



## GUIDELINES FOR TRANSFERRING PRIORITY RIGHTS

FICPI CET Group 3 recently carried out a study to identify the various national requirements for the effective transfer of priority rights in accordance with Article 4A(1) of the Paris Convention, under which an applicant filing an application for an IP right in one country can claim the right of priority from that application in another country. The study focused on the manner in which various countries and regions have implemented the provisions of Article 4A(1), and where this implementation differs from the specific provisions of the Paris Convention. The information gathered was analyzed and a set of guidelines prepared to assist FICPI members and their clients to take the steps necessary to ensure that priority rights are transferred in a manner which will be effective in all or most Paris Convention countries.

To initiate the study a questionnaire was prepared providing background information in relation to the operation and effect of the provisions of Article 4A(1) of the Paris Convention (PC) and setting out 16 questions framed to obtain information about requirements and procedures for transferring priority rights in accordance with these provisions.

The questionnaire was primarily concerned with the filing of a patent application (the “Later application”) claiming priority from an original priority setting application (the “Priority application”) made in an originating country that is a signatory to the Paris Convention, in circumstances where the applicant of the Later application is different from the applicant of the Priority application. For the priority claim made in the Later application to be effective it is important to ensure that the priority rights are transferred to the applicant of the Later application by the applicant of the Priority application. The questionnaire examined several issues associated with the effective transfer of priority rights, including:

- (i) The general requirements for transferring a priority right from the applicant of the Priority application to another party;
- (ii) Whether an applicant who has no rights in the Priority application can be included in a Later application claiming priority from the Priority application;
- (iii) Whether the right to claim priority can be treated separately from rights in the invention and rights to the Priority application;
- (iv) What rights are needed at the time of filing a Later application, and for obtaining a patent with a valid priority claim in respect of that application;
- (v) Whether, in the case of a Priority application with multiple applicants, each applicant has an individual priority right or the priority right is owned jointly by all applicants, and the circumstances under which the priority right (or the portions belonging to respective co-applicants) can be assigned to a third party;
- (vi) Whether employment contracts are effective in transferring priority rights in the case of a single applicant, and in the case of multiple applicants with potentially different employment contracts;



- (vii) The law that is applicable to the determination of the effectiveness of a priority right transfer, particularly when the invention is made and/or the transfer occurs over multiple countries; and
- (viii) In the case where a single application is filed for multiple inventions, the circumstances under which the priority right can be separated between the inventions and the inventors of each respective invention.

The questionnaire also examined whether there are differences in the requirements for the transfer of priority rights for national phase applications made under the Patent Co-operation Treaty (a PCT application).

## SUMMARY

While the full report of the study is available on the FICPI website, the results can be summarized as follows.

It appears that the right to claim priority from an earlier filed Priority application is not limited to the applicant of the Priority application, and may be held by the assignee of the Priority application, or the assignee of the right to claim priority.

In general, the mere consent of the applicant of the Priority application is not sufficient to enable a person who is not the assignee of the Priority application, or of the associated right to priority, to obtain the priority right. It appears that a contribution of patentable subject matter to the Later application will, in most countries, enable an applicant of this Later application to obtain the right to claim priority from a Priority application in circumstances where the person does not otherwise possess rights in the Priority application itself. The act of making the application jointly with the owner of the priority rights can imply assignment of those rights to the extent that such assignment may be necessary. However, such a priority claim will only be valid in respect of subject matter that is disclosed in both the Priority and Later applications.

Many countries recognize a practical separation between the right to claim priority from a Priority application, rights in the Priority application, and rights to the invention the subject of the Priority application, even in the absence of any specific legislative provisions or case law to support the independence of these rights. Countries where these rights appear to be inseparable include the United States, Canada, Peru and Singapore.

Although rights in the invention appear to be generally required for a person to obtain the grant of a valid patent, in many countries these rights are not required to file the Later application. In such countries, the retroactive acquisition of the rights in the invention after filing the Later application, and before the grant of a patent on this application, generally allows a valid patent to be obtained. Exceptions include the United Kingdom, and the United States and Canada where rights to the invention are required to file the Later application. However, some other countries do not permit rights in the invention to be obtained at a time after filing the Later application for the grant of a patent with a valid priority claim.



It appears that the right to claim priority must be possessed by the applicant of the Later application at the time of filing in order to enable the grant of a patent with a valid priority claim. The priority right cannot typically be acquired retroactively to allow a valid patent to be granted in respect of a Later application with its priority claim intact.

