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# Transfer of Priority Rights:

## -FICPI's Guidelines

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- **Article 4A(1) Paris Convention:**
- 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.**

- There has been an increasing number of patents invalidated through loss of entitlement to claim priority, particularly in Europe
- One such mechanism for invalidating a priority claim is to establish that the priority rights were not effectively transferred to the applicant as of the date the priority claim was made – Article 4A(1) Paris Convention
- The problem is particularly pronounced for US applicants who often file provisional applications in the name of the inventors, even post AIA [Section 119(e) uses the following language: “...*a provisional application filed under section 111 (b), by an inventor or inventors named in the provisional application...*”]

- FICPI carried out a study of the laws and practices of the 30+ countries and regions in relation to the transfer of priority rights
- Study commenced with a questionnaire seeking information regarding laws and practices in relation to the transfer of priority rights
- Study produced a guidelines for transferring priority rights and for preparing assignments to increase the likelihood of valid priority claims
- At this stage FICPI does not have a resolution in relation to how Article 4A(1) should be interpreted and applied

# QUESTIONS CONSIDERED

- The general requirements for transferring a priority right from the applicant of the Priority application to another party;
- Whether an applicant who has no rights in the Priority application can be included in a Later application claiming priority from the Priority application;
- Whether the right to claim priority may be treated separately from rights in the invention and rights to the Priority application itself;

# QUESTIONS CONSIDERED

- 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;
- 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;
- Whether employment contracts are effective in transferring priority rights in the case of a single applicant, or multiple applicants with different employment contracts;

# WHICH LAW APPLIES?

- In determining whether the right to claim priority has been transferred to the Convention/PCT applicant, which law is applied?
  - The law of the country where the invention was made? And if so, what if the invention is made in two or more countries?
  - The law in the country where the assignment (of priority rights) was signed? And if so, what if signed in more than one country?
  - The law of the country where the Convention application is made?
  - The law of the country where the Priority application is filed?
  - The law of the country where the assignee, or assignor, is located?
  - See EPI Information March 2010 (T. Breimi "Traps when transferring priority rights")

# MULTIPLE INVENTIONS

- Where a single application is filed for two inventions, A and B, naming inventors of both as applicants, can two Convention applications be filed for the separate inventions A and B?
  - If so, is a cross assignment of the priority rights needed, i.e from inventors of A to inventors of B and vice versa?
  - Or should inventors of A and B jointly assign priority rights for invention A to A inventors, and priority rights for invention B to the B inventors?
  - Can a priority right be split between different inventions disclosed in a single application?
  - Would it be safer to file a single Convention application for inventions A and B, and later divide out the subject matter of one of the inventions?



- 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.

- 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.
- 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.

- 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.

- 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.
- 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).
- 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.

- For multiple inventions (involving different inventors) disclosed in a single Priority application filing a single Later application and 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.
- The guidelines can be found on the FICPI website or <https://dcc.com/patents/guidelines-for-transferring-priority-rights/>

# THANK YOU

## Questions?

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