



# ROTHWELL FIGG

IP Professionals

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## TRANSFER OF PRIORITY RIGHTS IN THE UNITED STATES – GETTING WHAT YOU BOUGHT

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## THE PARIS CONVENTION

### 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.
- (2) ...
- (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.





## PRIORITY RIGHTS UNDER 4A

- “Any person” - not “every person” nor “everyone”.
- “A right of priority” – not “the right of priority”, not “a single right of priority”, not “an indivisible right of priority”.
- The right is created at the time the application is filed, not at the later time when it is relied upon elsewhere.
- Applicants should not be required to prepare their priority application based on what another country or region might require in their national or regional rules for a valid priority claim. By not complying with the PC, Patent Offices are requiring applicants to prepare their priority application based on priority requirements of another country or region.





## PRIORITY RIGHTS UNDER 4A

- Interpreting the PC to have the minimum requirements for claiming priority rights would allow valuable inventions to be protected.
- Requiring that at least all applicants or successors of title of priority applications be applicants is not required for examination because the focus is on the substance, not formalities.
- Concerns about the possibility of multiple patents can be handled in other ways, such as by procedures used in the US as discussed in a later slide.





## THE STATUTE FOR CLAIMING BENEFIT OF FOREIGN ORIGIN APPLICATIONS

### 35 USC 119(a)

#### ***BENEFIT OF EARLIER FILING DATE; RIGHT OF PRIORITY***

An application for patent for an invention filed in this country **by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country** which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within 12 months from the earliest date on which such foreign application was filed.....



## THE STATUTE FOR CLAIMING BENEFIT OF PROVISIONAL APPLICATIONS

### 35 USC 119(e)(1)

#### ***BENEFIT OF EARLIER FILING DATE; RIGHT OF PRIORITY***

(e)(1) An application for patent filed under section 111(a) or section 363 for an invention disclosed in the manner provided by section 112(a) (other than the requirement to disclose the best mode) in a provisional application filed under section 111(b), **by an inventor or inventors named in the provisional application**, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b), if the application for patent filed under section 111(a) or section 363 is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application.....





## THE STATUTE FOR CLAIMING BENEFIT OF NON-PROVISIONAL AND PCT APPLICATIONS

### 35 USC 120

#### *BENEFIT OF EARLIER FILING DATE IN THE UNITED STATES*

An application for patent for an invention disclosed in the manner provided by section 112(a) (other than the requirement to disclose the best mode) in an application previously filed in the United States, or as provided by section 363 or 385 **which names an inventor or joint inventor in the previously filed application** shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application .....





## THE STATUTE FOR CLAIMING BENEFIT OF NON-PROVISIONAL AND PCT APPLICATIONS

### 35 USC 363

#### ***INTERNATIONAL APPLICATION DESIGNATING THE UNITED STATES: EFFECT.***

An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office.

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## RULES

### 37 CFR 1.78 Claiming benefit of earlier filing date ...

(a) *Claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application.* An applicant in a nonprovisional application, ... may claim the benefit of one or more prior-filed provisional applications under the conditions set forth in 35 U.S.C. 119(e) and this section.

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(2) Each prior-filed provisional application **must name the inventor or a joint inventor named in the later-filed application as the inventor or a joint inventor.** In addition, each prior-filed provisional application **must be entitled to a filing date as set forth in § 1.53(c)....**





## RULES

### 37 CFR 1.53 Application number, filing date, and completion of application.

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(c) Application filing requirements — Provisional application.

The filing date of a provisional application is the date on which a specification, **with or without claims**, is received in the Office....

(1) A provisional application **must also include the cover sheet required by § 1.51(c)(1)**, which may be an application data sheet (§ 1.76 ), or a cover letter identifying the application as a provisional application.





## RULES

### 37 CFR 1.51 General requisites of an application.

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- (c) A complete provisional application filed under § 1.53(c) comprises:
- (1) A cover sheet identifying:
    - (i) The application as a provisional application,
    - (ii) **The name or names of the inventor or inventors**, (see § 1.41(a)(2)),
    - (iii) The residence of each named inventor,
    - (iv) The title of the invention, ...
  - (2) A specification as prescribed by 35 U.S.C. 112(a), see § 1.71;
  - (3) Drawings, when necessary, see §§ 1.81 to 1.85; and ...





## RULES

### 37 CFR 1.42 Applicant for patent.

(a) The word "applicant" when used in this title refers to the inventor or all of the joint inventors, or to the person applying for a patent as provided in §§ 1.43, 1.45, or 1.46.

(b) If a person is applying for a patent as provided in § 1.46, the word "applicant" refers to the assignee, the person to whom the inventor is under an obligation to assign the invention, or the person who otherwise shows sufficient proprietary interest in the matter, who is applying for a patent under § 1.46 and not the inventor.

(c) If fewer than all joint inventors are applying for a patent as provided in § 1.45, the phrase "the applicant" means the joint inventors who are applying for the patent without the omitted inventor(s).





## RULES

### **37 CFR 1.42 Applicant for patent. (Continued)**

(d) Any person having authority may deliver an application and fees to the Office on behalf of the applicant. However, an oath or declaration, or substitute statement in lieu of an oath or declaration, may be executed only in accordance with § 1.63 or 1.64, a correspondence address may be provided only in accordance with § 1.33(a), and amendments and other papers must be signed in accordance with § 1.33(b).

(e) **The Office may require additional information where there is a question concerning ownership or interest in an application**, and a showing may be required from the person filing the application that the filing was authorized where such authorization comes into question.





## PROVISIONAL APPLICATIONS

- Only need to disclose one or more inventions with the appropriate detail required by the statutes and the rules.
- Provisional applications need not have claims and thus inventors are named based upon the inventions believed to have been disclosed in the provisional application.
- It is only when a non-provisional application is filed with claims that inventorship can be determined, which may also determine ownership in some situations.





## CLAIMING THE BENEFIT OF FOREIGN ORIGIN AND PROVISIONAL APPLICATIONS

- Must name the inventor(s) of the invention(s) claimed in the non-provisional application, and thus it is possible that only certain inventors listed on the foreign origin or provisional application may be named in the non-provisional application.
- For example: a foreign origin or provisional application disclosing inventions 1 and 2 names inventors A, B, C, D, E, and F, whereby A, B, and C contributed to invention 1, and D, E, and F to invention 2.



## CLAIMING THE BENEFIT OF FOREIGN ORIGIN AND PROVISIONAL APPLICATIONS

- Thus, it would be proper to file two non-provisional applications for inventions 1 and 2, and only name the appropriate inventors for each application, with both claiming priority benefit of the foreign origin or provisional application.
- For priority benefit to be claimed, only a single inventor on the non-provisional application is required to be an applicant on a foreign origin or provisional application for which priority is claimed.
- This prevents an inventor from deciding that a co-inventor should not file a non-provisional application.







## PROCEDURES FOR HANDLING CONTROVERSIES

- The USPTO has rules in place to handle situations in which there is a question as to whether the applicant was entitled to file the application.
- There are also procedures for the situation where there are two owners of a non-provisional application and they cannot agree on how the application should be prosecuted.
- Finally, there are procedures, such as derivation proceedings and post grant review, for situations where there are controversies with respect to who the inventors are.





## TRANSFER OF PRIORITY RIGHTS

### *35 U.S.C. 261 OWNERSHIP; ASSIGNMENT.*

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Applications for patent, patents, **or any interest therein**, shall be assignable in law by an instrument in writing.





# THANK YOU



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