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## FICPI Study of Multiple and Partial Priorities – Paris Convention Virtual ExCo Meeting, 19 May 2021

*Drawn up by:*

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### Background

Multiple and partial priorities are provided for in Article 4F of the Paris Convention. Multiple priorities exist when a patent application claims priority from more than one earlier filed application in one or more foreign countries. Partial priority exists where only some of the subject matter of the invention claimed is disclosed in an earlier filed patent application in a foreign country from which priority is claimed. Since, recognition of multiple and partial priorities is a requirement of the Paris Convention it is expected that most, if not all, countries and regions would recognise multiple and partial priorities.

As a result of the circumstances leading to the 2016 decision of the Enlarged Board of Appeal of the EPO in G1/15, there was concern within CET-3 that some countries may not fully recognise multiple and partial priorities within a single claim.

Prior to G1/15, claims in European patents or patent applications that relied on multiple or partial priorities were vulnerable to anticipation by their European priority applications (so called “poisonous priority”) or by their divisional or parent European applications (so called “poisonous divisionals”). Unless the subject matter of the claim was clearly partitioned so that the subject matters derived from the or each priority application were expressed as clearly defined alternatives, the whole claim would be accorded the priority date of the first filing that disclosed all of its subject matter. Since any European priority application, divisional or parent application is likely to contain disclosure of subject matter within the claim under consideration that, if claimed in the cited priority application divisional or parent, would be entitled to an earlier priority date than the priority date of the claim under consideration, that claim would be considered anticipated by application of whole of contents novelty.

While G1/15 resolved this problem for applications filed under the European Patent Convention, CET-3 decided to carry out a study to ascertain if there were any other countries where multiple and partial priorities in a single claim are not fully recognised. Not only can a failure to fully recognise multiple and partial priorities give rise to poisonous priority and poisonous divisionals, but it can also have the result that claims can be anticipated by the publication of subject matter by third parties that occur after that same subject matter is



disclosed in a priority application filed by the applicant or patentee. This consequence seems to be contrary to the provisions, and certainly the intention, of Article 4B of the Paris Convention which describes the effect of a priority claim in the following words:

*“Consequently, any subsequent filing in any of the other countries of the Union before the expiration of the periods referred to above shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the invention, (...) and such acts cannot give rise to any third-party right or any right of personal possession.”*

An additional consequence of failing to fully recognise multiple and partial priorities in a single claim is in relation to the identification of the “first” application referred to in Article 4C(2) of the Paris Convention, which is the starting point for the priority period. If the earlier priority filing is not sufficient to accord priority to any subject matter claimed in a claim of the application or patent, then it is unlikely to be considered the “first” filing for the purpose of calculating the 12 month priority period. However, if the claim is split so that subject matter from the earliest priority application is in a single claim, then the 12 month priority period will likely start from the filing of the earliest priority application.

### The Study

In order to identify countries that fail to fully recognise multiple and partial priorities within a single claim it was decided to send a questionnaire to the various country delegates of FICPI. The questionnaire set out some background to the study and asked questions in relation to two scenarios. The first scenario related to partial priority where the number of alternatives was increased between filing the priority application and filing the national application. The second scenario related to multiple priorities where a range disclosed in a first priority application was expanded in a second priority application. A copy of the questionnaire is attached as Annex 1.

The questions were designed to highlight any complications that may arise in fully recognising multiple and partial priorities in a single claim. Although the questionnaire focussed on Article 4F of the Paris Convention, it was also hoped that the answers provided to the questions would provide insight into the way multiple and partial priorities are treated when priority is claimed from an earlier application filed in or for the same country, and elucidate any potential for poisonous priority. In view of the language used in the questionnaire, and the fact that some of the terms used meant different things to different people, some respondents had difficulty providing the information needed for the study. Accordingly, the initial replies were reviewed and, where necessary, further information and clarification was obtained. The 35 countries from which answers were obtained were Argentina, Australia, Austria, Brazil, Canada, Chile, China, Columbia, Czech Republic, Denmark, Ecuador, Finland, France, Germany, Greece, Ireland, Israel, India, Italy, Japan, Mexico, The Netherlands, New Zealand, Norway, Portugal, Romania, Singapore, South Africa, South Korea, Spain, Sweden, Switzerland, Turkey, United Kingdom, and the United States of America.



