



## TRANSFER OF PRIORITY RIGHTS PARIS CONVENTION ARTICLE 4A(1)

### BACKGROUND

This report describes the results of a study carried out 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 with a view to prepare a set of guidelines 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. A copy of this questionnaire is attached as [Annex 1](#). The questionnaire was sent to all Delegates on 10 July 2015 requesting completion and return by 13 September 2015. The replies were then reviewed in detail and a summary of the responses was prepared. Unfortunately responses were not received from Belgium, Chile, Columbia, Hungary, Ireland, Israel, Malaysia, the Netherlands, Norway or Sweden.

The questionnaire is 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 examines 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 examines 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).

## RESULTS

The results of the study are summarized in the spreadsheet attached as [Annex 2](#) (a blank entry in the sheet indicates that an answer was not provided by the Delegate for the corresponding question). The level of detail in the responses provided by the Delegates varied significantly. The responses of some Delegates indicated a possible difficulty comprehending the subtle differences between questions that relate to a common concept (such as the importance of rights to the invention for merely filing a Later application, as opposed to actually obtaining a granted patent). This was particularly evident for countries where the language of the questionnaire (i.e. English) is not natively spoken.

In cases where Delegates provided information that extended beyond the scope of the study, the analysis presented below may not necessarily reflect the entirety of this information. Furthermore, a number of responses referred only to the practices of the relevant Patent Office without providing any substantive legal basis for this practice. The interpretation and analysis provided below is based on the assumption that the practices referred to in such responses accurately reflect the IP laws in the relevant jurisdiction. Additionally, it is noted that while the information provided by the Delegates is assumed to be accurate, no independent verification of the correctness of this information has been performed.

The content of this report is organized into the following categories: i) legal frameworks governing priority rights; ii) obtaining priority rights; iii) separation of rights; iv) invention rights and priority rights; v) priority rights for multiple applicants; vi) employment contract based transfers; vii) laws for transfers across jurisdictions; and viii) multiple inventions within a single application.

## LEGAL FRAMEWORKS GOVERNING PRIORITY RIGHTS

The majority of the countries surveyed allow for the transfer of priority rights through the implementation of either the PC provisions directly or local law provisions which (are intended to) operate with the same effect. Most respondents indicated that there is unlikely to be a conflict between



the local (national) law provisions and those of the PC. However, in the event of a conflict there appears to be variation in relation to the legal code that takes precedence. A significant number of respondents, including those from Argentina, France, Greece, Russia and Switzerland, indicated that the PC provisions take precedence over their national law provisions. In other jurisdictions, including Australia, Canada, South Africa, the UK, and the United States, such a conflict would be resolved in favor of the national law provisions.

## OBTAINING PRIORITY RIGHTS

The right to claim priority from an earlier filed Priority application in a foreign country is generally not limited to the applicant of the Priority application. Priority rights can also be enjoyed by the assignee of the Priority application, or by the assignee of the right to claim priority in the case that this right exists as an independent right from the rights in the Priority application itself. Although the answers provided by the Czech Republic suggested that priority rights could not be transferred, it was subsequently clarified that this was not the case.

However, there are several exceptions. In Brazil and China, the right to claim priority is not automatically granted to the assignee of the Priority application. In this case the priority right must be obtained by explicit assignment (i.e. the assignee of the Priority application must also be assigned the priority right).

In most jurisdictions, mere consent of the applicant of the Priority application is not sufficient to enable a person to obtain the right to claim priority, particularly where the consent is not provided in a legally enforceable form (such as, for example, in the case of a verbal agreement). Therefore, it appears that formal assignment of the Priority application and the priority right should be performed to enable a person to claim priority in respect of a Later application.

In general, the right to claim priority can also be obtained by a person lacking rights in the Priority application but who is named as an applicant in the Later application. The acquisition of priority rights by this “other person” may, in some countries, require a contribution of patentable subject matter to the Later application. In other cases, it would seem that the making of the application jointly with the other person can imply a transfer of the right to claim priority, as well as rights in the invention, to the other person. Additionally, in some countries, such as Brazil, Denmark and Mexico, it is a requirement that at least one applicant of the Later application is able to validly claim priority from the Priority application. In other jurisdictions, the priority claim will only be valid for the subject matter contributed by the other person if this subject matter is disclosed in both the Priority and Later applications (for example, in Greece, New Zealand and Spain). Exceptions include China, Italy and Singapore, where a person’s right to claim priority is not dependent on their patentable subject matter contribution.

