



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) 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
- 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?



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- 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]