## Summary of Results

Most countries surveyed fully recognise multiple and partial priorities within a single claim, and that the “first” application for the purpose of calculating the 12 month priority period is the first application disclosing subject matter included within any of the claims. However, there were exceptions.

The countries that do not fully recognise multiple and partial priorities within a single claim are **Australia, New Zealand, Canada, China, India and United States of America.**

Of these, the United States and Canada have protection against self-collision, which means that poisonous priority and poisonous divisionals cannot arise. While Canada has a provision that allows multiple and partial priorities to be recognised within a single claim when the subject matter is claimed as alternatives, multiple and partial priorities do not appear to be recognised where the alternatives are not clearly defined, or as in the case of scenario 2 of the questionnaire, where the claim includes ranges that have been expanded. In both Canada and the United States, full advantage of multiple and partial priorities can be obtained by splitting the subject matter into separate claims that do not rely on multiple and partial priorities. Identification of the “first” application relevant for calculating the 12 month priority period is likely to depend on whether the claims are split in this manner.

Like the United States, New Zealand law does recognise multiple and partial priorities in a single claim. However, unlike the United States, there is no protection against self-collision. Accordingly, New Zealand law is highly likely to give rise to poisonous priority and poisonous divisionals. In order to obtain any advantage from multiple and partial priorities in New Zealand it is necessary to split the claims into separate claims that do not rely on multiple and partial priorities. Identification of the “first” application relevant for calculating the 12 month priority period could depend on whether the claims are split in this way.

This problem has been recognised in New Zealand, but instead of amending the law to provide full recognition of multiple and partial priorities, there is a proposal to introduce a provision to provide protection against self-collision. If this is done, the situation in New Zealand will be similar to the situation in the United States where claim splitting is required to obtain full advantage of multiple and partial priorities.

The law in India seems to be similar to the law in New Zealand, in that there is no provision that allows a single claim to enjoy more than one priority date. However, in place of the whole of contents novelty approach applied in New Zealand, India applies a prior claiming test to avoid double patenting. There is also no clear protection against self-collision in India. While it seems theoretically possible for poisonous priority and poisonous divisionals to exist in India, the limitations on filing divisional applications (which are restricted to ‘distinct’ subject matter) together with the prior claiming approach to avoiding double patenting might preclude poisonous divisionals. However, in order to obtain full advantage of multiple and partial priorities in India it is necessary to split the claims. Identification of the “first” application relevant for calculating the 12 month priority period could depend on whether the claims are split in this way.



The situation in China is similar to the situation in Canada, in that there appears to be some recognition of multiple and partial priorities when the subject matter is claimed as alternatives. However, in China there is no protection against self-collision. Accordingly, it is possible in China for poisonous priority and poisonous divisionals to exist. In fact, in 2019 there was a decision of the Chinese Supreme Court where a Chinese application was held to be anticipated by its Chinese priority application in circumstances where ranges were expanded in the patent relative to its Chinese priority application. Accordingly, unless the claim has clear alternatives, in order to obtain full advantage of multiple and partial priorities in China it is necessary to claim the subject matter in separate claims (by splitting if necessary) that do not rely on multiple and partial priorities. Identification of the “first” application relevant for calculating the 12 month priority period will likely depend on whether the claims are split in this way.

