

## Avoiding Failed Patent Application Filings

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### **I. INTRODUCTION**

This paper is directed to how patent attorneys can avoid failures in patent application filings. These failings can be grouped, as follows. Failing to file by a deadline; filing a substantively defective application; and failing to secure the legal relationships between sequential filings. This paper also summarizes the partial remedy for a missed filing deadline, of restoration of priority.

### **II. FAILING TO FILE BY A LEGAL DEADLINE**

There are legal deadlines that result in loss of rights. For example, failing to file by a 35 USC 102(b)(1) date (a date one year after a public disclosure of the invention communicated from one of the named inventors) results in loss of possible rights based upon the disclosure. For another example, failing to file a foreign application within 12 months from a national application results in loss of the right to the Paris Priority Right. My discussions with officials at WIPO and the USPTO indicate that more than 0.2 percent (aka 1 in every 500) of patent application filing deadlines are missed. So this is a significant problem.

There are many factors that go into meeting deadlines, such as proper docketing, and timely preparation of formal legal documents, specifications, and the like. However, the root cause of many deadlines missed by patent attorneys is their failure to realize their limitations and communicate the consequences of those limitations to their clients.

#### **II.A YOUR DUTY TO COMMUNICATE WITH YOUR CLIENT**

Many clients are not patent attorneys and do not understand what you understand about deadlines. What many clients do not know and you definitely do need to know and take to heart, is that there are circumstances that may prevent you from promptly filing an otherwise ready-to-file patent application. And therefore your delay in communicating relevant information to the client may result in you missing a patent filing deadline.

To drive home this point, assume you are in a position to file a patent application, having the specification, requirements forms and funds, at a particular time. Now recognize any of the myriad events that might prevent you from effecting filing of the application. Fire, flood, Internet failure, equipment failure, power outage, personal injury, mental lapse, stuck in traffic, on travel, or the like. Given that recognition, estimate the longest possible interval you might be delayed in receiving an instruction to file, and effecting the filing. There is such an interval for each of us, even though it varies from person to person. Call it the Risk Interval. The consequence of the existence of that Risk Interval is that you cannot guarantee a timely filing if you do not have a ready-to-file application in hand by an amount of time prior to the deadline that exceeds that Risk Interval.

The fact that you cannot guarantee a timely filing by a deadline, if you do not have a

ready-to-file application in hand by some date, defines a practical deadline in each case. That practical deadline is no later in time than the filing deadline minus your Risk Interval. Also recognize that the risk of loss due to further delay past your practical deadline increases as the deadline approaches.

So what should you tell your client, and when should you tell them when a filing deadline exists?

First, that there is a legal deadline for filing.

Second, the consequences of missing the filing deadline.

Third, the practical deadline by which you need to be in a position to effect filing to avoid risk of loss.

Fourth, that, after the practical deadline, the risk of loss due to further delay increases as the deadline approaches.

Finally, you need to communicate this information sufficiently in advance of the filing deadline to allow the client time to provide what you need. You should generally your practical deadline, as that date approaches.

## **II.B ANTICIPATING CLIENT FAILURES IN THEIR DUTY TO COMMUNICATE WITH YOU**

Recognize that some clients decline to respond to communications, or that they reply in a manner that is non-responsive to your communication. Often, for example, a client will simply not respond to an email requesting instructions. Or they will say something like, “It would be nice to file that application.” or “I will get back to you.” Neither of those are an express instruction to proceed. And then you may feel compelled to continue sending followup communications, emails, fax, phone call, postal letters, as the deadline nears. Or some clients will neglect to give you written instructions, instead only communicating instructions during voice calls.

Consider including the client’s duty to communicate expressly in your engagement agreement. And that they have a duty to update you with changes in their contact information, such as email, phone, fax, and postal address. Optionally, you may want to specify that all instructions to be in writing, in an email, or the like. (If you accept verbal instructions, consider to contemporaneously memorializing verbal instructions by email.)

Consider including in communications relating to filing deadlines that, if you do not have an express instruction to proceed by a certain date (such as one month prior t the filing deadline), you will assume the client does not intend for you to file and you will send no further reminders after that date. And then, when that certain date arises, if you do not have what you need from the client to effect the filing, send a final notice, pointing to your original communication, and noting that you will send no further reminders.