## SEPARATION OF RIGHTS

In many countries surveyed a separation exists between the right to claim priority from a Priority application, rights in the Priority application, and rights to the invention(s) that is/are the subject of the Priority application. A significant number of respondents have indicated that their Patent Office practice



allows for the separate assignment of the right to claim priority, the rights in the invention, and rights in the Priority application itself. This appears to be the case even in jurisdictions where there are no specific legislative provisions or case law that refer to a separation between the rights. Countries where all three rights are, in practice, able to be independently assigned to different parties include Australia, United Kingdom, South Africa, Brazil, China, Korea, India, Greece, Turkey, Poland, Switzerland and Portugal.

By contrast, rights in the invention, rights in the local Priority application, and the right to claim priority are not separable in several countries, including the United States, Canada, Peru and Singapore. For example, in the United States, an assignee of the Priority application owns all rights including the right to file continuation, divisional or foreign applications that claim priority, and this right in the Priority application is also coupled to the rights in the invention the subject of the Priority application.

There is variation in the extent to which rights in the invention are separable from rights in the Priority application, even when the right to claim priority can be assigned independently. In some countries, such as France, Italy, Russia, Spain and New Zealand, the rights in the invention are bound to the Priority application and cannot be separately assigned.

## INVENTION RIGHTS AND PRIORITY RIGHTS

Variation exists with respect to the necessity of possessing rights in the invention at the time of filing a Later application, and for obtaining the grant of a valid patent in respect of this application. In almost all countries surveyed, possessing rights in the invention is required for the grant of a valid patent. However, in many surveyed countries, rights in the invention are not required to file the Later application, and these rights can be obtained after the filing of the Later application, and before the grant of a patent on this application. In general, for countries where the rights in the invention can be acquired after the filing of the Later application, a Later application can also be transferred to a person already possessing rights in the invention to enable that person to be granted a valid patent. The exact timing requirements for obtaining rights in the invention varies according to each specific jurisdiction, and typically depends on whether these rights are needed at a particular stage during prosecution (as in Australia, for example, where they are required to request examination of the application).

However, in the United Kingdom, and also in the United States and Canada where rights in the invention and the right to claim priority are inseparable, rights to the invention are required to file the Later application. Furthermore, in these jurisdictions and some others (including China, Finland, India, Greece, Poland and Spain) the rights in the invention cannot be obtained by the applicant at a time after filing the Later application to enable the grant of a patent to that initially disentitled applicant. However, some respondents from these countries indicated that it may still be possible for an initially disentitled applicant to transfer the Later application to an entitled party, who had acquired rights in the invention prior to the filing of the Later application, to enable that entitled party to obtain a granted patent with a valid priority claim.

In contrast to rights in the invention, in general the right to claim priority must be possessed by the applicant of the Later application in order for the patent to be granted with a valid priority claim. Furthermore, in almost all surveyed jurisdictions the applicant must possess the priority right at the time of filing the application. That is, the priority right typically cannot be acquired retroactively to permit



the grant of a patent with a valid priority claim in respect of a Later application filed without such priority rights. This is consistent with provisions of the European Patent Convention (EPC) which require that any transfer of a right to claim priority for a Later application must have been effected prior to filing that application. However, there may be some exceptions to this requirement, such as Greece, where it was indicated that the priority right may be transferred to the applicant of the Later application at any time before the priority period has expired.

Some respondents (such as Russia and Poland) also indicated that their respective Patent Offices do not formally check that an applicant possesses the right to claim priority, or rights to the invention, at the date of filing the Later application or, in some cases, at any time. In such cases, a patent may be granted which is susceptible to challenge through invalidation proceedings.

## **PRIORITY RIGHTS FOR MULTIPLE APPLICANTS**

In most countries, where a Priority application in respect of a single invention is filed by multiple applicants/inventors, the resulting priority right is held by the applicants as a joint entity. That is, the right of priority derived from the Priority application must be exercised by the applicants jointly, such that all applicants named in the Priority application, or the assignee of those joint applicants, should be named as the applicant of the Later application.

However, in several jurisdictions a priority right that has been jointly acquired can be exercised as an individual right by a co-applicant of the Priority application, such that the co-applicant may file a Later application with a valid priority claim independently of the other applicants. Countries permitting individual co-applicants to claim priority from a Priority application include Austria, Brazil, China, New Zealand, Peru, Singapore and the United States. Additionally, Switzerland allows for each co-applicant of the Priority application to exercise their rights (i.e. to claim priority) individually provided that the consent of the other applicants is obtained.