The situation in Australia is very similar to China. Although Australian patent law includes a provision that allows a single claim to enjoy more than one priority date, a decision of the Federal Court of Australia has interpreted this provision as only applying when the claim defines the subject matter in the form of clear alternatives. According to this decision, the claims of a particular patent were considered to be anticipated by a co-pending application filed by the patentee on the same day and claiming the same priority. Accordingly, poisonous priority and poisonous divisionals can exist in Australia where claims are not drafted in a way that defines clear alternatives. The first application for the purpose of calculating the 12 month priority period will be the first application disclosing subject matter encompassed by the claim, and for which priority entitlement is recognised. However, unlike most other countries, the test for priority in Australia is an enablement test rather than a support test. Since the new priority provisions were introduced in 2013, there is little case law to assist in identifying the first application for the purposes of setting the 12 month priority period.

### Detailed Responses to Questionnaire

**Europe** (Austria, Czech Republic, Denmark, Finland, France, Germany, Greece, Ireland, Italy, The Netherlands, Norway, Portugal, Romania, Spain, Sweden, Switzerland, Turkey, United Kingdom)

The European countries, and certainly the contracting states of the EPC, traditionally consider that clear alternatives in one claim can have different (priority) dates. This practice derives from Article 88(2), second sentence, which states: “*Where appropriate, multiple priorities may be claimed for any one claim.*”

In addition, the European countries either already follow or are likely to follow G 1/15, ruling that a claim covering embodiments that are entitled to a priority date as well as embodiments entitled to a later (priority) date is entitled to the different (priority) dates even where the claim does not describe explicit alternatives. This protects an application or patent from anticipation by later filed patent applications and later published disclosures teaching the subject matter in the priority document from which priority is validly claimed. However it is important to note that a disclosure occurring prior to the date to which part of the claim is entitled may be detrimental to the patentability of (that part of) the claim, and hence the claim itself may be considered unpatentable.



## Asia/Middle East (China, India, Israel, Japan, Singapore, South Korea)

In China, if a claim has a reasonable number of explicit alternatives, partial priorities may be recognised in that claim and poisonous priority and poisonous divisional situations will not occur. If a claim has a continuous range (rather than explicit alternatives), or would cover a very high number of possibilities (for example, in case of a chemical Markush type of claim), this could result in what is termed an “integral technical solution” in that claim. In these circumstances the claim to this integral technical solution cannot be (theoretically) split into separate alternatives; and the claim will get the date of the application (either a priority application or the application as filed) where the integral technical solution was disclosed for the first time. Splitting such claims to avoid poisonous priority or poisonous divisionals would only be possible if there is support for the subject matters in the split claims being entitled to their single priority dates.

In India, a claim can only have a single date. When a claim contains subject matter that has, for one part, a fair disclosure in one earlier application and, for another part, a fair disclosure in a second later filed application, that claim in its entirety is only entitled to the date of that second, later filed application. The claim would need to be split in order for the claimed subject matter to be entitled to different (priority) dates.

With regard to potentially poisonous divisionals, a mere disclosure of relevant subject matter in the description of the parent/divisional is not enough – for prior claiming the matter must be the subject of a claim. This is in contrast to the situation where whole of contents novelty applies. Since the claims in parents and divisionals must be distinct, the opportunities for conflict will likely be minimal. Depending on the particular case and the distinctness of the subject matter, there may be circumstances where conflict could occur.

The situation in Singapore, Japan and South Korea is essentially the same. Claims covering alternatives and ranges may be entitled to one or more (priority) dates. While poisonous priorities and poisonous divisionals do not occur, care must always be taken to avoid double patenting.

Although the terms “multiple priority” or “partial priority” do not appear in Israeli patent law, Sections 10(b) and 10(d) do provide for such priority claims. Accordingly it would appear that multiple and partial priorities are fully recognized in Israel.

## North America (Canada, Mexico, United States of America)

In the United States of America, a claim is entitled to a single (priority) date. The effective date of a claimed invention is determined on a claim-by-claim basis (MPEP § 2152.01). Other than possible double patenting rejections, there is protection against self-collision. Claim splitting is likely to be necessary to obtain full advantage of multiple and partial priorities.

In Canada, there is a provision (section 27(5) of the Canadian Patents Act) that allows explicit alternatives in a claim to have their own priority date.