## **II.C FILING A DEFECTIVE APPLICATION**

I associate filing a defective application with failing to file by the deadline, because a defective application can often be refiled or cured, if done so prior to the legal deadline. Taking corrective action requires you to become aware of the defect before that legal filing deadline.

For example, it happens from time to time, that some part of an application is defectively filed or missed, and not filed, when filing an application. For example, drawings for one application are inadvertently filed with the specification of another application, or the final electronic conversion of documents results in loss of disclosure (formulas in which font conversion has resulted in nonsense, or images which render to a form suitable for electronic filing that are, as rendered, nonsense). The people that may catch this kind of error after filing are you, the governmental officials, or your client. But the catching of the error may occur when they review the filing, which occurs after the filing. If the original filing occurred sufficiently in advance of the deadline such that you become aware of the defect before the legal filing deadline has past, then you may be able to take a mulligan. Therefore, one factor to consider when setting your practical deadline is possibility for a defective filing and the time required to recognize and correct it.

In this regard, there is one issue peculiar to filing PCT applications in RO/US. Unlike Notices in US applications filed in the USPTO, Notifications issued in PCT applications filed in RO/US do not generate an eNotification. Instead, they are postal mailed to the PCT application's postal correspondence address. Consequently, if your RO/101 postal address is wrong, or you are not monitoring postal mail at that address, you can miss the USPTO's PCT Notifications. If that Notification contains identifies a substantive defect (such as blacked out drawings, botched font characters in formulas, missing pages) or a fee deficiency, the results may be fatal to rights springing from that PCT application.

### **III. SECURING THE LEGAL RELATIONSHIPS BETWEEN SEQUENTIAL FILINGS**

#### **III.A US Benefit - 35 USC 119(e); 120 (and 365(b) and (c); 386(c))**

US patent attorneys should know US benefit requirements like the back of their hand. I mention US benefit only for completeness, and to distinguish Paris requirements therefrom. Entitlement to US benefit (the benefit of the filing date of an earlier application) requires continuity of disclosure; inventorship; and pendency; and compliance with the specific reference requirement. *Cf. Zenon Environmental, Inc. v. United States Filter Corporation*, 506 F. 3d 1370, 1379 (Fed. Cir. 2007)(continuity of disclosure); 35 USC 120 (“filed before the patenting or abandonment of or termination of proceedings on the ... [prior] application...”); *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995)(continuity of inventorship); and *Encyclopaedia Britannica v. Alpine*, 609 F.3d 1345, 1352 (Fed. Cir. 2010)(specific reference). US benefit does not require complete identity of inventorship to comply with 120. *Chu, supra*. Copendency is satisfied when a continuing application's filing date occurs on the same date of the application to which it claims 120 benefit issues. *Immersion Corporation v. HTC Corporation*, 2015-1574, 826 F. 3d 1357 (Fed. Cir. 6/21/2016). An application claiming benefit to a nonprovisional or a provisional application is relieved from the requirement in 112(a) to disclose the best mode. 35 USC 119(e)(1); 120 (reciting “(other than the requirement to disclose the best mode)”).

#### **III.B Paris Convention Right of Priority**

The Paris Convention provides a Right of Priority (ROP) which is very similar to the rights provided by US benefit. Both US benefit and the ROP provide a mechanism for a

subsequent filing to avoid acts (such as publications) that occur after the first filing and before the second filing from defeating the right to a patent on the second filing. However, the requirements for entitlement to the ROP differ from the requirements for obtaining US benefit.

Paris is the fundamental treaty on which other major IP treaties rely, and therefore it is the appropriate starting point to look at the ROP, even when considering Hague and PCT filing routes. Consider that PCT Article 8, ROP for a PCT; and Hague Article 2, are governed by Paris. EPC Article 87 is modeled after Paris, and EPO case law analyzes Article 87 requirements in the context being modeled after and meaning essentially the same thing as Paris. PLT Article 15 members to comply with Paris.

### **III.B.1 Highlight of Paris Convention Elements Defining the ROP**

The articles of the Paris Convention relevant to the Right of Priority are Articles 1-4. After reproducing Articles 1-4, I will highlight provisions most relevant to the Right of Priority. Articles 1-4 read:

#### Article 1 Establishment of the Union; Scope of Industrial Property<sup>2</sup>

(1) The countries to which this Convention applies constitute a Union for the protection of industrial property.

(2) The protection of industrial property has as its object patents, utility models, industrial designs, trademarks, service marks, trade names, indications of source or appellations of origin, and the repression of unfair competition.

