claims for the purposes of the international phase, no matter what receiving Office had been used to file the international application.

39. Under this option, in the absence of a formal revision of the Paris Convention (see option 1, above), the final decision on whether same day priority claims were to be permitted under the Paris Convention would still be left to the national law of each designated State. This option would thus retain all the complexity referred to in paragraphs 10 to 12, above, for both applicants and Offices, as it would not address the issue of same day priority claims in a

comprehensive manner with effect for both the international and national phase of the PCT procedure; it would, of course, also not address the issue with effect for national (Paris Convention) filings.

40. On the other hand, noting the considerations set out in paragraphs 16 to 21, above, it would appear that this option, despite those shortcomings, could be considered to be the most realistic way to proceed, at least in the short term.

Option 4: Leave Interpretation to Individual Receiving Offices

41. A fourth and final option would be to do nothing and leave the current situation described in paragraphs 10 to 13, above, “as is”, leaving the “fate” of same day priority claims, as far as the international phase is concerned, to the interpretation of the receiving Office with which the international application is filed and, as far as the national phase is concerned, to the differing interpretations by the designated Offices pursuant to applicable national laws. If this approach is taken, it may nevertheless be desirable to modify the PCT Receiving Office Guidelines and Applicant’s Guide to indicate that this is an area where practices vary between receiving Offices.

42. The Meeting is invited to comment on the issues set out in this document.

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