However, difficulties may arise when a claim refers to a range rather than alternatives. In such a case it would appear that section 27(5) cannot be used to attach different priority dates to



the different parts of the range that is claimed. As a result, the whole claim gets a (priority) date from the first application mentioning the specific range. This may result in the claim lacking novelty over an earlier published document teaching a single value in or a sub-range even where that single value or sub-range was disclosed in a priority application filed prior to the publication. This result may be avoided if the range in that claim is split into sub-ranges as alternatives; then each sub-range might get its own (priority) date. In that case, each sub range will be novel and the whole claim will be considered novel. Alternatively, that original claim may also be split into a number of claims, each claiming a sub-range having its own (priority) date.

Mexico fully recognizes the concepts of multiple and partial priorities.

### **South America (Argentina, Brazil, Chile, Columbia, Ecuador)**

In Argentina, Brazil, Chile, Columbia and Ecuador, a claim may be entitled to two or more (priority) dates. It does not matter, whether such a claim gives clear alternatives or refers to a range. In addition, poisonous priorities and poisonous divisionals do not occur.

### **Australia/New Zealand**

Australian patent law includes a provision that allows a single claim to enjoy more than one priority date, a decision of the Federal Court of Australia has interpreted this provision as only applying to claims that are expressed as clear alternatives. According to this decision, the claims of a patent were considered to be anticipated by a co-pending application filed by the patentee on the same day and claiming the same priority. Accordingly, poisonous priority and poisonous divisionals can exist in Australia where claims are not drafted in a way that defines clear alternatives. The first application for the purpose of calculating the 12 month priority period will be the first application disclosing subject matter encompassed by the claim, and for which priority entitlement is recognised. However, unlike most other countries the test for priority in Australia is an enablement test, rather than a support test. Since the new priority provisions were introduced in 2013, there is little case law to assist in identifying the first application for the purposes of setting the 12 month priority period.

There is no recognition in New Zealand of multiple or partial priorities within a single claim, and claim splitting is required in order to take advantage of multiple and partial priorities. Partial priority can be a complicated issue, especially in circumstances where the alternative embodiments having different priority dates cannot easily or succinctly be expressed separately and clearly.

Under section 60(2) of the Patents Act 2013, the priority date of a claim in a Convention application is the date of the basic application that disclosed the matter that supports the claim (or, if there is more than one such basic application, the date of the earliest of them). If an earlier patent application does not fully support the claim in a New Zealand patent application, it does not provide a priority date for this New Zealand patent application and, hence, can be disregarded for the purposes of calculating the 12 month priority period.



## South Africa

In South Africa, claims covering alternatives and ranges may be entitled to one or more (priority) dates. Poisonous priorities and poisonous divisionals do not occur.

In South Africa, where priority is claimed from two prior applications in a Convention country and the invention claimed in the (South African) application is fairly based on matter disclosed in one or more of any such prior applications, the priority date of the claims shall be the date of lodging of the earliest of such prior applications in which that matter was disclosed in so far as it is fairly based on such earliest application. The 12 month priority period will be calculated from the filing date the earliest application providing fair basis for all or part of such a claim.

## Recommendations

Ideally, the laws relating to the recognition of multiple and partial priorities in Australia, New Zealand, Canada, China, India and the United States would be amended to provide full recognition of multiple and partial priorities in a single claim. Since this is unlikely to occur in the short term, applicants and their IP advisors should be careful in these jurisdictions and consider claim splitting in order to gain full advantage of multiple and partial priorities. In view of the severe consequences of poisonous priority and poisonous divisionals, it would seem equitable to provide applicants and patentees an opportunity to split claims after acceptance or grant, and even during opposition or a revocation/invalidation action, in order to restore priority entitlement. The same opportunity should also be afforded to applicants and patentees who need to rely on multiple or partial priorities that come to light after acceptance or grant.