(3) Industrial property shall be understood in the broadest sense and shall apply not only to industry and commerce proper, but likewise to agricultural and extractive industries and to all manufactured or natural products, for example, wines, grain, tobacco leaf, fruit, cattle, minerals, mineral waters, beer, flowers, and flour.

(4) Patents shall include the various kinds of industrial patents recognized by the laws of the countries of the Union, such as patents of importation, patents of improvement, patents and certificates of addition, etc.

#### Article 2 National Treatment for Nationals of Countries of the Union

(1) Nationals of any country of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals; all without prejudice to the rights specially provided for by this Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with.

(2) However, no requirement as to domicile or establishment in the country where protection is claimed may be imposed upon nationals of countries of the Union for the enjoyment of any industrial property rights.

(3) The provisions of the laws of each of the countries of the Union relating to judicial and administrative procedure and to jurisdiction, and to the

designation of an address for service or the appointment of an agent, which may be required by the laws on industrial property are expressly reserved.

Article 3 Same Treatment for Certain Categories of Persons as for Nationals of Countries of the Union

Nationals of countries outside the Union who are domiciled or who have real and effective industrial or commercial establishments in the territory of one of the countries of the Union shall be treated in the same manner as nationals of the countries of the Union.

Article 4 A to I. Patents, Utility Models, Industrial Designs, Marks, Inventors' Certificates: Right of Priority G. Patents: Division of the Application

A.(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.

(2) Any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognized as giving rise to the right of priority.

(3) By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application.

B. 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, the putting on sale of copies of the design, or the use of the mark, and such acts cannot give rise to any third-party right or any right of personal possession. Rights acquired by third parties before the date of the first application that serves as the basis for the right of priority are reserved in accordance with the domestic legislation of each country of the Union

C.(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.

(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.

(3) If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.

(4) 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.

D.(1) Any person desiring to take advantage of the priority of a previous filing shall be required to make a declaration indicating the date of such filing and the country in which it was made. Each country shall determine the latest date on which such declaration must be made.

(2) These particulars shall be mentioned in the publications issued by the competent authority, and in particular in the patents and the specifications relating thereto.

(3) The countries of the Union may require any person making a declaration of priority to produce a copy of the application (description, drawings, etc.) previously filed. The copy, certified as correct by the authority which received such application, shall not require any authentication, and may in any case be filed, without fee, at any time within three months of the filing of the subsequent application. They may require it to be accompanied by a certificate from the same authority showing the date of filing, and by a translation.

(4) No other formalities may be required for the declaration of priority at the time of filing the application. Each country of the Union shall determine the consequences of failure to comply with the formalities prescribed by this Article, but such consequences shall in no case go beyond the loss of the right of priority.

(5) Subsequently, further proof may be required. Any person who avails himself of the priority of a previous application shall be required to specify the number of that application; this number shall be published as provided for by paragraph (2), above.

E.(1) Where an industrial design is filed in a country by virtue of a right of priority based on the filing of a utility model, the period of priority shall be the same as that fixed for industrial designs.

(2) Furthermore, it is permissible to file a utility model in a country by virtue of a right of priority based on the filing of a patent application, and vice versa.

F. 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.

G.(1) If the examination reveals that an application for a patent contains

more than one invention, the applicant may divide the application into a certain number of divisional applications and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any.

(2) The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorized.

H. Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application in the country of origin, provided that the application documents as a whole

I.(1) Applications for inventors' certificates filed in a country in which applicants have the right to apply at their own option either for a patent or for an inventor's certificate shall give rise to the right of priority provided for by this Article, under the same conditions and with the same effects as applications for patents.

(2) In a country in which applicants have the right to apply at their own option either for a patent or for an inventor's certificate, an applicant for an inventor's certificate shall, in accordance with the provisions of this Article relating to patent applications, enjoy a right of priority based on an application for a patent, a utility model, or an inventor's certificate.

I now cover aspects of Paris dealing with the ROP.

National treatment is defined in Paris 2(1):

(1) Nationals of any country of the Union shall, as regards the protection of industrial property, **enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals**; all without prejudice to the rights specially provided for by this Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with.

Thus, national treatment is the right of equal treatment for industrial property rights, in every other country of the Union, under that country's laws.