In general, one applicant's 'share' of the joint priority right may be transferred to a third party. However, this type of independent transfer typically requires the consent of all other co-applicants. In a minority of countries, including the United Kingdom, Brazil, China, Switzerland, Romania, Russia and Spain, the transfer of a partial share in a joint priority right held by an individual co-applicant is not possible, regardless of whether the other co-applicants consent. In this case a third party may obtain priority rights only by a joint transfer of the right from all of the applicants of the Priority application. Additionally, in jurisdictions where the priority right is coupled to the rights in the invention and/or rights in the Priority application (such as in the United States, Canada, and Singapore) a joint transfer of these rights is typically required to effectively transfer the associated priority right.

## **EMPLOYMENT CONTRACT BASED TRANSFERS**

Employment contracts are generally effective in transferring priority rights in an application filed by, or on behalf of, a single employee inventor to their employer. This is typically conditional on the application relating to an invention made in the course of, or as a consequence of, the inventor's employment by the employer. Where the priority rights are coupled to the invention rights, effective transfer of priority requires the employment contract to also transfer the rights in the invention to the employer.



However, there are several exceptions, such as Argentina, China and Denmark, where priority rights must be separately assigned to the employer by the employee inventor filing the Priority application. Furthermore, in some jurisdictions, such as France, an employer is entitled to claim ownership over a Priority application, along with the associated right of priority, filed in the name of an employee. In such cases, an employment contract based assignment of the right of priority is unnecessary or at least redundant.

There is uncertainty regarding the effectiveness of employment contracts for transferring priority rights in cases where the Priority application has multiple applicants, and particularly where each applicant is subject to a distinct employment contract. In Australia, it appears that the success of a priority right transfer via an employment contract is dependent on the employer, who receives priority rights from an employee, being recognized as a "Convention applicant", a term defined in the Patents Act. It is believed that a transfer of the priority rights by an employment contract is unlikely to be recognized by a Court if the inventor has applied jointly with an inventor from another company subject to a different employment contract. The transfer of priority rights to the employer, or employers, of the inventors in the presence of conflicting employment contract provisions (i.e. where the contracts do not transfer the individual priority rights to the same employer) is also indicated to be ineffective in Turkey, Romania, Russia, China, and Korea.

However, in New Zealand an employer would be entitled to the priority rights in a Priority application filed in the name of an employee, even if the other joint applicants are not employees thereof (see *Fisher Controls International LLC v Dennis Eugene O'Hara* [2012] NZIPOPAT 14). Furthermore, since the priority right of the individual inventors is divisible in New Zealand (i.e. it can be exercised independently by the individual applicants) it is likely that priority rights would be transferred to an employer even if there are multiple inventors with different employment contracts. This also seems to be the case in some other countries where the priority right of the individual inventors is divisible, including South Africa, Brazil and Peru.

## **LAWS FOR TRANSFERS ACROSS JURISDICTIONS**

There is no clear consensus in relation to which laws should apply to determine whether a priority right has been transferred in the case where the transfer involves multiple jurisdictions. The majority of Delegates indicated that the law which should be applied to resolve such a transfer is either: i) the law of the country where the assignment of the priority rights was executed; or ii) the law of the country specified in the assignment as the country in which it is to be interpreted. However, the Delegates from some countries indicated that the applicable law should be that of the country where the Priority application is filed, the country where the Later application is filed, the country where the assignee resides, or the country where the assignor resides.

## **MULTIPLE INVENTIONS IN A SINGLE APPLICATION**

In general, a separate Later application can be filed for each invention disclosed within a single Priority application that is filed by multiple (i.e. joint) applicants who are the respective inventors of those inventions. The cross-assignment of priority rights is typically not required if the applicants of the Later application are the same as those of the Priority application. The extent to which the priority right is divisible between the distinct inventions disclosed in the application varies. A significant number of





countries allow the priority right to be split between the different inventions, including Denmark, Finland, Italy, Korea, New Zealand, Peru, Poland, Portugal, Russia, South Africa, Switzerland, and the United Kingdom.

However, in countries such as Argentina, Australia, Brazil, China, Greece, Romania and the United States the priority right is coupled to the application and cannot be split across inventions. In these jurisdictions, an alternative strategy may involve filing a single Later application that includes all inventions disclosed in the Priority application, and subsequently filing separate divisional applications for each distinct invention. If the divisional applications are filed in the name of the co-applicants of the Later application, then assignments may be executed to transfer the corresponding application relating to each invention to its inventor or assignee as required.

