

can make, through it, another application in any country of the Paris union. The later application has the same features of the original one. This will benefit the inventor to study, how and where, he marketing his invention in other countries.

The regulation of priority in patent applications adopted by Paris convention can be followed in Arabic homeland. The suggestion which may be in front of Arab league is to determine that regulation in order to inserting a particular one in the conventions held between Arab countries.

References:

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- 12- WIPO Intellectual Property Handbook: Policy, Law and Use, p. 243-244. Available at: (<http://www.wipo.int/about-ip/en/iprm/pdf/ch5.pdf>).

The expression partial priority in its narrower sense is normally used, in connection with the occurrence of partial priorities, also, where union priority is claimed for only one part of the application, while simple priority of filing exists in the case of the rest.⁽¹⁶⁾

The right of priority in the Convention permits the claiming of “multiple priorities”.¹⁷⁽¹⁴⁾ The later application may not only claim the priority of one application earlier of it, but it may also unite the priority of several earlier applications, each one of which relating to some different elements of the subject matter of later application. In the later application, furthermore, elements for which priority is claimed may be united with those no priority is claimed for it. The later application must, in all previous cases, comply with the requirement of unity of invention.⁽¹⁸⁾

and not basically transformed or modified in its principles”. See: Gehard Schricker, op. cit., p. 678.

16 Gehard Schricker, op. cit., p. 680.

17 “The need to recognize claims to multiple priority in respect of one and the same application arose very early in connection with the Paris convention. As early as 1911, at the Washington conference of revision, the international bureau proposed, with the approval of the United States government, to include an appropriate additional provision in article 4 of the Paris convention”. Gehard Schricker, op. cit., p. 680.

18 International Treaties and Conventions on Intellectual Property, p. 245. Available at: “Noteworthy, that all members of the competent sub-committee had agreed a proposal except Great Britain. The British representative objected that there would be practical difficulties owing to the different claims, and that it would be too complicated to establish whether the claims corresponded to the relevant prior applications. Although several delegates illustrate that certain countries were applied that system without facing any serious difficulties, the British opposition prevented the adoption of the proposed amendment to article 4”. See: Gehard Schricker, op. cit., p. 678.

3- Loss of Priority

Paris Convention construes by Case law in Europe with a stringent degree, which will be harsh on many applicants where necessary transfers of priority right are not carried out in full and before the end of the time, 12 months, available by convention when the later application claiming priority is filed.

Under the Convention, a claim for priority must be made by the same person who had filed the original application which establishing priority. Only the successor in title of the priority applicant can makes the claim to priority at the time he claim the right to priority, i.e. on the date they file the later application, whether the succession was by assignment or by operation of law. The right to priority, then, currently lost if there is no clear transfer by the filing date of the later application. Where there is an assignment to transfer, it must take place before the later application is filed.⁽¹⁹⁾

Priority can be lost, also, and lead to patent invalidity, if there is a relevant document or intervening disclosure made public in the period between the priority date and the filing date.⁽²⁰⁾

IV- Conclusion

The protection of intellectual property had developed in the later times as long as the developing in such property itself. The right in patent is the main topic that got protection. Paris convention for the protection of industrial property had developed patent protection by a set of rules governing the matters of priority in applications for patent.

Article 4 from the convention determines one year the person who made first application

19 Avoid loss of priority and potential invalidity in Europe: Priority claimant must have actual ownership of the priority right when they make their claim to it, may 2010. Available at: <http://www.hgf.com/uploads/Cook%20Edwards%20Decision.pdf>

20 *ibid.*

III- The Regulation of Priority for Patent Application under Paris Convention

1- Meaning of Priority:

The priority for patent application under the Paris Convention is the right of a person who has filed a patent application in one of the member countries of the Paris Convention, which named the first country, to receive the same treatment, as that at the time when the patent application has been filed in the first country, in determination of ingenuity, inventive step, etc. for patent applications in another member country of the Paris Convention, which named the second country, regarding the content described in the filing documents of the first patent application.⁽¹¹⁾

This process of development was followed through the Lisbon revision in 1958. One of the achievements of that revision was to introduce the concept of partial priority in the text of the convention. After overcame a long opposition from a number of countries, the principle of multiple priority had first been included in article 4 as revised in London. The provisions were extended at Lisbon to cover partial priority also.