Paris Articles 2(a) and 3, as shown in bold, identify who is entitled to "National Treatment"

Article 2 National Treatment for Nationals of Countries of the Union

(1) **Nationals of any country of the Union** shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals; all without prejudice to the rights specially provided for by this Convention. Consequently, they shall have the same protection as the latter, and the same legal

remedy against any infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with.

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Article 3 Same Treatment for Certain Categories of Persons as for Nationals of Countries of the Union

**Nationals of countries outside the Union who are domiciled or who have real and effective industrial or commercial establishments in the territory of one of the countries of the Union** shall be treated in the same manner as nationals of the countries of the Union.

Thus, nationals of member countries, nationals of non member countries domiciled in member countries, and nationals of nonmember countries that have real and effective industrial or commercial establishments in the territory of a member country enjoy national treatment.

Paris Article 4A.(1) is very significant, containing many of the rights and requirements for the ROP. Paris Article 4A.(1), as shown in bold, provides the ROP.

A.(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 4A.(1), as shown in bold, identifies who enjoys the ROP.

A.(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.

As explained in Bodenhausen, "Guide To the Application of the Paris Convention For the Protection of Industrial Property," at 35, "any person" is limited to the entities entitled by Paris Articles 2 and 3 to national treatment. As stated there:

The term "any person" must be interpreted within the context of the rules of the Convention which define the persons capable of benefitting therefrom. The term thus means all persons entitled to claim application of the Convention according to Articles 2 and 3, that is, nationals ... . [Bodenhausen, at 35.]

Paris Article 4A.(1), as shown in bold, limits the ROP to inter-national filings.

A.(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 4A.(1), as shown in bold, limits the ROP to applications filed in member countries.

A.(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 4B, as shown in bold, identifies the scope of the ROP, which is to preclude invalidate by acts occurring after the priority filing date.

B. 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, the putting on sale of copies of the design, or the use of the mark**, and such acts cannot give rise to any third-party right or any right of personal possession. Rights acquired by third parties before the date of the first application that serves as the basis for the right of priority are reserved in accordance with the domestic legislation of each country of the Union

Paris Article 4C.(2) and (3), as shown in bold, provides that the ROP period includes the anniversary date and extends over local holidays in the country where protection is claimed, to the next working day.

(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**.

(3) If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the **period shall be extended until the first following working day.**”

Paris Article 4C.(2) and (3), as shown in bold, provides a ROP period of 12 months for patents and utility models, and six months for industrial designs and trademarks.

(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**.

Paris Article 4C(4), as shown in bold, specifies the (very limited) circumstances were a

subsequent filing for the same invention can restart the ROP period.

(4) 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**.

These circumstances are enumerated as follows.

[I] The subsequent application is filed in the same country of the Union as the previous application;

[ii] At the time of filing the subsequent application, the previous application has been withdrawn, abandoned, or refused;

[iii] At the time of filing the subsequent application, the previous application has not been laid open to public inspection;

[iv] At the time of filing the subsequent application, the previous application leaves no rights outstanding;

[v] At the time of filing the subsequent application, the said previous application has not served as a basis for claiming a right of priority; and

[vi] The previous application may not thereafter serve as a basis for claiming a right of priority.

Paris Article 4A.(3), as shown in bold, specifies that, what happens to the priority application after it is duly filed (such as being abandoned), does not affect the right to claim priority thereto.

(3) By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, **whatever may be the subsequent fate of the application**.

Paris Article 4A.(3), as shown in bold, entitles an applicant to claim multiple ROPs, and ROPs from applications filed in multiple countries.

F. 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.

Paris Article 4F, as shown in bold, entitles an applicant to a new ROP for new matter disclosed in a subsequent application.

F. 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.**

### **III.B.1 Paris ROP Related Case Law**

This section covers cases interpreting the ROP in adversarial proceedings. While these cases are in particular jurisdictions (EPO Board and UK courts), their principles are widely applicable because they deal directly or inferentially with Paris Article 4's ROP through its counterpart in the EPC. Herein below, I state the rule of law in the subheading, and highlight text most relevant to that rule in the corresponding case excerpts.

#### **III.B.1.a The Subsequent Application Must Include All Applicants of the First Application to enjoy the ROP**

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, independently of the question of the same invention, could only serve as a basis for claiming a priority right for the filing of a later application designating both applicants. **But since the present application was only filed by one applicant (Terumo), D1 could not represent the "first application" within the meaning of Article 87(1) EPC.** [Boston Scientific Scimed, Inc. v. Terumo Kabushiki Kaisha, T 0788/05 (EPO Board 5/8/2007).]