## OTHER POTENTIAL ISSUES

### PARIS CONVENTION VS PCT APPLICATIONS

In the majority of countries surveyed, national phase applications of a PCT Priority application are treated in the same way as a Later application that claims priority from a foreign Priority application. Australia appears to be the only surveyed country that implements a substantially different set of legal provisions governing priority rights for Paris Convention applications and PCT applications (see [Annex 2](#)).

In Australia, to claim priority from a Priority application when filing a Later Convention application outside the PCT, the applicant must be a ‘Convention applicant’. The legislative definition of a Convention applicant includes a person who has the consent of the original applicant, the assignee, or a person who is entitled to an assignment, or legal representative of any of those persons. It is unclear whether Convention applicant status must apply: i) on the date of filing the application, or ii) whether the applicant can qualify after the filing of the Later application such as to permit valid grant of the patent.

However, when the Later application is a national filing in respect of a PCT application, it seems that the definition of ‘Convention applicant’ does not apply to determine priority rights. In Australia, priority rights for a PCT application are obtained in accordance with Article 8 of the PCT and Article 4 of the PC. In contrast to Convention applications, it appears that the consent of the original applicant is unlikely to be sufficient for the transfer of priority rights to another person.

## SUMMARY

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 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**

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FÉDÉRATION INTERNATIONALE DES CONSEILS  
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF  
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION  
VON PATENTANWÄLTEN

## ANNEX 1 - (copy of questionnaire as circulated)

### QUESTIONNAIRE ON TRANSFERRING PRIORITY RIGHTS

An important aspect of the International system for registering intellectual property rights is the ability for an applicant for an IP right in one country, or the applicant's successor in title, to claim a right of priority in another country. This priority right arises under Article 4 of the Paris Convention. Article 4A(1) of the Paris Convention appears as follows:

"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."

At least in some jurisdictions the right to claim priority for a patent application (i.e. the right to file a patent application claiming a right of priority from an earlier foreign application) is a right which exists separately from the rights in the invention itself (i.e. the right to obtain a patent for the invention), and separately from the rights in the application that was filed to give rise to the priority rights.

The situation is even further complicated in some jurisdictions where rights in the invention itself are intimately linked to the right to file a patent application in the first place; in other words, where rights in the invention are required in order to file a valid patent application.

The net result is that there is the potential for the various rights to be owned by different parties. This then raises the question: which of these rights must be possessed by an applicant in a particular country in order to obtain a patent with a valid priority claim, and to be in a position to enforce the patent in that country?

Since the priority period referred to in Article 4A(1) of the Paris Convention is a fixed period, 12 months for patents and utility models, and 6 months for trademarks and designs, it also appears to be important for the person claiming the priority right to be in possession of that priority right at the time the priority right is exercised. In this regard, it is apparent that in at least some jurisdictions it is not possible to transfer a priority right to an applicant retrospectively, i.e. after an application has been filed claiming the priority, or after the fixed priority period has expired. There may also be other rights, such as the right to file a patent application, which must be possessed by the applicant at the time the application is filed.

Where the applicant of the original priority setting application (a "Priority" application) is the same as the applicant filing the priority claiming application (the "Later" application) in the other Paris Convention country, problems regarding the transfer of priority rights seldom arise. However, particular care must be taken to ensure effective transfer of priority rights in circumstances where the applicant of the Priority application is different from the applicant of the Later application. The problem is particularly pronounced for US applicants since many US applications are filed in the name of the inventors while the foreign applications are filed in the name of a company.

The wording of Article 4A(1) of the Paris Convention also raises other questions in relation to the transfer of priority rights. For example, where there are multiple applicants or multiple inventions,



trademarks or designs associated with a single Priority application, are the priority rights divisible among the applicants, or divisible between the inventions, trade marks or designs?

In view of the importance of ensuring that priority rights are effectively transferred to the applicant of the Later application claiming priority, CET Group 3 has prepared the following questionnaire to assist in gaining an understanding of the various national requirements for the effective transfer of priority rights. It is hoped that the answers to the Questionnaire will assist in the preparation of guidelines for preparing assignments for transferring priority rights in a manner which will be acceptable to all Paris Convention countries. In order to simplify the questionnaire, several questions refer solely to patents and inventions. If your answers would be different if the question referred to designs or trade marks, please indicate this in your answers.