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CET 3 Questionnaire on  
Multiple and Partial Priorities

## Annex 1 Questionnaire on multiple and partial priorities

### Purpose:

The main purpose of this questionnaire is to ascertain how your country or region treats multiple or partial priority claims as provided for in Article 4F of the Paris Convention.

### Background:

Multiple priorities exist when a patent application claims priority from more than one earlier filed application in one or more foreign countries. Partial priority occurs where only some of the subject matter of the invention is disclosed in an earlier filed patent application in a foreign country, from which priority is claimed.

This questionnaire seeks to ascertain how multiple priorities, and partial priority, are assessed in your country or region.

The questionnaire also seeks to ascertain how the “first” application from which the 12-month priority period is identified in your country or region, and whether any publication of an invention occurring in the priority period can invalidate a claim directed to that invention in circumstances where the subject matter published was wholly contained within the first application from which priority is claimed.

To assist you in answering the questionnaire we set out below Articles 4A(1), 4B, 4F and 4C(1) and (2) of the Paris Convention:

**4A(1)** *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 trade mark, 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.*

**4B** *Consequently, any subsequent filing in any of the other countries of the Union before the expiration of the periods referred to above shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the invention, (...) and such acts cannot give rise to any third-party right or any right of personal possession.*

**4C(1)** *The periods of priority referred to above shall be twelve months for patents and utility models, and six months for industrial designs and trademarks.*

**4C(2)** *These periods shall start from the date of filing of the first application; the day of filing shall not be included in the period.*

**4F** *No country of the Union may refuse a priority or a patent application on the ground that the applicant claims multiple priorities, even if they originate in different countries, or on the ground that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed, provided that, in both cases, there is unity of invention within the meaning of the law of the country.*

*With respect to the elements not included in the application or applications whose priority is claimed, the filing of the subsequent application shall give rise to a right of priority under ordinary conditions.*

In essence the questionnaire seeks to ascertain how your country or region has implemented these provisions of the Paris Convention.





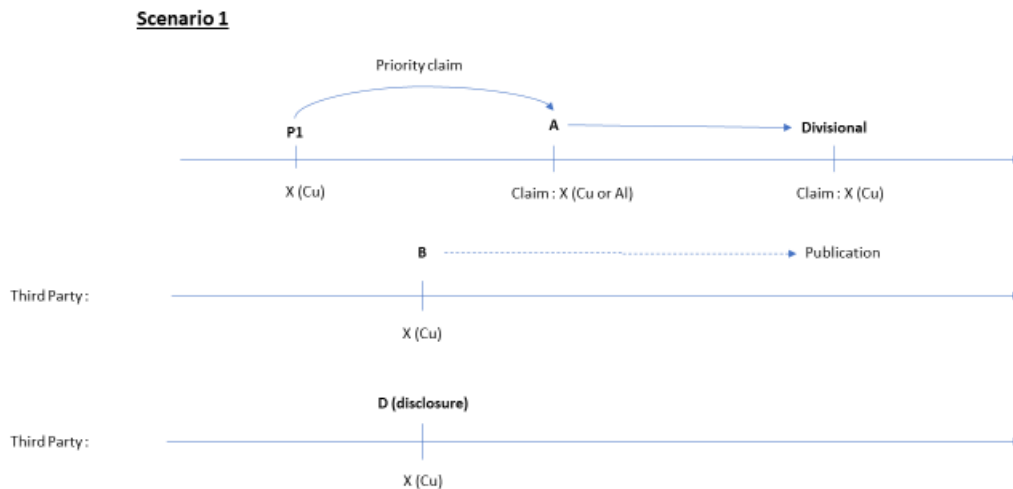
## Questions:

In the scenarios below assume that P1 and P2 refer to “priority” setting patent applications filed in a foreign country, and that P1 was pending when P2 was filed.