#### **III.B.1.b The Subsequent Application May Include More Applicants Than the First Application and Enjoy the ROP**

2.4 As far as the board is concerned, **Article 87 (1) EPC does not**

**preclude the (individual) applicant for the first application from sharing his right of priority with a third party by filing an application claiming priority with him.** So if the application claiming priority is filed jointly by several applicants, not all of these applicants must also be applicants or successors in title of the applicants for the first application. Rather, this article requires that the applicant for the first application (or applicants) or his or her successor in title (or their successors in title) is also among the applicants for the claiming priority. In such a case, in which only one further applicant is added to the subsequent application, there is then no need to provide evidence of the transfer of the right of priority to this further applicant (see: *Bremi*, loc. Cit., Art. 87 para. 56). **Since in the present case the only applicant A2 of the earlier application D1 is also one of the applicants for the application on which the patent in suit is based, D1 is to be regarded as the first application within the meaning of Article 87 (1) EPC.** [*Schaeffler Technologies GmbH & Co. KG v. Porsche AG*, T 1933/12 (EPO Board 2/21/2014); translated from German.]

### **III.B.1.c The ROP Must Have Vested in the Successor, Prior to the Filing Date of the Subsequent Application**

95. In my judgment, the effect of art.4 of the Paris Convention and s.5 of the Act is clear. 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. 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. 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), Kitchin, Judge.]

**There is no indication that, during the Washington Revision Conference, the intention in adding the term "successor in title" was to give an applicant claiming priority from an earlier application who is not entitled to the right of priority when he is filing his application an opportunity to acquire at a subsequent stage the priority right existing from an earlier application in respect of the same invention filed by another person and attribute it to his own application. \*\*\* In view of the above, the board considers that its interpretation of Article 87(1) EPC 1973 is in line with the basic principles governing the right of priority laid down in the Paris Convention. \*\*\*** In the present case, the subsequent application was filed on 6

September 2003 and, at the same time, the declaration of priority was submitted in accordance with Article 8(1) PCT and Rule 4.10(a) PCT (as in force until 31 March 2007). According to appellant's line of argument (I), Tenaris Connections AG was the successor in title as of 9 September 2003, i.e. three days later. Hence, Tenaris Connections AG was not entitled to the claimed priority pursuant to Article 87(1) EPC 1973 according to any of the established approaches in the case law. [Vallourec Oil and Gas France v. Tenaris Connections Ltd., T 0577/11 (EPO Board of Appeals 4/14/2016).]

Likewise, in the case law of the boards of appeal and the jurisprudence of national courts of the EPC contracting states hitherto, **the point in time at which the subsequent application was filed has been considered relevant in assessing whether the applicant of the subsequent application is entitled to the claimed priority pursuant to Article 87(1) EPC 1973** as a successor in title (see decisions T 62/05, Reasons, point 3.4; T 788/05, Reasons, point 2; T 493/06, Reasons, point 11; T 382/07, Reasons, point 9.1; German Imperial Patent Office, BIPMZ 1906, 127; German Federal Court of Justice, decision of 16 April 2013, X ZR 49/12 ? Fahrzeugscheibe, Reasons, point II.2.a); High Court of Justice of England and Wales, *Edwards Lifesciences AG v Cook Biotech Incorporated*, [2009] EWHC 1304 (Pat), para 95 with reference to decisions J 19/87 and T 62/05; *KCI Licensing Inc. et al. v Smith & Nephew PLC et al.*, [2010] EWHC 1487 (Pat), para 58; *HTC Corporation v Gemalto S.A.*, [2013] EWHC 1876 (Pat), para 132; *Idenix Pharmaceuticals Inc. v Gilead Sciences Inc. et al.*, [2014] EWHC 3916 (Pat), para 409; Higher Regional Court Düsseldorf, decision of 6 December 2012, I-2 U 46/12, Reasons, point II.B.3(b)(aa) 1.2.1). **It is less clear from the above-mentioned case law whether, considering that the smallest time unit under the EPC is a day, the latest day on which succession in title has to have occurred is the day before the filing of the subsequent application or whether that date is still included. This specific question, however, was not relevant in the present case.** As to other approaches, the board is aware of decisions in which the German Federal Patent Court considered that it was the moment of filing the declaration of priority with the particulars relating to the priority application which was relevant for the assessment of entitlement to priority rights (German Federal Patent Court, decision of 15 February 2012, 5 Ni 59/10 (EP), Reasons, point I.2, and decision of 28 October 2010, 11 W (pat) 14/09, Reasons, point II.B.2(a)(cc)). [Vallourec Oil and Gas France v. Tenaris Connections Ltd., T 0577/11 (EPO Board of Appeals 4/14/2016).]