We would be grateful if each national group could complete the attached Questionnaire and return it to the FICPI Secretariat ([alexandra.louage@ficpi.org](mailto:alexandra.louage@ficpi.org)) by 13 September 2015. When completing the Questionnaire, please restrict your answers to the practice and law relating to claiming priority in your country from Priority applications, either through filing Later applications directly under the Paris Convention (a "Convention" application) or filing International applications, such as International patent applications under the PCT. Please answer the numbered questions in so far as they relate to applications filed directly in your country under the Paris Convention. In the final section of the questionnaire you will be asked to explain if there are any differences in relation to the treatment of PCT applications with foreign priority claims.

[Questionnaire appended]

## QUESTIONNAIRE

1. Has your country adopted the provisions of Article 4A(1) of the Paris Convention into its law, or has your country introduced provisions which differ in language or effect from Article 4A(1)? If the provisions are different, please set out the provisions below and explain any differences in operation or effect.
2. If the provisions implementing Article 4A(1) in your country differ from the wording of Article 4A(1) of the Paris Convention, such that there is a discrepancy between the two provisions, which provision has legal effect, the provision in your national law or the Paris Convention? What is the legal basis for one provision dominating the other?
3.
  - (a) Does the right to claim priority in your country from an earlier filed Priority application in a foreign country rest solely with the applicant of that earlier filed Priority application?
  - (b) Or can this right to claim priority rest with:
    - (i) the successor in title of the Priority application (i.e. the assignee of the Priority application),
    - (ii) the successor in title to the priority right (i.e. the assignee of the right to claim priority), or
    - (iii) the successor in title of both the Priority application and the priority right?



- (c) Can this right to claim priority even extend to other persons - and if so what are the criteria to be met by such 'other' persons?
- (i) Is it sufficient for the person claiming the right of priority to merely have the "consent" of the applicant of the priority application to enable a priority right to be claimed?
  - (ii) If the right to claim priority can extend beyond the original applicant and the successor in title of the original applicant, please explain the legal basis for this extension of the priority right.
  - (iii) Can an additional person who does not have any rights in the Priority application be named as an applicant in a Later application filed in your country claiming priority under the Paris Convention:
    - In circumstances where the person contributed patentable subject matter to the Later application not previously disclosed in the Priority application, or obtained rights to such subject matter? If so, is being named as an applicant for the Later application sufficient to enable the additional person to be a patentee for the patent eventually obtained? Can the priority claim in the patent be valid in these circumstances?
    - In circumstances where the person did not contribute patentable subject matter to the Priority application or Later application, and did not possess the right to claim priority from the Priority application in your country? If so, is being named as an applicant for the Later application (but not having the priority right) sufficient to enable the additional person to be a patentee for the patent eventually obtained? Can the priority claim in the patent be valid in these circumstances?
    - In circumstances where the person did not contribute patentable subject matter to the Priority application or Later application, and did not possess rights to the invention in your country? If so, is being named as an applicant for the Later application (but not having a right to the invention) sufficient to enable the additional person to be a patentee for the patent eventually obtained? Can the priority claim in the patent be valid in these circumstances?
    - In other circumstances?
4. (a) In your country is it necessary (for the purposes of filing an application which will lead to the grant of a patent with a valid priority claim) for the applicant to possess rights in the invention (i.e. the right to obtain a patent) at the time of filing the Later application for the invention in your country, or can the application be filed by a person who does not possess rights in the invention (a "disentitled" applicant), for example, a local subsidiary company or a person possessing only the right to claim priority in your country.
- (b) In such circumstances, (i) can the disentitled applicant obtain rights to the invention at a later date (i.e. after filing the Later application) so as to become entitled to be granted



- the patent, and/or (ii) can the disentitled applicant later transfer/assign the Later application to the person possessing rights in the invention (the "entitled" person) in your country so that entitled person can be granted the patent?
- (c) What is the legal basis for your answers?
5. (a) In your country is there any legislation or case law which clarifies whether or not the right to claim priority exists as a separate right from the rights in the Priority application itself, and/or separate from the rights in the invention?
- (b) For your local applicants who have filed a local Priority application in your country, is it possible for the original local applicant to separately assign priority rights in the foreign countries to party A, rights in the local Priority application to party B, and rights in the invention itself to party C?
- (c) In these circumstances could party B obtain a patent in your country without first obtaining rights to the invention from party C?
- (d) If not, would there be any difficulty having party C assign rights to the invention to party B at a later stage, after expiry of the priority period, so that a patent could be obtained in your country, or at least exploited in your country, by party B?
- (e) Please explain the legal basis for your answers.
6. (a) Is it possible for a foreign applicant possessing the right to claim priority from a foreign Priority application to file a Later application in your country in circumstances where that foreign applicant does not, at the same time, possess rights in the invention itself?
- (b) In such circumstances could the foreign applicant obtain the grant of a patent in your country without obtaining rights in the invention?
- (c) Would it be necessary (and possible) for the foreign applicant to obtain rights in the invention in your country at a later stage in order to obtain the grant of a patent?
- (d) What is the legal basis for your answers?
7. (a) Is it possible for a foreign applicant possessing rights to the invention to file a Later application in your country in circumstances where that foreign applicant does not, at the same time, possess the right to claim priority from the Priority application?
- (b) In such circumstances is there any way that the foreign applicant could obtain the grant of a patent in your country with a valid priority claim?
- (c) Could the foreign applicant obtain the right to claim priority
- (i) after the Later application is filed in your country and before the priority period has expired, and
- (ii) after the Later application is filed in your country and after the priority period has expired?