### Scenario 1 Partial priority (alternatives)

**P1 discloses widget X with component Y composed of copper.**

**Application A is filed in your country (claiming priority from P1) and has a claim to widget X with component Y composed of copper or aluminium.**



- 1) Which of the following correctly describes the priority entitlement of the claim in Application A?
  - a) The claim is entitled to a single priority date - the date of filing of P1.
  - b) The claim is entitled to a single priority date - the date of filing of Application A.
  - c) The claim is entitled to two priority dates - the date of filing of P1 in so far as claim encompasses widget X with component Y composed of copper and the date of filing of application A in so far as the claim encompasses widget X with component Y composed of aluminium.
  - d) Other – please explain and identify the relevant legal provisions.
- 2) If the claim is only entitled to the date of filing of Application A, could the priority claim to P1 be restored by splitting the claim into two separate claims, one directed to widget X with component Y composed of copper and the other directed to widget X with component Y composed of aluminium (assuming unity is acknowledged)?
- 3) If the applicant files a divisional of application A to pursue a narrower claim to widget X with component Y composed of copper, can the filing of the divisional conflict in any way with the claim in Application A?
- 4) If the answer to question 3) is yes, do any of the following apply?



- a) The divisional will be considered to be “secret” prior art against the claim because the claim encompasses widget X with component Y composed of copper, and the claim to such a widget in the divisional will enjoy an earlier priority date, the date of filing of P1.
  - b) The divisional will be considered to be “secret” prior art against the claim because the claim encompasses widget X with component Y composed of copper, and such a widget is disclosed in the divisional. [In other words, the disclosure of the widget in the divisional is enough to give rise to “secret” prior art, and this disclosure does not have to be the subject of a claim]
  - c) The conflict occurs for other reasons - please explain and identify the relevant legal provisions.
  - d) The divisional will no longer conflict if the claim in Application A is split into two separate claims, one directed to widget X with component Y composed of copper (with priority claim to P1) and the other directed to widget X with component Y composed of aluminium (assuming unity is acknowledged).
- 5) If the answer to question 3) is no, is this because:
- a) The claim in application A enjoys partial priority to P1 in respect of widget X with component Y composed of copper.
  - b) There is protection against self-collision. If so, please explain and identify the relevant legal provisions.
  - c) Other reason – please explain and identify the relevant legal provisions.
- 6) If a third party files Application B between the filing dates of P1 and Application A disclosing and claiming widget X with component Y composed of copper, and Application B is not yet published at the date of filing of Application A: is Application B citable, *i.e.* novelty destroying, against the claim in Application A?
- 7) If the answer to question 6) is yes, do any of the following apply? In your answer please identify the relevant legal provisions, and explain how they operate.
- a) Application B will be considered to be “secret” prior art against the claim of Application A, because this claim encompasses widget X with component Y composed of copper, and the claim in Application A does not enjoy a priority date earlier than the date of filing Application B.
  - b) Application B will be considered to be “secret” prior art against the claim because the claim encompasses widget X with component Y composed of copper, and such a widget is disclosed in Application B.[ the disclosure of the widget in Application B is enough to give rise to “secret” prior art, and this disclosure does not have to be the subject of a claim ]
  - c) Application B is citable for other reasons - please explain.
  - d) Application B will no longer conflict if the claim in Application A is split into two separate claims, one directed to widget X with component Y composed of copper (with priority claim to P1) and the other directed to widget X with component Y composed of aluminium (assuming unity is acknowledged).
- 8) If the answer to question 6) is no, is this because:
- a) The claim enjoys partial priority to P1 in respect of widget X with component Y composed of copper.



- b) Other reason – please explain.
- 9) If a third party independently publishes a document D disclosing widget X with component Y composed of copper between the filing dates of P1 and Application A is that disclosure D citable, *i.e.* novelty destroying, against the claim in Application A?
- 10) If the answer to question 9) is yes, do either of the following apply? In your answer please identify the relevant legal provisions, and explain how they operate.
- a) Document D will be considered to be prior art against the claim because the claim encompasses widget X with component Y composed of copper, and the claim to such a widget in Application A does not enjoy a priority date earlier than the publication date of Document D.
  - b) Document D is citable for other reasons - please explain.
  - c) Document D will no longer be citable for novelty if the claim in Application A is split into two separate claims, one directed to widget X with component Y composed of copper (with priority claim to P1) and the other directed to widget X with component Y composed of aluminium (assuming unity is acknowledged).
  - d) Further in case of such claim splitting Document D will still be citable against the claim resulting from the split and directed to widget X with component Y composed of aluminium for inventive step because the claim directed to widget X with component Y composed of aluminium will have a priority date after publication of Document D. .

