

Avoiding Failed Patent Application Filings

For:



2023 Annual Convention

By: Rick Neifeld
Neifeld IP Law PLLC



rneifeld@neifeld.com; 703-415-0012; www.Neifeld.com

Professional Responsibility

- Competence, legal and technical. **ABA/VA/PTO**
Rules 1.1/11.101
- Communication, “explain a matter to the extent reasonably necessary to permit the client to make informed decisions regarding the representation.” ABA/VA/PTO Rules
1.4(b)/11.104(b)

Obligations After Harmful Legal Error

- Self Report - The atty must inform the client so the client can “make informed decisions regarding the representation.” ABA/VA/(PTO) rules 1.4/(11.104).
- Withdraw? - Is there a “significant risk that the representation ... will be materially limited ... by a personal interest of the lawyer”? ABA/VA/(PTO) rules 1.7(a)(2)/(11.107).
- Report to malpractice carrier

Outline

- | SLIDE# | TOPIC |
|--------|--------------------------------------|
| • 5 | Filing by the deadline |
| • 19 | Filing the intended disclosure |
| • 50 | Foreign filing (FF) licenses |
| • 57 | Non publication requests |
| • 67 | Securing the Right Of Priority (ROP) |
| • 108 | End |

Filing By The Deadline

Missed Deadlines Are A Big Problem

- 15% of all legal malpractice claims are based upon missed deadlines (thousands of claims in the US annually)*
- 1/500 patent filings miss their deadline**

*Vincent R. Johnson, "The Informed Consent Doctrine in Legal Malpractice Law," 11 St. Mary's J. Legal Mal. & Ethics 362 (2011); and Mark Bassingthwaite, ALPS, private communication (including: failure to calendar; failure to ascertain; failure to react)

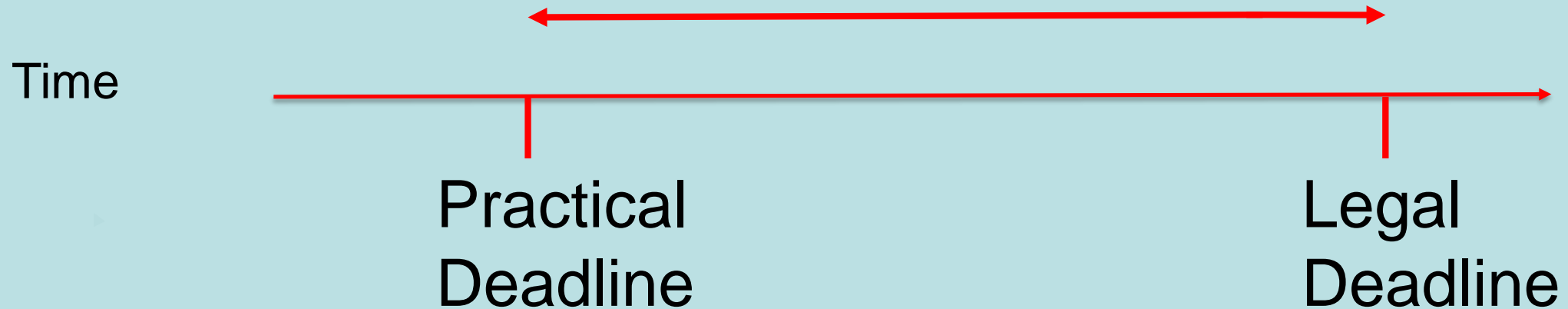
**Application estimates based upon private communications with Michael Richardson, WIPO IB, Charles Pearson, USPTO IPLA, Circa 2017.

Technical Competence – Know Your Limits

- How much time do you need to **ensure** you will meet a deadline?
- What are foreseeable causes of delay?
(Computer malfunction, power failure, network disruption, filing systems glitches, personal illness)
- Unforeseeable causes of delay (Acts of God)

Identify Your Practical Deadline

Time required to **ensure**
you will meet deadline



Client Communications Regarding A Deadline

- The legal deadline
- The consequences of missing the legal deadline
- What the client must do, for you to meet the deadline
- Your practical deadline
- Basis for your practical deadline
- Actions you intend to take

Benefits Of Communications Regarding A Deadline

- Motivates the client to act promptly
- Allow client to make an informed decision about risk/benefit of their delay
- Dispels any implication of contractual limit to liability for malpractice. ABA/VA/PTO Rule 1.8(h)/11.108(h)

Benefits Of Communications Regarding A Deadline

- Implies informed consent to risk of client delay
- Informed consent requires explanation of “risks of and reasonably available alternative....” ABA/PTO Rule 1.0(e)/11.1.
- Informed consent *doctrine* may affect legal malpractice claim elements: duty, standard of care, proximate cause.

Timing Of Communications Regarding A Deadline

- Upon initial inquiry; engagement; initial instructions in specific matter, and reminders
- When risk of loss due to delay arises
- When you assume client decided to abandon
- When you plan to be unavailable
- When rights are lost

Procedures For Communications Regarding A Deadline

- Escalation: confirm receipt; email; alternate emails/representatives; fax; telephone; postal
- Docketing: confirm receipt, reminders (first, second, final); risk of loss arises; assumption of abandonment; loss of rights

Exemplary Language – Engagement Agreement

You should always plan on **sending your instructions as soon as possible**, so that I have time to reliably, and in an orderly manner, act on your instructions.

I advise you to send all instructions via email, and to confirm I timely received your instruction. I will confirm receipt by email.

Exemplary Language – Engagement Agreement

For a **new application filing**, I agree to go forward with the filing, only if you provide the required funds, information, and executed forms to me, **not later than one month prior to any legal deadline** for the application filing. If you do not believe you can comply, seek other counsel.

Exemplary Language – Engagement Agreement

Regarding **ongoing matters** for you that I am handling, I will always make a **best effort** to implement any instruction you provide once I have received your instruction and the required funds for implementing your instruction.

Exemplary Language – Engagement Agreement

However, **computer malfunction, power failure, network disruption, filing systems glitches, and personal illness** are generally beyond my control and could delay my acting after receipt of your instruction. Consequently, there is a **foreseeable risk, which increases as a legal deadline approaches**, that I will not be able to properly act on instructions you send to me within one month of the deadline. That risk rises rapidly from near zero probability at one month prior to the deadline until the deadline.