Generally, where there are multiple applicants of a Priority application the priority right must be exercised by the co-applicants jointly. A minority of countries, including Brazil, China, New Zealand, Peru, Singapore and the United States, permit individual co-applicants to claim priority independently. The transfer of a co-applicant's 'share' of the joint priority right to a third party typically requires, at least, the consent of all other co-applicants, and in some countries is not possible even when such consent is available.

Provisions included within employment contracts are generally effective in transferring priority rights in an application filed by, or on behalf of, a single employee, provided that the application relates to an invention made in the course of, or as a consequence of, the employee's employment. However, in some countries the priority rights must be separately assigned to the employer by the employee filing the Priority application. Additionally, when the Priority application has multiple applicants the effectiveness of the employment contract provisions for transferring priority rights varies based on jurisdiction.

When determining whether a transfer of priority rights involving multiple jurisdictions is effective, most countries prioritize the law of the country where the assignment was executed, or the law of the country that is specified in the assignment. Due to the absence of any international legal authority or substantial consensus regarding this issue, applicants anticipating the possibility of a priority rights transfer across multiple jurisdictions should proceed cautiously.

Finally, it appears that separate Later applications can generally be filed for each invention disclosed within a single Priority application. Although the priority right can be split between the different inventions in many jurisdictions, some notable exceptions include Argentina, Australia, Brazil, China, Greece, Romania and the United States where the priority right is coupled to the application.

## **GUIDELINES FOR THE EFFECTIVE TRANSFER OF PRIORITY RIGHTS**

Some general guidelines for the effective transfer of priority rights include:

- If possible, try to ensure that any Later application (which may be a PCT application) is filed in the name of the applicant of the Priority application, and that this applicant is also the owner of the invention and the priority rights at the time the Later application is filed.
- If this is not possible (i.e. where the rights to the application, to the invention and to the priority claim belong to different parties), try to ensure that the rights to the application, to the invention and to the priority claim are transferred to the applicant prior to filing the Later application.
- Where it is not possible to ensure that rights to the invention and priority rights are possessed by the same party at the time of filing a Later application, consideration should be given to naming as



applicants all parties possessing rights in the invention and priority rights, taking into account the potential difficulties that handling an application with multiple applicants may present.

- In many countries it is important for assignments of rights relating to patents and patent applications to be in writing and signed by the assignor and the assignee. For this reason, it is safest to ensure that such assignments are executed, as a Deed or contract, in this manner.

The following additional guidelines may also assist applicants to effectively transfer priority rights:

1. It is possible to include an additional applicant in a Later application who does not have any rights in the Priority application where that additional applicant has contributed patentable subject matter to the Later application, or derives title from a person who has contributed patentable subject matter, provided the applicant of the Priority application, or the person who has obtained rights in the invention and priority rights from that applicant, is also named as an applicant.
2. If an additional person or entity is made a co-applicant of the Later application by a party who possesses all the relevant rights (i.e. rights in the invention, the Priority application, and the priority claim), then the act of making the Later application by the party may implicitly transfer those rights to that additional person or entity.
3. In some countries obtaining rights to the application, the invention and the priority claim will necessarily require assignment of the Priority application itself. When a Priority application is filed by multiple applicants, it is safest to avoid any transfer of priority rights by individual co-applicants and to file the Later application in the name of all co-applicants of the Priority application or in the name of the assignee of all co-applicants. Where the Later application is filed in the name of one of the co-applicants and an assignment from all co-applicants cannot be obtained, it is important to obtain the consent, at least, of the other co-applicants.
4. Regarding the transfer of priority rights via employment contracts:
  - a. employment contracts should not be relied on for the effective transfer of priority rights, particularly for a Priority application with multiple applicants and where the respective employee inventors are each bound by different contracts;
  - b. if an employment contract is used for the transfer of priority rights, a confirmatory assignment should be obtained in order to confirm the transfer (*preferably before filing the Later application*); and
  - c. instead of relying on employment contract provisions, it is recommended that the employee inventors (either jointly or individually) transfer all rights associated with the invention to the applicants of the Later application (i.e. the employer(s)), including rights to the Priority application, to claim priority from this application, and to the invention itself.
5. For multiple inventions involving different inventors disclosed in a single Priority application filing a single Later application and subsequent divisional applications for each invention is recommended. The corresponding application for each invention may be subsequently assigned to



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the respective inventor(s) by the other co-applicants. Where it is envisaged at the time of initial filing that different applications will be pursued for inventions involving different inventors it is advisable to file separate priority applications for the different inventions.

**Michael Caine – Chair CET 3  
& Daniel Pullella, Davies Collison Cave Pty Ltd**

*The full Guidelines, including Annexes, are downloadable [here](#).*

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