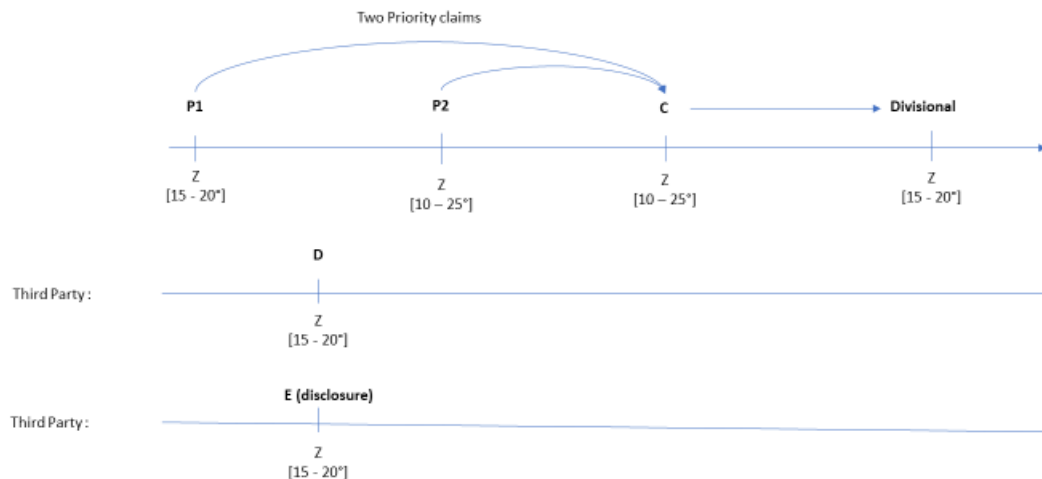
**Scenario 2 Multiple priorities (broadening)**

**P1 discloses process Z carried out within a temperature range of 15-20°C.**

**P2 discloses process Z carried out within a temperature range of 10-25°C.**

**Application C is filed in your country or region (claiming priority from P1 and P2) and has a claim to process Z carried out within a broader temperature range of 10-25°C.**

**Scenario 2**



11) Which of the following correctly describes the priority entitlement of the claim in Application C?

- a) The claim is entitled to a single priority date - the date of filing of P1.
- b) The claim is entitled to a single priority date - the date of filing of P2.
- c) The claim is entitled to two priority dates - the date of filing of P1 in so far as claim encompasses process Z carried out within a temperature range of 15-20°C and the date of filing of application P2 in so far as the claim encompasses process Z carried out within a temperature range of 10 to <15°C and >20 to 25°C.
- d) Other – please explain and identify the relevant legal provisions.

12) If the claim is only entitled to the date of filing of P2, could the priority claim to P1 be restored by splitting the claim into two separate claims, one directed to process Z carried out within a temperature range of 15-20°C and the other directed to process Z carried out within a temperature range of 10 to <15°C and >20 to 25°C. (assuming unity is acknowledged)?

13) If the applicant files a divisional of application C to pursue a narrower claim to process Z carried out within a temperature range of 15-20°C, can the filing of the divisional conflict in any way with the claim in Application C (10-25°C) ?

14) If the answer to question 13) is yes, do any of the following apply?