Exemplary Language – Engagement Agreement

The **consequences** of failing to meet a deadline may be irrevocable loss of all your rights for the application and claims. Therefore, by delaying your instructions (and any required funds therefore) to within one month of any deadline results in a **risk that you will lose all of rights** due to my inability to properly meet the deadline.

Filing The Intended Disclosure

- Procedures for reliable filings
 - Filing wrong application/parts of application
- DOCX filings
 - Understanding DOCX, sufficiently, to safeguard against PTO corruption of the application

Procedures For Filings

- Folder and filename conventions
 - \ClientName**DocketNumber**\Drafts
 - \ClientName\DocketNumber\Final
- Filing list – Identify, in advance, all documents you intend to file.
- Standard check list – (Signatures, internal identification, pages numbered, claim numbering, fonts embedded, etc.)

Pre Filing Final Review

- Comparisons:
 - ✓ Final version to an “original” version
 - ✓ Drawing figure numbers/contents to “Brief Description of Drawings”
 - ✓ Claims to “Summary of The Invention.”
- Specification Completeness
- Paragraph by paragraph or page by page review
- Presence of all pages/page numbers

Post Filing Review

- Download the filing.
- Confirm filing is what you intended.

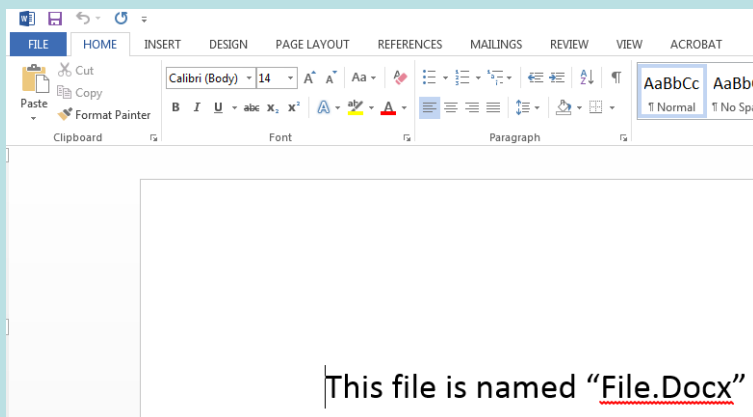
DOCX – Introduction

- PTO allows new application filings of specification, claims, abstracts as either PDF or DOCX files.
- Effective 1/17/2024 PTO will impose a \$400 surcharge for initial filing of specification, claims, abstracts that are **not** filed as DOCX files.
- PTO intends future rules to require DOCX files for follow-on submissions.

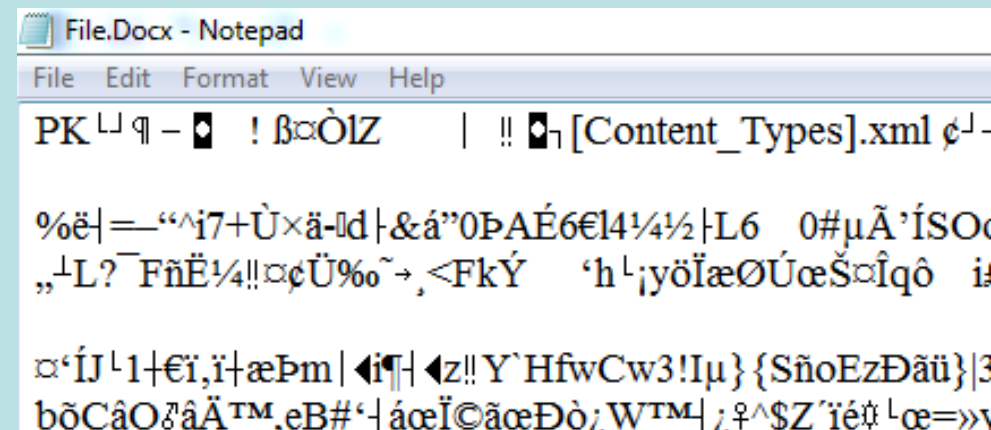
PTO DOCX – Reliability Concerns

- “.docx” is a file extension, not a file format.
- “.docx” does not specify how the file appears on the screen.

“File.docx” opened
with Word 2016



“File.docx” opened with
Notepad



PTO DOCX – Reliability Concerns

- PTO revises your uploaded DOCX before filing.
- You can only file the PTO's revised DOCX file.
- PTO's revised DOCX files may have changed file content.
- PTO does not allow you to rely upon the DOCX file you upload, to correct the record.

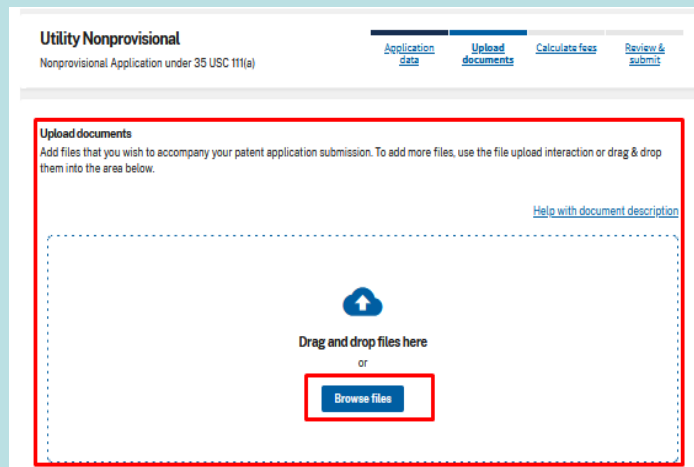
PTO's "Auxiliary PDF"

- Auxiliary PDF – **Your** PDF rendering of **your** DOCX
- PTO agrees to retain an Auxiliary PDF for the life of any patent issuing from the application.
- PTO will entertain a petition to correct the record based upon the Auxiliary PDF.
- Auxiliary PDF filing is only available in PC.
- PC only allows one Auxiliary PDF per submission.