2- Rules of priority

In this section, we offer in two points: the period when priority can be claimed in the convention and partial and multiple priorities:

A- Period when priority can be claimed:

The period when priority can be claimed under the Paris Convention shall be 12 months from the date of filing of the first application to the first country.⁽¹²⁽⁹⁾⁾

This period shall start from the date of filing of the first application, and the day of filing shall not be included in the period.⁽¹³⁾

11 Priority under the Paris Convention, p.3. Available at: (http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/Guidelines/4_1.pdf).

12 Article 4 C (1).

13 Article 4 C (2).

In addition, 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 second country, the period shall be extended until the first following working day.⁽¹⁴⁾

b- Multiple and Partial Convention Priorities:

Partial priorities is a term that used when a patent application, or a patent, cannot be given uniform priority, because of the existence of different priority dates for the various parts of the application or the patent, irrespective of the cause of such differences. Partial priorities may arise when priority according to the convention was claimed for the various parts of the application on the basis of different prior application in which the respective parts of the invention were first disclosed⁽¹⁵⁾.

14 Article 4 C (3).

15 "The reasons -which, mutatis mutandis, apply similarly to the recognition of partial priorities - were described by the international bureau in the following terms":

"It often happens that, after filing a first patent application, an inventor improves his invention while the period of priority is still valid and requests for these improvements either ordinary patents or certificates. The problem has arisen of whether the inventor who patents his invention in one or more countries of the union can combine all of their elements in the same application or whether he must on the contrary apply for as many foreign patents as he has successively obtained for his invention in the country of original deposit. The later, and more stringent, solution is scarcely in harmony with the spirit of the convention, which aims to favor and promote the inventive spirit. If the multiplicity of the successive patents in the country of original deposit is a consequence of the fact that they had been requested following the successive improvements, this is not true of the applications in other countries once the invention has been fully adapted. It is only natural for all the elements to be grouped within the same application at that point, provided that the character of the invention has remained unchanged and that it has only been improved

claimed that it is necessary to protect small inventors, who might not have the resources to file patent applications at the time, and might, therefore, lose a patent race with the large companies may invent a same thing after they did.⁽⁶⁾

But, in September 2011, the American Congress enacted, and President Obama signed the law, a bill entitled the “Leahy-Smith America Invents Act” (AIA). Section 3 of this law entitled “First Inventor to File”. In this Section, the act alters the principle of “first to invent” priority⁽⁷⁾, and adopts instead a “first

awarded a patent so long as he does not abandon, suppress, or conceal it”. “But an inventor who would otherwise lose a priority contest under the general priority rule will be granted a patent if (1) he was the first to conceive of an invention and (2) he was diligent in reducing the invention to practice”. See: John F. Carroll, IV, Priority of Invention in United States Patents: From the Paris Convention to GATT, 1 RICH. J.L. & TECH. 3 (1995), p. 18-19. Available at: <<http://www.richmond.edu/jolt/v1i1/carroll.html>>

- 6 Mark A. Lemley & Colleen V. Chien, Are the U.S. Patent Priority Rules Really Necessary? UC Berkeley Public Law and Legal Theory Research Paper Series, p.1.

There is an exception in USA law, however, based on the Paris Convention. The code “allowed a very specific foreign act to be admissible to prove an inventor’s date of invention: the filing of a foreign patent application. Specifically, the date the foreign patent *application* was filed will be considered the date of invention if: (1) a patent application is then filed in this country by a person who has (2) within the past twelve months (3) filed (4) a patent application that meets certain disclosure requirements (5) for the same invention (6) in a foreign country that affords “similar privileges” to applications filed in the United States”. John F. Carroll, IV, op. cit., p. 24.

- 7 This “has been a feature of the United States patent system since the earliest statutes in 1790 and 1793”. See: Donald S. Chisum, Priority among Competing Patent Applicants Under the American Invents Act, Electronic copy

inventor to file” priority principle. It retains a “grace period” of one year for inventor pre-filing date disclosures, and provides remedies for instances in which a first-to-file applicant derived an invention from a second-to-file applicant. Article 3 is the prominent feature of that act.⁽⁸⁾

3- Importance of Priority Regulation by the Convention:

The most important advantage afforded by the Paris convention is the possibility of claiming priority for patent applications in any country of “Paris union”. This right of priority had already contained in the earliest version of the regulations of the convention, as signed in Paris in 1883. Continuously, the regulations incorporated in article 4 have been developed since that time. The aim of these developments was to make the regulation of priority in the convention corresponding to practical requirements, and at the same time, to ensure the greatest possible uniformity in its application in all countries of the union.⁽⁹⁾

A great practical advantages, also, offers by the right of priority to the applicant wanting protection in several countries. The applicant is not required to present all applications at home and in foreign countries at the same time, since he has 12 months at his disposal to decide in which countries to request protection. That period can be used by the applicant to determine the steps must be taken to ensure protection in many countries of interest in the particular case.⁽¹⁰⁾

available at: <http://ssrn.com/abstract=1969592>, p. 4.