- (d) What is the legal basis for your answers?
8. (a) Is it possible for the applicant of a foreign Priority application who does not possess the right to claim priority from the application in your country (e.g. where that right has been assigned to someone else) nonetheless file a Later application in your country claiming priority from the Priority application?
- (b) In such circumstances could the applicant obtain a patent in your country with a valid priority claim?
- (c) For example, could the applicant, after filing the Later application in your country and after expiry of the priority period, obtain the right to claim priority, such as through a retroactive assignment?
- (d) What is the legal basis for your answers?
9. (a) Where a foreign Priority application filed in respect of a single invention, trade mark or design names two applicants, is it possible for only one of those applicants to file an application in your country claiming priority from the jointly filed Priority application without obtaining priority rights from the other applicant? In other words, is the "applicant" for the purpose of assessing priority rights the two applicants jointly, or is each applicant equally entitled to claim, for himself or herself alone, priority in your country from the joint Priority application?
- (b) Please explain your answer with reference to legislation and/or case law.
10. (a) Where a Priority application is filed in the name of two independent inventors A and B as applicants, does each inventor/applicant have the right to transfer his or her share or part of the priority right to a third party of his own choosing (say inventor a assigns to company A and inventor b assigns to company B), such that a Later application can be validly filed by company A and company B jointly?
- (b) Or, is the priority right a right which is held/owned jointly by the two inventors/applicants, and which can only be transferred to the two companies jointly by the two inventors/applicants?
- (c) If so, are there any conditions which would apply to such a transfer of priority rights?
- (d) Please provide the legal basis for your answers.
11. (a) In your country, would a provision included in an employment contract purporting to transfer priority rights in any applications filed by or on behalf of the inventor during the period of employment to the employer be recognized as effective in transferring priority rights to the employer?
- (b) If so, would this be limited to the situation where the employee is the only inventor/applicant of the Priority application?
12. (a) In your country would (i) a provision in an employment contract transferring ownership of an invention to the employer, or (ii) an operation of law that vests with the employer



ownership of inventions made by an employee, be also recognized as effective in transferring priority rights to the employer in circumstances where a Priority application is filed by the employee, or filed jointly by more than one employee?

- (b) Please provide the legal basis for your answers.
13. (a) Where two inventors having different employment contracts jointly file a Priority application in their own names, could provisions in those employment contracts dealing with transfer of priority rights be effective in transferring priority rights to the employer or employers of the inventors?
- (b) If so, how can this be reconciled in circumstances where the priority right is indivisible and enjoyed by the two inventors jointly, and where the employment contracts only refer to individual rights?
- (c) Please explain the legal basis for your answers.
14. (a) In determining whether the right to claim priority has been transferred to the applicant in your country, which law is applicable? Before answering this question it may be informative to read the article by T. Breimi entitled "Traps when transferring priority rights" published in the March 2010 edition of epi Information available on the epi website: [www.patentepi.com](http://www.patentepi.com)
- The law of the country where the invention was made? If so, what if the invention is made in two or more countries?
  - The law of the country where the assignment (of priority rights) was signed? If so, what if signed in more than one country?
  - The law of the country specified in the assignment as the country in which it is to be interpreted.
  - The law of the country where the Later application is filed?
  - The law of the country where the Priority application is filed.
  - The law of the country where the assignor is located.
  - The law of the country where the assignee is located.
- (b) Please explain the legal basis for your answers.
15. (a) Where a single Priority application is filed for two inventions, invention A and invention B, naming inventors of both inventions as joint applicants, can two separate Later applications be filed in your country for the separate inventions A and B?
- If so, is a cross-assignment of the priority rights needed, i.e. from inventors of invention A to inventors of invention B and vice versa?