DOCX Filing Best Practice - File An Auxiliary PDF

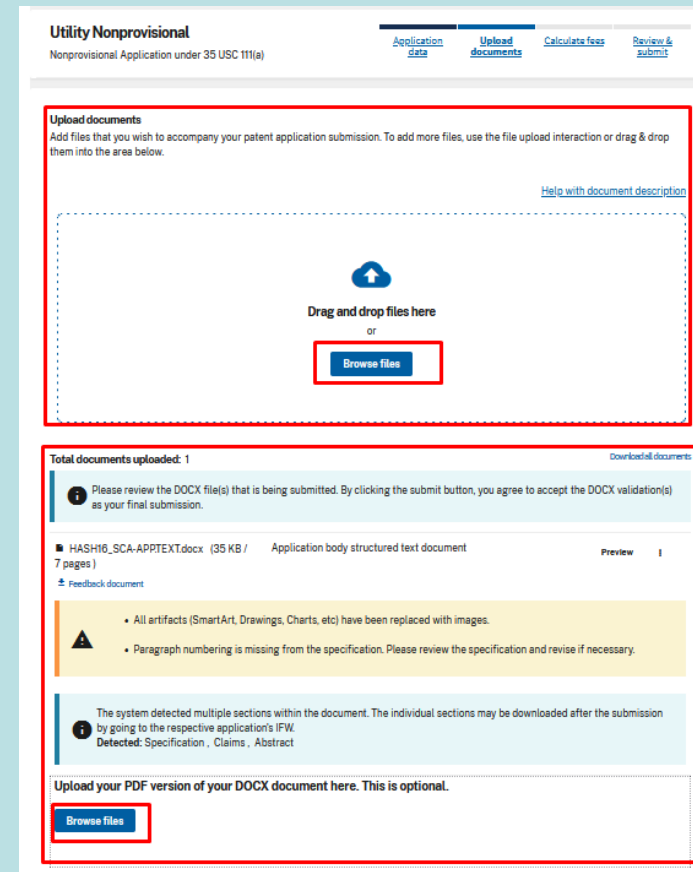
- Prepare a single DOCX containing Spec, Abstract, Claims
- Prepare an Auxiliary PDF from your DOCX
- File using PC (not EFS-Web)
- Upload your DOCX, and then, upload your Auxiliary PDF
- Retain your uploaded Auxiliary PDF

How to File An Auxiliary PDF



DOCX
UPLOAD

Auxiliary PDF
Upload Option
Appears



DOCX Filing Best Practice - Pre Filing Comparison

- Download the **PDF** of the DOCX prepared by PC
- (Do not download the DOCX prepared by PC)
- Compare **that PDF** against your uploaded DOCX.
- Why use **that PDF**? –
- What PDF displays is device/software independent.
- **That PDF** should show you what the PTO sees for the DOCX prepared by PC.

How To Download The PDF Of The DOCX Prepared By PC

The screenshot displays the 'Utility Nonprovisional' application page. At the top, there are navigation tabs: 'Application data', 'Upload documents', 'Calculate fees', and 'Review & submit'. The 'Upload documents' tab is highlighted with a red box. Below the tabs, the 'Upload documents' section contains a 'Drag and drop files here' area with a 'Browse files' button. Below this, the 'Total documents uploaded: 1' section shows a list of documents. The first document is 'HASH16_SCA-APPTXT.docx (35 KB / Application body structured text document (7 pages))'. It has a 'Download all documents' button and a 'Preview' button with a three-dot menu. A yellow warning box indicates that artifacts have been replaced with images and paragraph numbering is missing. At the bottom, there is an option to 'Upload your PDF version of your DOCX document here. This is optional.' with a 'Browse files' button.

“Upload Document” Tab

“Download All Documents”

3 dots drop down menu
across from PC’s “DOCX”
filename

DOCX Filing Best Practice - Retain **Uploaded** “Auxiliary PDF”

- Despite what I said earlier, the PTO does not *really* retain the Auxiliary PDF you upload!
- Do not replace your uploaded Auxiliary PDF with the “AUX.PDF” available in the PTO’s official record for your application.

DOCX Filing Best Practice - Retain Your **Uploaded** “Auxiliary PDF”

- The Electronic Acknowledgement Receipt (“EAR”) shows the name of the Auxiliary PDF you uploaded, and the SHA-512 hash value for the Auxiliary PDF.
- The “AUX.PDF” document in your application’s “Documents & transaction history” tab has a **different filename** and a **different SHA-512** hash value.

EAR's "Digest" Shows "Auxiliary PDF" Filename And SHA-512 Hash Value

Digest

DOCUMENT

MESSAGE DIGEST (SHA-512)

HASH19_ADS.pdf

F5D3D11F878F8CDF9EA5E82C4761ED8A40931CEB4C44081082698C58
456208E05F4D0705FEAEA04AF8D83C85B6975823DF0F5F32D53CF75
9E75E6D0077476284

HASH19_SCA-APP.TEXT.docx

D508243C7460F3D44B95883665E818FE6ABD00A446C0AC9DEA66E10
7E54F9247DC6ED3AFE357F547B0B493A78E8C242F8DC846B34426DC
3C18D9D33532C602CD

HASH19_SCA.pdf

227F131446A1BD34E713328C11371D06EE0622DAD7ED8FFDAF6B31C437
101B3C5E01CB5C18D776F95099B19FA8CB8C85E9FF8AAE5604CDF615D
5549B282BC2F2

Auxiliary PDF

Auxiliary PDF SHA-512 hash value starts "227F1...."

Uploaded “Auxiliary PDF” Has Same SHA-512 Hash Value

The screenshot shows the Hash Tool 1.2 application window. The interface includes a menu bar with 'File', 'Options', and 'About'. Below the menu is a toolbar with a green circular icon containing a white '#' and a 'Select File(s)...' button. The main area is divided into two sections: 'Input File(s)' and 'Hash type'. The 'Input File(s)' section contains the text 'Select file(s) or drag from Windows Explorer'. The 'Hash type' section has a dropdown menu set to 'SHA-512'. Below these is a green 'Results' section. At the top of the results section, it says 'Last file hash: 227F131446A1BD34E713328C11371D06EE0622DAD7ED8FFDAF6B31C437101B3C5E01CB5C18D776F95099B19FA8CB8C8'. A 'Copy' button is next to this text. Below the 'Last file hash' text, a table displays the hash and filename. The first row shows the hash '227F131446A1BD34E713328C11371D06EE0622DAD7ED8FFDAF6B31C437101B3C5E01CB5C18D776F95099B19FA8CB8C85E9FF8AAE5604CDF615D5549B282BC2F2' and the filename 'C:\HASH19_SCA.pdf'. A red box highlights the first few characters of the hash, and three red arrows point from text annotations below to these elements.

| Input File(s) | Hash type |
|--|-------------------|
| Select file(s) or drag from Windows Explorer | SHA-512 |
| Results | |
| Last file hash: 227F131446A1BD34E713328C11371D06EE0622DAD7ED8FFDAF6B31C437101B3C5E01CB5C18D776F95099B19FA8CB8C8 | |
| 227F131446A1BD34E713328C11371D06EE0622DAD7ED8FFDAF6B31C437101B3C5E01CB5C18D776F95099B19FA8CB8C85E9FF8AAE5604CDF615D5549B282BC2F2 | C:\HASH19_SCA.pdf |

SHA-512 hash value of
uploaded Auxiliary PDF also
starts with “227F1....”

