

RE: RIGHT OF PRIORITY, AND FILING OPTIONS
FOR INTERNATIONAL AND US IP RIGHTS

Dear Colleague:

What follows is an overview of the deadlines that arise as a consequence of filing an original application for IP rights. For any particular situation, contact us to obtain situation specific advice how to proceed.

I. 6 AND 12 MONTH FILING DEADLINES TO PRESERVE THE “RIGHT OF PRIORITY” FOR FOREIGN RIGHTS

This section provide explanatory information about the 6 and 12 month deadlines triggered by the filing of an original application for IP rights.

A United States (U.S.) patent, design, or trademark application will not result in rights outside the U.S.

In order to obtain rights in a foreign country to the invention, design, or trademark disclosed in U.S. application, you must file an application for those rights in that foreign country.

You obtain a “right of priority” of the filing date of the US application, in a foreign application, if you meet certain conditions. The “right of priority” means that the foreign application will be deemed to have been filed in the foreign country on the date the US patent application was filed, for the purpose of determining what is and what is not prior art against the invention claimed in the foreign application. The “right of priority” is provided by the international treaties called the Paris Convention and the TRIPS agreement of WTO. The right is available in all countries that are members of either the Paris Convention or the WTO. Almost all countries are member of either or both Paris and WTO, and therefore provide this “right of priority.”

For patents, prior art is that information against which the novelty, and inventive step (also referred to as obviousness) of your claimed invention is evaluated. A claim in your patent application that is determined to not be novelty and inventive (non-obvious) will be rejected. For trademarks, that information are the trademark rights of others and common meanings of terms.

For trademarks, prior art refers to pre-existing trademark rights, including but not limited to registered trademarks, and use of names in commerce.

For industrial designs and trademarks, that limited period of time is 6 months from the filing of the corresponding US application. For patents (and utility models available in some countries outside the US), that limited period of time is 12 months from the filing of the corresponding US application.

In order to obtain the “right of priority” of the filing date of the US application, in an application filed in a foreign country, the foreign application must: (1) be filed in the foreign

country within a limited period of time; (2) be owned at the time of filing of the foreign application by the same entity that owns the US application; (3) make a claim to the “right of priority” to the US application; and (4) have a certified copy of the US application delivered to the IP office of the foreign country. The next section discusses alternatives based upon pan national IP offices.

II. OVERVIEW OF FILING OPTIONS TO OBTAIN FOREIGN RIGHTS

There are options for filings to obtain rights in foreign countries.

There are regional agreements for patents that provide for filings that may result in patents in several countries. These agreements providing for filing a PCT application; and EPO; Eurasian; ARIPO; and OAPI applications. Some of these applications result in patents and others require a subsequent filing in a national patenting office to result in patents. In addition, most countries also have a national patenting office in which anyone can file an application for a patent in that country. However, some countries have closed their national office and now rely upon the regional patenting office of which that country is a member. In addition, most if not all of the regional offices also provide for the “right of priority” to an original application. Accordingly, you have various filing routes that may result in patent protection in countries you desire.

For industrial designs, there is a similar regime. The Hague convention provides for filing one application covering multiple countries. For trademarks, the Madrid protocol provides a similar multinational filing system.

The Patent Cooperation Treaty provides residents of PCT contracting states the right to file PCT applications entitled to the “right of priority.” As of October 2015, WIPO (which administers international treaties) reports that there are 148 PCT contracting states. This leaves about 34 countries that are not PCT contracting states.

To be entitled to the “right of priority” for a patent application that can result in a patent in a foreign country that is not a contracting state of the PCT, you must file a foreign national application in that country. Two such countries of relevance as of 2023 are Argentina and Taiwan.

To be entitled to the “right of priority” for a patent application that can result in a patent in a foreign country that is a contracting state of the PCT, you must file at least one of a PCT application; a regional patenting authority application covering that country; or a foreign national application in that foreign country. Certain territories can be covered by an extension from PCT filings in other offices. One example as of 2023 is Hong Kong, which can be covered by an extension from either UK or China, for a PCT filing nationalized in those countries.

For your review, refer to the following web pages, maintained by WIPO, that list and graphically show Paris, WTO, and PCT contracting states:

PCT, Paris, WTO list:

http://www.wipo.int/export/sites/www/pct/en/texts/pdf/pct_paris_wto.pdf

PCT with map showing territories covered:

http://www.wipo.int/export/sites/www/pct/en/list_states.pdf

If you are not sure whether a country is a member of Paris, WTO, or PCT, do not hesitate

to ask us.

Note specifically that, as of 2023, Taiwan and Argentina are not members of PCT. Argentina is a member of Paris and Taiwan is a member of WTO and therefore both countries provide a right to priority for utility applications filed within 12 months of a first filing for an invention.

III. FILING OPTIONS TO PRESERVE RIGHTS TO A US PROVISIONAL OR NON PROVISIONAL PATENT APPLICATION

An original US provisional application will not issue into a patent.

To preserve the right to obtain a US patent benefitting from an original US provisional application, you must follow the provisional filing with some other filing within 12 months of the US provisional application's filing date. That subsequent filing may be either or both of a US national application and a PCT application. A US original nonprovisional application may issue as a patent. To preserve the right in the US to seek additional claims covering the invention disclosed in a US nonprovisional application that has the benefit of the filing date of the original nonprovisional application, you must file a subsequent nonprovisional US application before the original application is abandoned or issued. By "original", this paragraph means the first filing disclosing the subject matter claimed.

To preserve the "right to priority" to the filing date of the US provisional application in foreign countries, based upon either a US provisional or US original nonprovisional application, you must file a foreign national application; regional application; or PCT application within 12 months of the US provisional application's filing date. For a PCT application, you would then subsequently need to file PCT foreign national or regional stage entry applications in each country in which you sought patent protection. For some of the regional applications, you would also need to take subsequent action in national patenting authorities.

IV. PCT NATIONAL STAGE DEADLINES - 30 MONTHS FROM PRIORITY DATE

A PCT application does not issue into a patent. If you filed a PCT application, then you must follow that PCT filing with PCT national or regional stage entries (filings) within 30 months from the date of filing the original application to which the PCT claims priority (or if no priority is claimed, then 30 months from the filing date of the PCT application), in each country or region in which you desire a patent.

V. YOUR DEADLINE TO ACT IS LONG PRIOR TO THE LEGAL DEADLINE

You cannot simply wait until the priority or national stage legal deadline to act. Filing an application is time consuming, and the ability to file an application depends upon factors beyond our control (power, Internet, governmental Web site status, weather, etc.) Sending appropriate instructions to your foreign agents and having those agents act on your instructions is subject to the same factors. Moreover, there is a chance that any filing will be defective in some manner, requiring correction of the defect before the legal deadline. The normal way such filing errors

come to light is that the government officials reviewing the filings identify them, which normally takes a couple of weeks. Accordingly, you must have finalize your instructions not later than one month prior to the legal deadline to ensure your rights are protected. We can work with you to ensure that happens.

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