### **III.B.1.d The Paris ROP Is Enjoyed by Either the Person That Filed the Priority Application or the Successor in Interest, but Not Both**

5.1 The board is convinced that no decision of the Enlarged Board is required in the present case. In the board's view, the formulation in accordance with 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 Company v. Furanix Technologies B.V., T 0725/1 (1/21/2019); emphasis in the original.]

### **III.B.1.e The Original Person That Filed the Priority Application Can Have Their Subsequent Application Invalidated If the Alienated or the Successor in Interest, but Not Both**

IX. In its reply dated 21 December 2018, the respondent \*\*\* further requested that two questions be referred to the Enlarged Board of Appeal (see below) \*\*\* **"1. Can the original inventor/applicant - under the Paris Convention for the protection of industrial property and corresponding articles in the European Patent Convention - lose the right to priority whereby the publication of his invention despite having validly filed a subsequent application within the priority year result [sic] in the invalidation of this subsequent application? 2. If the answer to question 1 is yes, must the Paris Convention and corresponding articles in the EPC be interpreted such that the right to create priority is taken away from the original inventor/applicant in case of a successor in title?"** \*\*\* 5.1 The board is convinced that no decision of the Enlarged Board is required in the present case. In the board's view, the formulation in accordance with 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". \*\*\* 5.4 **On the basis of Article 87 EPC, the board is thus in a position to answer both questions posed by the respondent (XIII, supra) affirmatively.** The respondent's request to refer those questions to the Enlarged Board of Appeal is therefore refused. [Archer-Daniels-Midland Company v. Furanix Technologies B.V., T 0725/1 (1/21/2019).]

### **III.B.1.f The Equitable Owner is the “successor in title,” Enjoying the ROP**

60. The Confidentiality Agreement is expressed to be entered into by Mr Lina "in consideration of employment with" KC Inc. Paragraph 3 provides: **"I hereby assign and agree to assign to the Company [i.e. KC Inc] 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. In addition, I will communicate promptly to the Company all such inventions and improvements and will sign all documents reasonably requested by the Company to evidence the fact that such inventions and improvements are the sole and exclusive property of the Company and will do all things necessary to enable the Company to file patent applications on the inventions throughout the world." 61. Paragraph 5 of the Confidentiality Agreement provides that it is governed by the law of the State of Texas. There is no evidence as to Texas law before me, and accordingly it is common ground that it should be assumed to be the same as English law. \*\*\* I would add that, even if it was not effective to convey the legal title to the invention, paragraph 3 of the Confidentiality Agreement was plainly effective to transfer the entire beneficial interest in the invention, including the right to file patent applications in respect of it, from Mr Lina to KC Inc. KC Inc would have been entitled to demand that Mr Lina convey the bare legal title to the invention to itself at any time, and to compel Mr Lina to do so if he failed or refused to do it. **If necessary, I would hold that that was sufficient to make KC Inc Mr Lina's "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 KC Inc had not acquired the bare legal title at the relevant date.** [KCI Licensing v Smith & Nephew, HC09C02624, 1487 (EWHC 6/23/2010).]

I note that the agreement included the so called automatic assignment language ((e.g., "agrees to and does hereby grant and assign" approved as effect to convey title, by the Federal Circuit. *Cf. SIRF Technology v. ITC and Broadcom*, 2009-1262, \_\_\_ F.3d \_\_\_ (Fed. Cir. 2010)). So it is advisable for employers to include that language in IP clauses in employment agreements governed by US law.