SHA-512
function
selected

Auxiliary PDF filename

“Documents & transaction history” Tab Shows “AUX.PDF”

Documents & transaction history

Documents Transactions

None selected

Showing 1 to 7 of 7 entries

| Mail room date | Doc code | Doc description | Pages | | Quick download | |
|----------------|----------|--|-------|-------------------------|--|--------------------------|
| 07/09/2023 | N417 | Electronic Filing System(EFS) Acknowledgment Receipt | 2 | Preview | PDF | <input type="checkbox"/> |
| 07/09/2023 | ADS | Application Data Sheet | 12 | Preview | PDF | <input type="checkbox"/> |
| 07/09/2023 | AUX.PDF | Auxiliary PDF of Application | 7 | Preview | PDF | <input type="checkbox"/> |
| 07/09/2023 | SPEC | Specification | 5 | Preview | PDF / XML / DOCX | <input type="checkbox"/> |
| 07/09/2023 | CLM | Claims | 1 | Preview | XML / DOCX / PDF | <input type="checkbox"/> |
| 07/09/2023 | ABST | Abstract | 1 | Preview | XML / DOCX / PDF | <input type="checkbox"/> |
| 07/10/2023 | APP.TEXT | New Application in Text Format | 7 | | DOCX | <input type="checkbox"/> |

| | |
|---------|------------------------------|
| AUX.PDF | Auxiliary PDF of Application |
|---------|------------------------------|

| |
|---------------------|
| PDF |
|---------------------|

Filename Of Download of “AUX.PDF”

- “AUX.PDF” download



31518_1834916307-09-2023AUX.PDF.PDF

- Download filename format: “[CusNum]_[AppNo]_[DATE]AUX.PDF.PDF”

“AUX.PDF” Has A Different SHA-512 Hash Value

Hash Tool 1.2

File Options About

Input File(s)

Select File(s)...

Select file(s) or drag from Windows Explorer

Hash type

SHA-512

Results

Last file hash: DF8EDAE171D4A4FC6DB1B8986E98C13AF34DEC060083CAEED1AB81225B06B3B92C5109BDAAFD748BB26EBBE5986952D3D73DCDC0AA23AA97169CF538022EFA41 Copy

DF8EDAE171D4A4FC6DB1B8986E98C13AF34DEC060083CAEED1AB81225B06B3B92C5109BDAAFD748BB26EBBE5986952D3D73DCDC0AA23AA97169CF538022EFA41 C:\31518_1834916307-09-2023AUX.PDF

SHA-512 hash value of uploaded “AUX.PDF” starts with “DF8ED....” and not “227F1....”

SHA-512 function selected

AUX.PDF filename

Why Saving Your Auxiliary PDF Is Important

- You cannot use the EAR's hash to show your downloaded copy of the "AUX.PDF" is an authentic copy of what you filed.
- You can only use the EAR's hash to show your file copy of your uploaded "Auxiliary PDF" is authentic.

Background On PDF, DOCX, And Why DOCX Is Unreliable.

- The topics in slides 40-49 are covered in my paper.
- We can skip these slides.

PTO DOCX History 1

- **Filer Files Their MS-DOCX**

| | |
|-----------|---|
| 6/14/2012 | MS-DOCX “Text2PTO” (PTO Presentation) |
| 8/31/2012 | MS-DOCX “Text2PTO” (Director’s Blog Post) |
| 8/2017 | ??-DOCX – EFS-Web enables DOCX filing |
| 9/6/2018 | MS-DOCX – PPAC public hearing |
| 7/31/2019 | (84FR37398) MS-DOCX Proposed Rule |

PTO DOCX History 2

- PTO Files **Their** DOCX

| | |
|------------|---|
| 8/3/2020 | OOXML (85 FR 46932) – Final Rule Effective 1/1/22 |
| 6/2/2021 | DOCX (86 FR 29571) – Evidentiary Change |
| 11/22/2021 | DOCX (86 FR 66192) – Rule Delay to 1/1/23 |

PTO DOCX History 3

- PTO Files **Their** DOCX, But Allows Filer To Also File **Their** “Auxiliary PDF”

| | |
|------------|--|
| 4/28/2022 | DOCX (87 FR 25226) – “AUX.PDF” until 12/31/22 |
| 12/20/2022 | DOCX (87 FR 77812) – “AUX.PDF” until 6/30/23 |
| 12/29/2022 | DOCX (87 FR 80073) – Rule Delay to 4/3/23 |
| 3/27/2023 | DOCX (88 FR 18052) – Rule Delay to 6/30/23 |
| 6/6/2023 | DOCX (88 FR 37036) – “AUX.PDF” extended/revised. |
| 6/6/2023 | DOCX (88 FR 36956) – Rule Delay to 1/17/2024 |

PDF – File Format Standard Specified By ISO 32000

- “enables the description of text and graphics in a **device-independent and resolution-independent manner**”
- “imaging model derived from the PostScript®1 page description language”
- “based on a structured binary **file format** that is optimised [sic] for high performance in interactive viewing.”

What Does The PTO Mean By “DOCX”?

- “DOCX” is not a defined term.
- The PTO Final Rule for DOCX incorrectly claimed that “DOCX” was part of OOXML.
- OOXML is a standard for file formats, including word processing documents.
- OOXML does not include “docx” in the normative part of the specification; merely in examples.
- OOXML does not require a “.docx” file extension

What Is “OOXML” ?

- ECMA-376 (ISO/IEC 29500), Office Open XML, (“**OOXML**”) - Family of file format standards for word processing, spreadsheet, and related.
- OOXML defines an “extension list” that can store “Application-Defined Extension Element[s]”
- OOXML defines a set of “conventions [that] allow XML documents created by applications of later versions or extensions to be handled by applications of earlier versions.” Ignore, replace, etc.
- <https://www.ecma-international.org/publications-and-standards/standards/ecma-376/> Parts 1 and 3.