- Or should inventors of respective inventions A and B jointly assign priority rights for invention A to invention A inventor, and priority rights for invention B to the invention B inventor?
- Can a priority right be split between different inventions disclosed in a single application, or does the priority right apply to the whole application as suggested by the wording of Article 4A(1)?
- In the above circumstances, in your country, would it be safer to file a single Later application for inventions A and B, and later divide out the subject matter of one of the inventions into a divisional application?

(b) Please explain the legal basis for your answers.

## PCT APPLICATIONS

In several countries and regions the legislation in relation to priority claims in PCT applications differs from the legislation applicable to claims in applications filed directly under the Paris Convention. The reason for this is that while some countries have provisions which are more lenient than Article 4 of the Paris Convention, particularly in relation to the transfer of priority rights, Article 8 of the PCT specifies that priority claims "shall be as provided in Article 4 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property". If any of the answers provided above in relation to Later Convention applications would be different if applied to a PCT application which has entered national phase in your country, please explain those differences.

*[End of document]*



## ANNEX 2 - Summary of Responses to FICPI Questionnaire regarding Paris Convention Article 4A(1)

Country	Argentina (AR)	Australia (AU)		Austria (AT)	Brazil (BR)	Canada (CA)
Question	Convention Application	Convention Application	PCT Application	Convention Application	Convention Application	Convention Application
<p><b>1</b></p> <p>Has your country adopted the provisions of Article 4A(1) of the Paris Convention into its law, or has your country introduced provisions which differ in language or effect from Article 4A(1)?</p>	<p>Argentina adopted the provisions of Article 4A(1) of the Paris Convention into its law.</p>	<p>Sections 29B, 43 and sch 1 of the Patents Act 1990. Regulations 3.12, and 3.13B define the priority date for a convention application.</p>	<p>Regulations 3.12, and 3.13A define the priority date for a PCT application.</p>	<p>The Paris Convention (PC) is adopted directly in provisions § 95(1) PatG, § 24(1) MaSchG, § 20(1) MuSchG.</p>	<p>Ratification of the Stockholm Revision of the Paris Convention; Article 16 of the Brazilian Industrial Property Law.</p>	<p>Sections 28.1(1), 28.2 and 28.4 of the Patent Act.</p>
<p><b>2</b></p> <p>If the provisions implementing Article 4A(1) in your country differ from the wording of Article 4A(1) of the Paris Convention, such that there is a discrepancy between the two provisions, which provision has legal effect, the provision in your national law or the Paris Convention?</p>	<p>Article 4A(1) of the Paris Convention takes precedence (international treaties enjoy higher hierarchy than national laws).</p>	<p>Local provisions dominate.</p> <p>(see <i>Chiropedic Bedding Pty Ltd v Radburg Pty Ltd</i> [2007] FCA 1869)</p>		<p>N/A since PC is applied directly.</p>	<p>Article 16 is not considered as being in conflict and consequently Article 4A(1) can be considered as having the effects of national law.</p>	<p>Local law has precedent in the event of a conflict.</p>

Country	Argentina (AR)	Australia (AU)		Austria (AT)	Brazil (BR)	Canada (CA)
<p><b>3a</b></p> <p>Does the right to claim priority in your country from an earlier filed Priority application in a foreign country rest solely with the applicant of that earlier filed Priority application?</p>	No	No	No	No	Yes, but it can be assigned (see below).	No
<p><b>3b</b></p> <p>Or can this right to claim priority rest with:</p>						
(i) the successor in title of the Priority application (i.e. the assignee of the Priority application)	Yes	Yes	Unlikely	Yes	No	Yes
(ii) the successor in title to the priority right (i.e. the assignee of the right to claim priority)	Yes	<p>Possibly.</p> <p>The right to file is that of a "Convention applicant". It is sufficient for the applicant to be the assignee of the priority application or entitled to the invention.</p>	<p>Likely that the PCT applicant filing in Australia will need to be the assignee of the priority right prior to filing the PCT application.</p>	Yes	Yes	
(iii) the successor in title of both the Priority application and the priority right	Yes	Yes		Yes	No	
<b>3c</b>						