### **III.B.1.g A Bare Legal Title Holder Does Not Enjoy the ROP**

32. AbbVie's first submission is that it is unnecessary to examine the chain of title because the inventors owned the legal title and made the claim to priority. AbbVie argues that on both parties' cases, when the PCT was filed on 5 June 2002, the inventors each still held legal title to the Invention. **Under their EISAs, the US inventors had agreed to assign their rights to KPC or its nominee. This operated as an agreement to assign future rights which needed to be perfected before legal title was assigned. That had not been done by June 2002. Therefore, the US inventors held legal title on trust for KPC or its nominee.** \*\*\* This was permitted under Article 4A of the Paris Convention. Abbott Bermuda was also included as an applicant on the PCT Application. However, AbbVie submits that it makes no difference if there was an additional applicant, provided that the legal owners, who are entitled to claim priority, are applicants for the PCT Application; *see KCI* at [98]. 34. I do not accept this

argument, for the following reasons. First, I do not consider that Article 4A permits both the original applicant and his successor in title to enjoy a right of priority. In my judgment, where a right to claim priority has been assigned, the assignor cannot subsequently make a claim himself. The Article contemplates a claim to priority either by the original applicant or his successor in title, and not by both. Once the right has been assigned there is no reason why the assignor should retain a right of priority. This is consistent with ensuring certainty as to who is entitled to apply, as referred to by Kitchin J in *Edwards Lifesciences*.

**Looking at the issue as a question of substance rather than form, in the present case the inventors did not retain a substantive right as of 5 June 2002.** [*Fujifilm Kyowa Kirin Biologics Company Ltd v Abbvie Biotechnology Ltd*, HP-2015-000053, HP-2016-000016, EWHC 395 (Pat) (EWHC 3/3/2017).]

This holding shows that mere compliance with the formal requirement of Paris Article 4A.(1) to name the same applicant listed in the priority application is insufficient because that does not account for who is entitled to the right of priority when the subsequent application is filed.

*Fujifilm* also explains that entitlement to priority, in a PCT application is not a unitary thing. Instead, entitlement to the priority right depends upon whether the right exists for each country or region the PCT designates. In this instance, the fact that the inventors of the US priority application were named as applicants for the US, even assuming they were the owners of the priority right, would not have helped entitle the other applicant designated as the applicant for the remainder of the PCT countries, to the ROP for those other countries.

*Fujifilm* also explains failure to timely transfer the ROP to the named applicant cannot be cured by Rule 26bis correction to the priority claim. PCT formalities mechanisms cannot cure the substantive defect of lack of entitlement to the ROP, at the time a PCT application is filed.

In summary: the right of priority inures the benefit of the equitable owner of patent rights; must have vested in the applicant of the subsequent application prior before that subsequent application is filed; is unitary to the plurality of entities that filed the priority application but may be shared with additional applicants in a subsequent application; and merely complying with PCT formalities by listing the legal title holder may be insufficient to enjoy the right of priority.

I note that corporate groups that lack clear written policies as to IP rights, and clear employment contract terms about the rights of inventors and to whom those rights are assigned, can have detrimental affects. Hence, the terms of corporate group policies, employment contract terms, and international patent rights are related and affect how to proceed with international patent filings in any particular corporate group situation.

#### **IV. Partial Remedy for missing a filing date: Restoration of Priority**

Restoration of priority refers to the concept of being entitled to priority even though a filing date is outside the time period normally entitled to the priority date of a prior filing. The Patent Law Treaty (PLT) which came into existence about twenty years ago provides for restoration of priority under limited circumstances. The concept of restoration is that, if an

applicant intends to, but fails to, file within the priority period, the applicant may be entitled to priority, effectively extending the priority period. That is what restoration refers to. The conditions under which the priority period can be restored, as a result of a belated filing, are limited.

In 2012, the United States acceded to the Patent Law Treaty (PLT).<sup>1</sup> There are now 39 contracting parties to the PLT. PLT Article 3 requires contracting parties to provide for restoration of priority.

#### **IV.A Types of Application in Which Priority Can be Restored**

PLT Article 3 (1) provides for restoration of priority in national and regional applications for patents for invention, in their divisions, and in PCT applications. PLT Article 3 (1). PLT Article 3 (2) provides for restoration of priority in the corresponding patents.

#### **IV.B Time Limits Applicable to Restoration**

PLT Articles 13 and 14 provide minimum time limits in which an applicant must act to restore priority. PLT Article 13(2); rule 14(4)(a) require the belatedly filed application to be filed within 2 months of the expiration of the priority period. PLT Article 13(2); rule 14(4)(a). PLT Article 13(2)(ii); rule 14(4)(b) (generally) require the request for restoration of priority to be filed within 2 months from expiration of the priority period.

PLT Article 12(1) provides requirements for a request to restore priority.

#### **IV.C Office Findings Required For Restoration**

PLT Article 12(1)(iii) provides that the request to restore priority must state the reasons for the failure to comply with the Paris time limit.