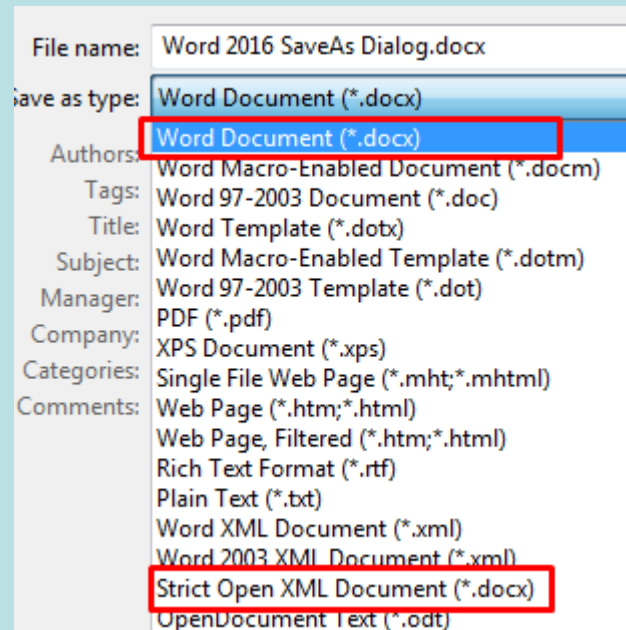
What Is “MS-DOCX”?

- “MS-DOCX” is a file format specification controlled by Microsoft
 - MS Word defaults to saving files in MS-DOCX
 - MS-DOCX = OOXML + “Extensions to” OOXML
 - There have been 49 revisions to MS-DOCX, since it diverged from OOXML circa 2009.
-
- See “[MS-DOCX]: Word Extensions to the Office Open XML (.docx) File Format” at
 - https://learn.microsoft.com/en-us/openspecs/office_standards/ms-docx/b839fe1f-e1ca-4fa6-8c26-5954d0abbccd

What is The Relationship Between MS-DOCX and OOXML?

- MS-DOCX = OOXML + “Extensions to” OOXML
- There have been 49 revisions to MS-DOCX, since it diverged from OOXML circa 2009.

“*.docx” Does Not Identify A Unique File Format



← “Word Document (*.docx)”

← “Strict Open XML Document (*.docx)”

Your “Normal.dotm” file sets your default file save type.
C:\Users\[username]\AppData\Roaming\Microsoft\Templates

DOCX File Format Concerns

- Which of the 50 DOCX file format versions does your word processor use?
- Which of the 50 versions of DOCX file formats does Patent Center use to read and revise your uploaded DOCX?
- What happens when MS-DOCX and OOXML release further updates?

Foreign Filing (FF) Licenses

Foreign Filing (FF) Licenses

- Requirements for FF license
- Penalties for license violation
- Scope of license

FF Requirements and Penalty For Violation

- 35 USC 184: Must wait “**six months** after filing” for “an invention made **in this country**,” or until after you receive a FF license, to FF.
- 35 USC 185: FF license violation results in a bar to a patent for the invention. (“shall not receive a patent for an invention... [and such a patent] shall be invalid.”)
- Bar is to “invention”; not “application.”

In re Gaertner, 604 F. 2d 1348 (CCPA 1979).

FACTS:

- Parent had a FF license
- CIP added only newly disclosed example 6 and corresponding dependent claim 9.
- CIP foreign filed without a FF license.
- “Application” rejected under 185.
- CCPA affirmed the rejection.

In re Gaertner - Reasoning

- Prohibition applies to “any information or ‘subject matter’ not first disclosed to the PTO.”
- “Gaertner's CIP foreign applications did contain technical information or ‘subject matter not previously disclosed.’”

In re Gaertner – Response To Arguments

- Enabling disclosure in parent application, of unlicensed CIP subject matter, not relevant.
- Rejection of all claims was proper (not just claims supported by the unlicensed subject matter).
- No license required for idiomatic formal revisions.

FF License Takeaways

- FF license required prior to FF *any new technical information*.
- Bar to a patent relates to the “invention,” not merely the unlicensed subject matter.

Non Publication Requests

Non Publication Requests

- Requirements for Non Publication
- Right to rescind
- Penalty for violating requirements

Requirements For Non Publication

35 USC 122(b)(2)(B)(i):

“request **upon filing**”

“certifying that *the invention disclosed* in the application *has not and will not* be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing”

Right To Rescind And Notify

35 USC 122(b)(2)(B)(iv) “If an applicant **rescinds** a request made under clause (i) or **notifies** the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published”

What Must Be Published

- **Inventions disclosed** in FF applications must be published.
- “if the invention has previously been the subject of a foreign-filed application, then another application in that family [sic; disclosing that invention] must be published.” *Asghari-Kamrani v. USAA*, 2:15cv478., 220 F. Supp. 3d 707 (EDVA 12/9/2016); affirmed under rule 36, 2017-2504, 2017 (Fed. Cir. 9/11/2018).

Penalty For Not Timely Notifying the Director of FF - Statute

35 USC 122(b)(2)(B)(iii)

- “A failure of the applicant to provide such notice within the **prescribed period** shall result in **the application** being regarded as **abandoned**.”
- Prescribed period – “not later than 45 days after the date of the filing of such foreign or international application”