- a) The divisional will be considered to be “secret” prior art against the claim because the claim encompasses process Z carried out within a temperature range of 15-20°C, and the claim to such a process in the divisional will enjoy an earlier priority date, the date of filing of P1.
- b) The divisional will be considered to be “secret” prior art against the claim because the claim encompasses process Z carried out within a temperature range of 15-20°C, and the such a process is disclosed in the divisional. [In other words, the disclosure of the process in the divisional is enough to give rise to “secret” prior art, and this disclosure does not have to be the subject of a claim]
- c) The conflict occurs for other reasons - please explain and identify the relevant legal provisions.
- d) The divisional will no longer conflict if the claim in Application C is split into two separate claims, one directed to process Z carried out within a temperature range of 15-20°C and the other directed to process Z carried out within a temperature range of 10 to <15°C and >20 to 25°C. (assuming unity is acknowledged).

15) If the answer to question 13) is no, is this because:

- a) The claim enjoys partial priority to P1 in respect of process Z carried out within a temperature range of 15-20°C.
- b) There is protection against self-collision. If so, please explain and identify the relevant legal provisions.
- c) Other reason – please explain and identify the relevant legal provisions.

16) If a third party files Application D between the filing dates of P1 and P2 disclosing and claiming process Z carried out within a temperature range of 15-20°C, is Application D citable against the claim in Application C?

17) If the answer to question 16) is yes, do any of the following apply?

- a) Application D will be considered to be “secret” prior art against the claim because the claim encompasses process Z carried out within a temperature range of 15-20°C, and the claim in Application C will not enjoy a priority date earlier than the filing date of Application D.
- b) Application D will be considered to be “secret” prior art against the claim because the claim encompasses process Z carried out within a temperature range of 15-20°C, and such a process is disclosed in Application D. [In other words, is disclosure of the process in Application D is enough to give rise to “secret” prior art, and this disclosure does not have to be the subject of a claim]
- c) Application D is citable for other reasons - please explain and identify the relevant legal provisions.
- d) Application D will no longer conflict if the claim in Application C is split into two separate claims, one directed to process Z carried out within a temperature range of 15-20°C (with priority claim to P1) and the other directed to process Z carried out within a temperature range of 10 to <15°C and >20 to 25°C (assuming unity is acknowledged).

18) If the answer to question 16) is no, is this because:

- a) The claim enjoys partial priority to P1 in respect of process Z carried out within a temperature range of 15-20°C.
- b) Other reason – please explain and identify the relevant legal provisions.



- 19) If a third party independently publishes a document E disclosing process Z carried out within a temperature range of 15-20°C between the filing dates of P1 and P2 is that disclosure citable against the claim in Application C?
- 20) If the answer to question 19) is yes, do either of the following apply?
- a) Document E will be considered to be prior art against the claim because the claim encompasses process Z carried out within a temperature range of 15-20°C, and the claim to such a process in Application C does not enjoy a priority date earlier than the publication date of Document E.
  - b) Document E is citable for other reasons - please explain and identify the relevant legal provisions.
  - c) Document E will no longer be citable for novelty if the claim in Application A is split into two separate claims, one directed to process Z carried out within a temperature range of 15-20°C (with priority claim to P1) and the other directed to process Z carried out within a temperature range of 10 to <15°C and >20 to 25°C (assuming unity is acknowledged).
  - d) Further, in case of such claim splitting Document E will still be citable for inventive step against the claim resulting from the split and directed to process Z carried out within a temperature range of 15-20°C because the claim directed to process Z carried out within a temperature range of 15-20°C will have a priority date after publication of Document D.
- 21) Under the law of your country or region would the applicant be able to validly treat P2 as the first application in respect of process Z carried out within a temperature range of 10-25°C, such that P1 can be disregarded for the purposes of calculating the “fixed” 12 month priority period, or would P1 be regarded as the first application because it discloses part of the subject matter of the claim? In answering this question, please recall that P2 was filed while P1 was pending. Please explain your answer and identify the relevant legal provisions.
- 22) Are there any other aspects of the law in your country or region relating to multiple or partial priorities, or identification of the “first” application for the purposes of setting the 12 month priority period, that you would like to mention?

*[End of document]*