- 8 *ibid.*
- 9 Gehard Schricker, Problems of convention priority for patent applications, in the collection of (the international intellectual property system: commentary and materials, part one, Kluwer Law International, 1999, p. 678.
- 10 WIPO Intellectual Property Handbook: Policy, Law and Use, p. 243-244. Available at: (<http://www.wipo.int/about-ip/en/iprm/pdf/ch5.pdf>).

Priority in Paris Convention for the Patent Applications

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Introduction

The right of priority is found in Article 4 from Paris Convention for the Protection of Industrial Property, which provides that an applicant, to be protected by Convention, who files a first regular patent or application in any of the countries of the convention union, can then file subsequent applications in other countries of it for a defined period of time, 12 month, and which subsequent applications will have an effective filing date as of the first filed application.⁽¹⁾ That right is referred to, also, as the “Convention priority right,” “Paris Convention Priority Right,” or “Union Priority Right”.

II- Importance of priority

1- In General:

There are some most important reasons for priority in patent application:

a. The inventor can fill an application in most countries of the world through 12 month of the filing date of the original application. This allows the patentee another year for determine, whether or not, there is a market for his product outside the country in which the original application was filed, and also, whether or not, there is a profit can be made in those other countries⁽²⁾.

b. When the application is examined, if there

had been any publication of the same invention, between the time that the original application was filed and the filing date of the subsequent foreign applications, that publication should not be used as prior art against the subsequent application. That is because of the priority date is the “Effective Filing Date” for examination purposes in the other jurisdictions in which the application is later filed⁽³⁾.

c. Further development time: the inventor may be needed to develop his invention further; the priority year allows him the time to make this. This time can be used to obtain more experimental data to support the patent application or to refine more specifically the aspects of the invention that are likely to be the most commercially important. If further experimental data is produced, one or more priority applications can be filed in the priority time, 12 month, based on the text of the original application, but including the additional new data⁽⁴⁾.

2- Importance of Patent Priority in USA Law: Previously, The United States was the only country in the world that awards patents to the first person to invent something, not to the first person to file a patent application. In order to determine who is first to invent, it had created a set of “interference” proceedings and legal standards to define invention and decide how it may be proven⁽⁵⁾. Supporters of this system

1 Seth M. Reiss, Commentary on the Paris Convention for the protection of industrial property, available at: (www.Lex-IP.com.Paris.)

2 Viola Ange, Priority – Article 4A of the Paris Convention, September 7th, 2010, available at: <http://ipparalegals.com/media/blogs/workaround-workshop/929/>.

3 *ibid*.

4 Patent and trademarks attorneys, Options in the Priority Year, available at: <http://www.Dehnes.com>

5 “The general rule regarding priority of invention can be restated as follows: the first person to reduce an invention to practice will be

الأسبقية بشأن طلبات براءة الاختراع في اتفاقية باريس

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الملخص

إن الأسبقية في طلب براءة الاختراع تجسد حقاً للشخص الذي يبادر قبل غيره في طلب هذه البراءة في بلد معين ومن ثم تكون له ذات المعاملة في بلد آخر، وذلك فيما يتعلق بتحديد الخطوة الإبداعية في الاختراع وما إلى ذلك. وقد أقر الحق تبعاً للأسبقية في المادة (٤) من اتفاقية باريس التي أجازت أن تقدم طلبات لاحقة في بلدان أخرى لتحديد المدة وما يتبع ذلك من طلبات لاحقة، وأن يكون لهذه الطلبات ذات الأثر لتاريخ الطلبات التي قدمت أول مرة. إن هذه الورقة تحدد الحق بموجب اتفاقية باريس وتقتصر على أن يتم تبني ذلك في القوانين العربية.

Priority in Paris Convention for the Patent Applications

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Abstract

The priority for patent application is the right of a person who files a patent application in certain country to receive the same treatment in another one related to the determination of ingenuity, inventive step, etc. This right conferred according to Article (4) of Paris convention for the Protection of Industrial Property, which provides that an applicant can then file subsequent applications in other countries for a defined period of time, and which subsequent applications will have an effective filing date as of the first filed application. This paper will determine the right in Paris convention, and suggest to be adopted in Arab countries.

Keywords: Intellectual property. Patent. Priority.

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