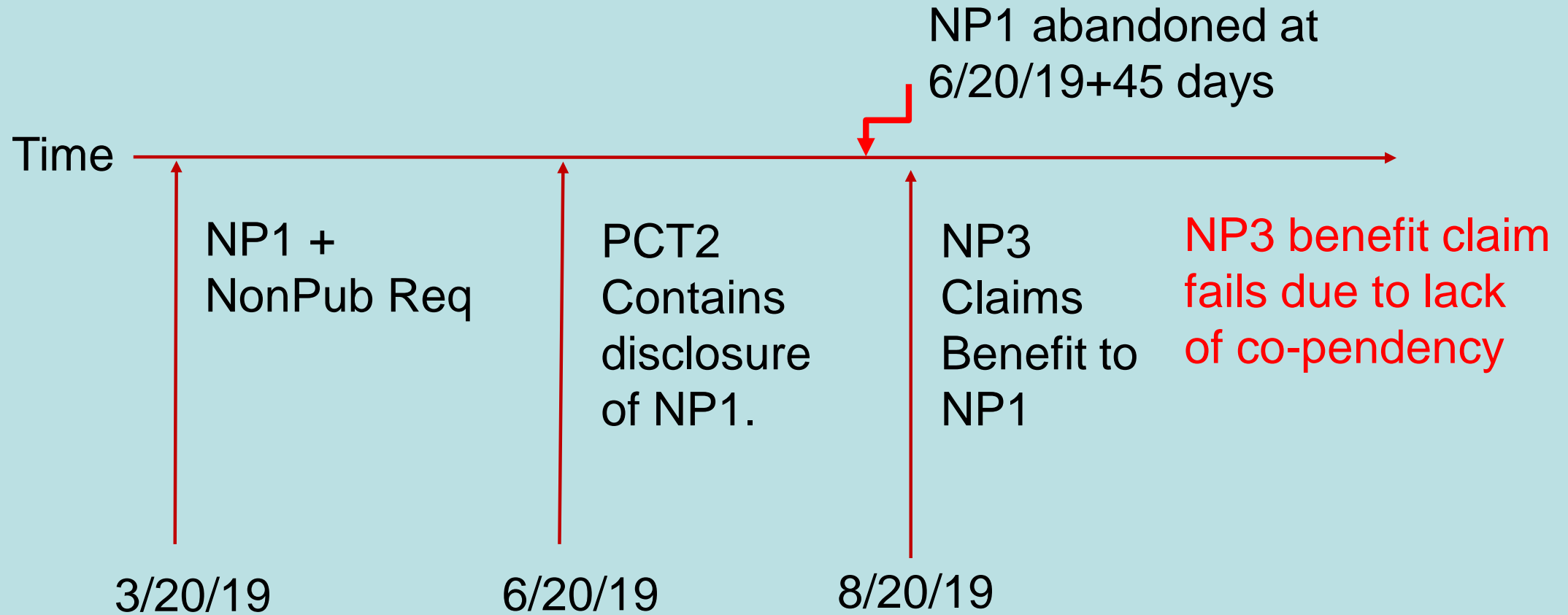
Penalty For Not Timely Notifying the Director of FF - Rule

37 CFR 1.213(c) Failure to timely notify the Office of FF of an application directed to “**the invention disclosed** in” the US application containing the nonpublication request ... shall result in **abandonment of the application** in which the nonpublication request was submitted.”

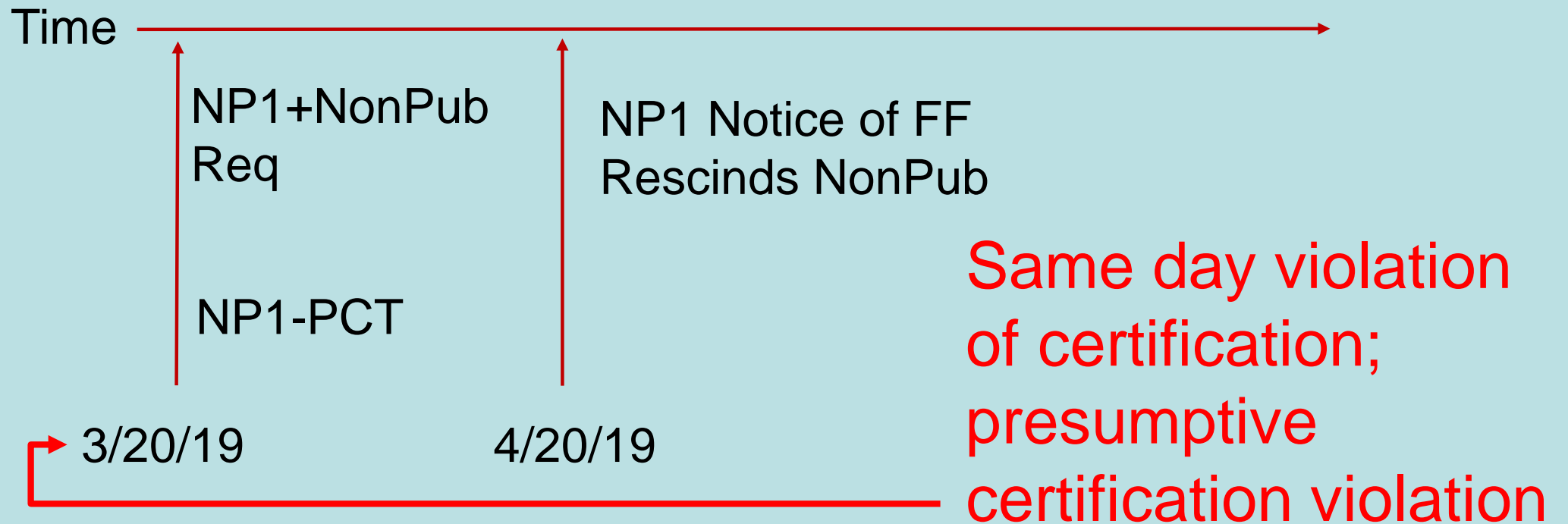
Penalty For Certification Violation

- Not expressly specified by statute or rule
- “The statutory penalty for violating the certification is abandonment of the underlying patent. See 35 U.S.C. § 122(b)(2)(B)(iii).” *Arrow Intern., Inc. v. Spire Biomedical, Inc.*, 06-cv-11564-DPW, 635 F. Supp. 2d 46, 60 (D. Mass 7/10/2009).

Non Publication - Hypo



Non Publication - Hypo



Securing The Right Of Priority (ROP)

Securing The Right Of Priority (ROP)

- What is the ROP?
- What are its requirements?

What is the ROP?

A right to treat disclosure of subject matter in your application that was present in an earlier application as if your application was filed on the date of the earlier application, for purposes of determining patentability.

Paris Article 4 Governs ROP Requirements

- Paris Article 4 defines a ROP
- Paris Article 4 incorporated into: EPC Art. 87; UK section 7; PCT Art 8; Hague 1960 and 1999 Agreements; and the PLT all incorporate Paris Article 4.
- Paris Article 4 is the model for: 35 USC 119(a)-(d).

Paris Article 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 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.”

Paris Article 4 Case Law

- Each jurisdiction has an independent body of law.
- Paris is likely to be interpreted similarly across jurisdictions.
- Cases from England and Wales High Court (Patents Court) (EWHC) and EPO Board.

Rule, Followed by Case Law

In the slides that follow for ROP, I synthesize the rule of law, for each issue, followed by case law quotations supporting rule.