PLT Article 12(1)(iv) provides that the Office (deciding the request to restore priority) must restore priority if it finds that the failure to comply with the time limit occurred in spite of due care required by the circumstances having been taken.

PLT Article 12(1)(iv) also provides that the Office (deciding the request to restore priority) may restore priority if it finds that any delay was unintentional.

The criteria specified in regulations and the Office's analysis of requests for restoration indicate that the "in spite of due care" finding requires a showing that is equivalent to the showings that used to be required in the USPTO for a finding of unavoidable delay. The criteria for an Office to find the delay was in spite of due care are exacting, and very difficult to meet. On the other hand, a showing that the delay was unintentional is normally very easy to meet.

#### **IV.D Restoration Availability and Available Standard**

Not all countries provide for restoration of priority. Of those countries that do provide restoration of priority, not all will restore based upon a finding that the delay was unintentional. In other words, restoration of priority is, at best, a partial remedy for a missed priority date. The following chart shows information compiled from WIPO's web site in 2017 regarding

availability of restoration in the RO's of major patenting jurisdictions.

PCT Receiving Office	RO may find failure was "in spite of due care"/grant restoration under this standard	RO may find failure was unintentional/grant restoration under this standard	RO Fee For Request to Restoration
RO/USA	NO	YES	USD 1700
RO/IB	YES	YES	NO
RO/EP	YES	NO	EUR 640
RO/CN	YES	YES	CNY 1000
RO/JP	YES	NO	NO
RO/BR	NO	NO	N/A
RO/IN	NO	NO	N/A
RO/AU	YES	YES	AUD 200
RO/CA	YES	YES	NO
RO/MX	YES	NO	NO

This chart shows that the ROs of India and Brazil do not provide for restoration. The last time I checked with my Indian and Brazilian counterparts, neither country had any provision for restoring priority. On the other hand, this chart shows that the ROs of Australia, Canada, China, and the US will restore priority based upon a finding that the delay in filing was unintentional. However, this chart shows that the EPO, Japan, and Mexico require a finding that the delay meets the higher "due care" standard.

For those Offices that consider both the due care and unintentional standard, and may find that either is satisfied, normally a request for restoration under the due care standard will be deemed a request for restoration under the unintentional standard, if the Office finds that the requirements for due care were not met. This is certainly true for RO/IB.

The USPTO jettisoned its unavoidable standard for petitions years ago, in order to streamline its activities and avoid having the burden of having to decide fact intensive patterns unrelated to patentability. So now the USPTO will only consider procedural matters under an unintentional standard, but normally charges a substantial fee to grant procedural relief. That is the case for a request to restore priority filed in the USPTO. The USPTO will charge a hefty fee to consider a request for restoration. And the USPTO will only find that the delay was unintentional. A substantial drawback to filing a belated PCT in RO/US is that filing in RO/US precludes a finding under the due care standard. Therefore, a restoration granted by RO/US will never be sufficient to restore priority in Offices which require a finding due care, such as the European Patent Office (EPO) and Japan Patent Office (JPO).

If a United States applicant or resident misses a PCT priority filing date, then the best course of action is for them to obtain a foreign filing license for the PCT application, and then ePCT file that application with RO/IB. This has the benefits of avoiding the hefty USPTO fee and entitling the filer to the possibility of RO/IB restoring priority with a finding due care, so

that this restoration will be effective in all Offices requiring either that higher standard or the lower unintentional delay standard. (Under PCT rule 48, applicants have another shot at restoring priority in each Designated Office (DO) upon national stage entry, but that would require a request to restore priority in each DO in which the restoration before the RO was insufficient.)

#### **IV.E US National Implementation of PLT**

The US has implemented the PLT in various statutory sections to cover all utility and design applications, for claims to both foreign priority and benefit of a United States provisional application. Here is a list by application type and corresponding statutory section.

Application Type	35 USC Section providing for restoration
111(a) claim to Paris priority	35 USC 119(a)
111(a) claim to Provisional benefit	35 USC 119(e)(1)
PCT claim to Paris priority	35 USC 365(e)
Design claim to Paris priority	35 USC 171(b)
International design claim to Paris priority	35 USC 382(c); 385; and 386.

1. See "Review of United States Statutory Implementation of the Patent Law Treaty" Rick Neifeld, November 18, 2013, posted on Neifeld.com.