Country	Argentina (AR)	Australia (AU)	Austria (AT)	Brazil (BR)	Canada (CA)	
Can this right to claim priority extend to other persons:						
(i) Is it sufficient for the person claiming the right of priority to merely have the "consent" of the applicant of the priority application to enable a priority right to be claimed?	The right to claim priority can be assigned to any person. Consent is not sufficient.	Yes, since the applicant would be a Convention applicant.	Likely to be insufficient since definition of Convention applicant does not apply.	No	No, formal assignment is required.	No
(ii) If the right to claim priority can extend beyond the original applicant and the successor in title of the original applicant, please explain the legal basis for this extension of the priority right	The Argentine Civil and Commercial Code provides that, as a principle, any right can be assigned. Art. 19 of the Argentine Patent Act - priority rights can be assigned within 90 days of the filing date.	"Convention applicant" includes a person who has the consent of the original applicant, the assignee, or a person who is entitled to an assignment, or legal representative of any of those persons.	Priority entitlement for a PCT application is governed by Article 8 of the PCT and Article 4 of the Paris Convention.		Article 5 of the law.	
(iii) Can an additional person who does not have any rights in the Priority application be named as an applicant in a Later application filed in your country claiming priority under the Paris Convention:						
(A) where the person contributed patentable subject matter to the Later application	Yes. - Yes, it is sufficient to	Yes - Yes, being named an		N/A	Yes, If applicant of the	Yes



Country	Argentina (AR)	Australia (AU)		Austria (AT)	Brazil (BR)	Canada (CA)
not previously disclosed in the Priority application, or obtained rights to such subject matter? - Is being named as an applicant sufficient for the person to be a patentee? - Can the priority claim in the patent be valid?	enable the additional person to be a patentee and the priority claim in the patent would be valid.	applicant is sufficient.  - Yes, the priority claim will be valid.			priority application is a co-applicant of the later application, then the priority claim would be valid. Otherwise, assignment is required.	
(B) where there is no contribution of patentable subject matter to either application, and no right to claim priority from the Priority application in the country? - Is being named as an applicant (but not having the priority right) sufficient for the person to be a patentee? - Can the priority claim in the patent be valid?	Yes.  - Yes, it is sufficient to enable the additional person to be a patentee and the priority claim in the patent would be valid.	Yes, if the person is assigned a right in the Later application  - Yes  - Yes	An assignment of the priority right is likely to be necessary  - Probably not  - Probably not	N/A	Yes, as for A above.	Yes, assuming that the applicant can acquire rights to the invention.
(C) where there is no contribution of patentable subject matter to either application, and no right to the invention in the country? - Is being named as an applicant (but not having a right to the invention) sufficient for the person to be a patentee for the patent eventually obtained? - Can the priority claim in the patent be valid?	As above for A and B.	Yes  - No, the person needs to be assigned rights in the invention  - Yes, if the patent proceeds to grant		N/A	Yes, as for A above.	No, assuming that the applicant cannot acquire rights to the invention.

Country	Argentina (AR)	Australia (AU)	Austria (AT)	Brazil (BR)	Canada (CA)
(iv) Any other circumstances?		No			N/A
<p><b>4a</b></p> <p>In your country is it necessary (for the purposes of filing an application which will lead to the grant of a patent with a valid priority claim) for the applicant to possess rights in the invention (i.e. the right to obtain a patent) at the time of filing the Later application for the invention in your country?</p>	Not necessary; the right to claim priority suffices.	<p>Depends on whether a person possessing only the right to claim priority in Australia qualifies as a Convention applicant.</p> <p>- If so then such a filing would be possible.</p>	The right to claim priority at the time the PCT application is filed is most important.	No	<p>Rights in the invention are assumed to be possessed by the applicant.</p> <p>Yes, a person must have rights in the invention. A disentitled applicant cannot make an application.</p>
<p><b>4b</b></p> <p>Or if the application is filed by a "disentitled" applicant:</p>					
(i) can the disentitled applicant obtain rights to the invention at a later date (i.e. after filing the Later application) so as to become entitled to be granted the patent?	N/A	Possibly, but not definitely (see 4(b) above).	Yes	Yes	<p>Yes, the rights to the invention may be received by a later assignment.</p> <p>No</p>

Country	Argentina (AR)	Australia (AU)		Austria (AT)	Brazil (BR)	Canada (CA)
(ii) can the disentitled applicant later transfer/assign the Later application to the person possessing rights in the invention (the "entitled" person) in your country so that entitled person can be granted the patent?	N/A	Yes, (before filing) by transfer of the application under s 36.  If the application can be filed, then assignment to an entitled person after filing should be possible.	Yes, should be possible without relying on section 36.	Yes	Yes, but the disentitled applicant would first need to receive rights via assignment (as in (i) above) to assign all his rights back to the entitled person.	No