ROP – The Timing Rule

- Paris 4A.(1) "Any person ... **shall enjoy, for the purpose of filing** in the other countries "
- **Rule:** The ROP must be owned by the filer **when** filing their subsequent application.

Owned At Time of Subsequent Filing - *Edwards*

“95. ... A person who files a patent application for an invention is afforded the privilege of claiming priority only if he himself filed the earlier application from which priority is claimed or if he is the successor in title to the person who filed that earlier application. If he is neither the person who filed the earlier application nor his successor in title then he is denied the privilege.” *Edwards Lifesciences AG v Cook Biotech Inc.*, HC08 C 00934, (EWHC 6/12/2009)

Owned At Time of Subsequent Filing - *Edwards*

“95. ... Moreover, his position is not improved if he subsequently acquires title to the invention. It remains the case that he was not entitled to the privilege when he filed the later application and made his claim.” *Edwards Lifesciences AG v Cook Biotech Inc.*, HC08 C 00934, (EWHC 6/12/2009)

Owned At Time of Subsequent Filing - *Edwards*

“95. ... Any other interpretation would introduce uncertainty and the risk of unfairness to third parties. In reaching this conclusion I derive a measure of comfort from the fact that the Board of Appeal of the EPO has adopted the same approach to the interpretation of art.87 EPC in two cases: J19/87 and T62/05.” *Edwards Lifesciences AG v Cook Biotech Inc.*, HC08 C 00934, (EWHC 6/12/2009)

ROP – The All Applicants

- Paris 4A.(1) "**Any person** who has duly filed .. shall enjoy ... a right of priority"
- **Rule:** When there are multiple applicants, the ROP attaches to the later application, **only if, all those applicants (or successors in title)** are also applicants of the later filed application.

All Applicants - *Edwards*

“99. That leaves the alternative argument advanced by Cook, namely that it always owned Mr Obermiller's interest in the invention and that is sufficient. I can deal with this argument quite shortly. The US application was filed in the names of Mr Obermiller, Mr Osse and Ms Thorpe, all as joint inventors. It was not filed by Mr Obermiller alone and therefore he was not ‘a person’ who had ‘duly filed an application for a patent’ within the meaning of Article 4A(1) of the Paris Convention. Once again, this approach is consistent with that adopted by the Board of Appeal of the EPO in case T 0788/05.”
Edwards Lifesciences AG v Cook Biotech Inc., HC08 C 00934, (EWHC 6/12/2009), Kitchin, Judge)

All Applicants - *Boston*

“In the case of D1 in which two co-applicants (Terumo and Tokin) are present, this means that the priority right belongs simultaneously and jointly to the two applicants, who thus constitute a legal unity unless one of them decides to transfer his right to the other applicant, who then becomes his successor in title and this before the filing of the later application. Since no evidence for such a transfer was submitted to the Board, D1 ... could only serve as a basis for claiming a priority right for the filing of a later application designating both applicants.” *Boston Scientific Scimed, Inc. v. Terumo Kabushiki Kaisha*, T 0788/05 (EPO Board 5/8/2007).

All Applicants Rule - *Schlich*

“How is the expression ‘any person’ in Article 87(1) EPC to be interpreted? *** the Board finds that the words ‘any person’ in Article 87(1) EPC require that all applicants for the priority application, or their successors in title, are applicants for the subsequent application.” *Schlich et al. v. The Broad Institute, Inc.*, T 0844/18 (EPO Board 11/7/2020).

ROP – The Exclusive Or Rule

- 4A.(1) “Any person ...**or** his successor in title”
- **Rule:** “or” is **exclusive**.
- The “successor in title” gains the ROP.
- The original “person” loses the ROP.

ROP Exclusive “or” - ADM Co.

“5.1 ... Article 4 of the Paris Convention of Article 87 EPC, in particular the wording “*Any person who has duly filed...an application for a patent... **or his successor in title**, shall enjoy...a right of priority*” (emphasis added by the board) renders perfectly clear that the mentioned right of priority pertains **either** to the first applicant **or** to its successor in title. In other words, contrary to what was submitted by the respondent, the ‘or’ in Article 87 EPC and Article 4 of the Paris Convention must unambiguously be read as an ‘exclusive or’.” *Archer-Daniels-Midland Co. v. Furanix Technologies B.V.*, T 0725/1 (EPO Board 1/21/2019); bold, italics, in the original.

ROP – The Duly Filed Formal Assessment General Rule

- 4A.(1) “Any **person** who has **duly filed**”
- **General Rule:** “Any person who has duly filed” is **conclusively governed** by applicants listed in the priority application.
- (But since the construction of “Any person who has duly filed” is a question of national law, there may be exceptions.)

ROP – The Duly Filed Formal Assessment Rules Of The EPO

4A.(1) “Any **person** who has **duly filed**”

Rule 1: The law determining the EPO’s interpretation of who “duly filed,” is Paris.

Rule 2: Paris requires interpretation of who “duly filed,” based upon national law.

Rule 3: US choice of law for interpreting who “duly filed,” is Paris, *per se*.

Rule 4: Paris limits to a ***formal*** assessment, determining who “duly filed.”

Duly Filed – *Schlich*

Schlich v. The Broad Institute, T 0844/18 (EPO Board 11/7/2020)

- This is a famous case dealing with rights to Crispr-CAS9.
- Broad claimed a ROP to US provisionals that each listed at least one person as one of the applicants that was not listed as an applicant in the EPO application.

Duly Filed – *Schlich Holding*

- The EPO Board held that the Broad's EPO application did not enjoy priority from those provisional applications.
- In reaching its conclusion, the EPO Board asked and answered 3 questions.

Schlich Case – First Question

- “1) Should entitlement to priority be assessed by the EPO?”
- Yes. “The EPC clearly sets out a requirement that the EPO examines the ‘who’ issue of priority entitlement.”
- EPO will determine who has “duly filed”

Schlich Case – Second Question

- “2) How is the expression ‘any person’ in Article 87(1) EPC to be interpreted?”
- Answer: All applicants rule
- The EPO Board concluded that it "is necessary to interpret the legal concept of ‘any person’ in Article 4A Paris Convention ... [and Article 87(1) EPC]...to be the same.”
- EPC choice of law for ROP is Paris Art 4A

Schlich Case – Second Question

- The EPO Board found “that the words ‘any person’ in Article 87(1) EPC require that all applicants for the priority application, or their successors in title, are applicants for the subsequent application.”

Schlich Case – Third Question

- “3) Does national law (in this case US law) govern the determination of ‘any person’ who has ‘duly filed’ in Article 87(1) EPC?”
- Yes, Paris Article 4 “Any person who has duly filed” is determined by national law.

Schlich Case – Third Question

- *Schlich* concluded that Paris Article 4, per se, was the relevant choice of US law, because *the* “Paris Convention is part of the ‘supreme Law of the Land’ in the US.”
- Concerns about propriety of this conclusion:
 - Paris is not self-executing. See *In re Rath*, (Fed. Cir. 2005)(Paris is not self-executing).
 - Paris Article 4 is implemented in 35 USC 119(a)-(d)
 - US property law is governed by state law

Schlich construction of “Any person who has duly filed”

Any person who has duly filed, “does not require that the ‘any person’ is actually legally entitled to make the filing, but *merely that they did so*. Thus the Paris Convention and the EPC provide self-contained definitions of the person who claims priority, both treaties *define this person by means of the action that this person has performed*.” Italics added for emphasis.

Schlich construction of “Any person who has duly filed”

- *The phrase “Any person who has duly filed,” in Paris and EPC 87(1), limits to “a formal assessment of the person (‘any person’) who has performed the act of filing the [prior] patent application.”*
- “Any person who duly filed” is conclusively governed by list of applicants in the priority application.

Successor In Title – EPO Substantial Legal Assessment Rule

4A.(1) “Any **person** who has **duly filed ... or his successor in title**”

EPO Rule: The EPO conducts a substantial legal assessment of evidence to determine whether an entity is a successor in title.

Successor In Title – Schlich

“20. The EPO only assesses, and for this it is the practice of the EPO to require evidence, that a successor in title is in fact the successor in title of the original applicant; an assessment which indeed involves a substantial legal assessment but not an assessment of legal entitlement to a priority right.” *Schlich et al. v. The Broad Institute, Inc.*, T 0844/18 (EPO Board 11/7/2020).

Successor In Title – UK Equitable Ownership/Beneficial Interest Rule

- 4A.(1) “Any **person** who has **duly filed ... or his successor in title**”
- **UK Rule:** So long as the applicant has “equitable or beneficial title to the priority right,” that is “good enough” for the ROP.
- (Equitable ownership – Right to acquire title)
- (Beneficial interest – A right to benefit from a property)

Successor In Title - Accord

“67. ... In *KCI Licensing v Smith & Nephew* and *HTC v Gemalto* the judges (Arnold J and myself respectively) accepted a significant softening to what otherwise might have been the rigour of the rule that the title must be secured by the time the international application is made, by accepting an analysis based on common law principles distinguishing the equitable and legal title to property.”
Accord Healthcare Limited v. Research Corporation Technologies, Inc., HP-2016-000038 (EWHC 11/7/2017).

Successor In Title - Accord

“67. ... If the relevant local law meant that the equitable or beneficial title to the priority right was in the hands of the person making the priority claim in the international application, that was held to be good enough even though that person did not then hold the legal title under the local law and could only perfect their title after the event.” *Accord Healthcare Limited v. Research Corporation Technologies, Inc.*, HP-2016-000038 (EWHC 11/7/2017).

Successor In Title - KCI Licensing

“in consideration of employment [Mr. Lin agreed to] ***
assign and agree to assign to ... KC ... all right, title and
interest in all confidential information, inventions and
improvements conceived or developed by me, alone or in
conjunction with others, during my employment and for a
period of three (3) years after termination for whatever
reason, which relate to any phase of the Company's
business.” *KCI Licensing v Smith & Nephew*,
HC09C02624, 1487 (EWHC 6/23/2010).

Successor In Title - KCI Licensing

“69. The Lin agreement ‘was plainly effective to transfer the entire beneficial interest in the invention, including the right to file patent applications in respect of it *** that was sufficient to make [KCI the] *** ‘successor in title’ for the purposes of a claim to priority under Article 87(1) of the EPC and Article 4(A)(1) of the Paris Convention even if *** [KCI] had not acquired the bare legal title at the relevant date.’”
KCI Licensing v Smith & Nephew, HC09C02624, 1487 (EWHC 6/23/2010).

Successor In Title – UK BFP Rule

- 4A.(1) “Any **person** who has **duly filed ... or his successor in title**”
- **UK Rule:** A Bone Fide Purchaser (for value without notice) enjoys the ROP (defeating at least a prior equitable ownership interest).

Successor In Title - Accord

“119. I turn to the *** common law concept of a bona fide purchaser for value without notice had been codified in statute at 35 USC §261. *** 123. I find that on 4th February 1997 RCT was not on notice of any possible conflicting interest held by the university. Therefore RCT acquired good title to the invention including any priority right. Any equitable interest in the invention which the university did hold prior to the assignment was destroyed or overridden by the assignment to RCT. 124. Accordingly RCT had the substantive priority right when the PCT application was filed.” *Accord Healthcare Limited v. Research Corporation Technologies, Inc.*, HP-2016-000038 (EWHC 11/7/2017).

ROP Period – General Rule

- Paris article 4 A and C
- **General rule:** The first filing of subject matter starts the ROP *period* for that subject matter.
- The ROP period is 12 months for patents and 6 months for designs and trademarks.

Paris ROP Period Provisions

- 4A.(1) “shall enjoy *** a right of priority during the periods hereinafter fixed.”
- 4C.(1) “twelve months for patents *** six months for industrial designs and trademarks.”
- 4C.(2) “start from the date of filing of the first application”
- 4C.(3) extended to the next working day “If the last day of the period is an official holiday, or a day when the Office is not open.”
- 4C.(4) “A subsequent application” ROP period reset rule.

Paris ROP Period Reset Rule

The Paris 4C.(4) Reset

“A **subsequent application concerning the same subject** as a previous first application within the meaning of paragraph (2), above, filed in the same country of the Union shall be **considered as the first application**, of which the filing date shall be the starting point of the period of priority, if, **at the time of filing** the subsequent application, the said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.”

ROP Period Reset Rule

- The Paris ROP period reset provision is very narrow.
- Do not rely upon it!

THANK YOU

- Rick Neifeld
- NEIFELD IP LAW PLLC
- <http://www.Neifeld.com>
- rneifeld@neifeld.com
- 1-703-415-0012
- Fairfax, VA 22312

