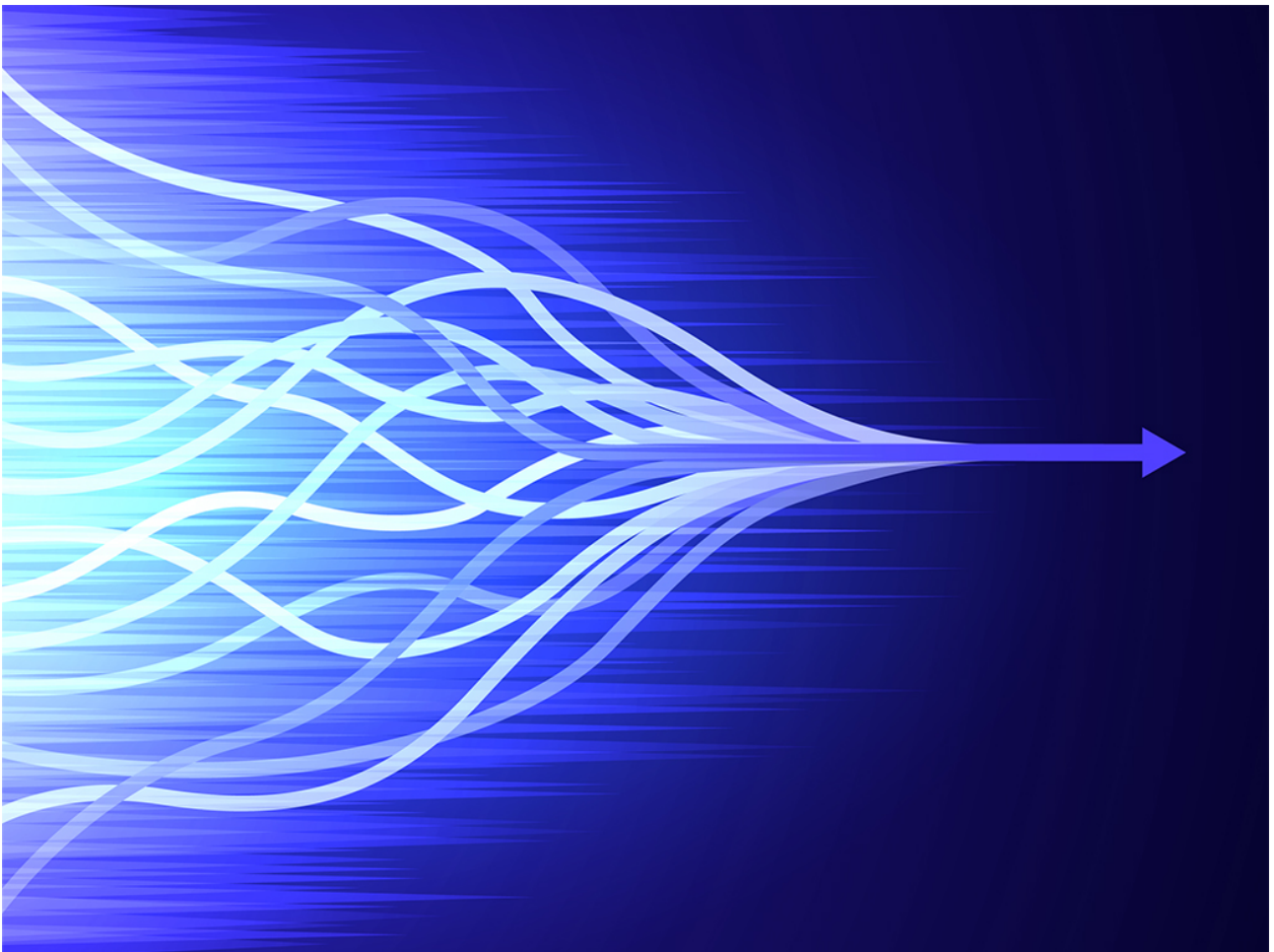


# Convergence of practice

## Common practice as regards accordancy of a date of priority

March 2022



## **Common practice as regards the accordance of a date of priority**

Considering the need for an administrative simplification of the procedure and of the formal requirements governing the accordance of a date of priority;

Considering the advantages for users of the system in terms of legal certainty, transparency and patent information in publishing all the particulars of a declaration of priority with both the patent application and the granted patent;

Considering the growing use of electronic means for the provision, storage, dissemination and exchange of priority documents; taking into account the expanding possibilities for Offices to retrieve priority documents from digital libraries; considering the advantage for users to be able to obtain and submit priority documents in electronic form;

Considering that translations of priority documents are in fact only needed where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable where such an examination is carried out by an Office;

Considering the benefits for users to receive an invitation where deficiencies are noted as to the particulars of the declaration of priority, or where the (certified) copy of the earlier application has not been submitted in due time;

Considering that the risk of a loss of rights with respect to the requirements governing the accordance of a date of priority may be mitigated by means of legal redress provided in accordance with the applicable law;

Considering the advantages for users of an alignment of the periods for adding or correcting the declaration of priority and for submitting a (certified) copy of the earlier application;

Noting that any common practice will be implemented on a voluntary basis;

After consulting the Committee on Patent Law;

The Administrative Council at its meeting on 22 March 2022 approved the following common practice as regards the accordance of a date of priority:

### **Publication of particulars**

Particulars of the declaration of priority (i.e. date of previous filing, file number and country in or for which the earlier application was filed) should be published with both the patent application and the granted patent.

### **Express exemptions from filing priority document**

Express exemptions from the obligation to file a (certified) copy of the earlier application should be provided where the earlier application was filed with the Office concerned or is available to that Office from a digital library which is accepted by the Office for that purpose.

## **Electronic priority documents**

Offices should ensure access to electronic priority documents via digital libraries, such as WIPO Digital Access Service (DAS). Further, they should issue and accept (certified) electronic copies of priority documents.

## **Translations**

Where the earlier application is not in a language accepted by the Office, a translation of the earlier application should only be required where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable where such an examination is carried out by the Office.

Where the earlier application is not in a language accepted by the Office, the option should be provided that instead of filing a translation into a language accepted by the Office, the applicant may submit a declaration that the patent application is a complete translation of the earlier application.

## **Invitations from the Office**

Where a deficiency is noted in accordance with the applicable law as to the particulars of the declaration of priority, or where the (certified) copy of the earlier application has not been filed in due time, the Office should send an invitation to the applicant to remedy the deficiency noted within the relevant period.

## **Means of legal redress**

Offices should provide a means of legal redress in accordance with the applicable law where a loss of rights with respect to the right of priority occurs due to the failure to meet the relevant periods for:

- filing or correcting the declaration of priority,
- responding to an invitation requesting particulars of the declaration of priority,
- filing a (certified) copy of the earlier application or a translation of the earlier application.

## **Period for correction or addition of declaration of priority (priority claim) and period for filing a copy of the earlier application**

Offices should provide for a period for the correction or the addition of a declaration of priority (priority claim) and for the filing of a (certified) copy of the earlier application in line with the provisions of the Patent Cooperation Treaty (Rule 26*bis*.1(a) PCT; Rule 17.1 PCT).

## 1. Background

With the adoption of the Strategic Plan 2023, discussions were launched on a convergence programme aimed at reducing or overcoming differences in administrative practices by setting common practices in identified areas where a more uniform approach would provide the most beneficial results for both users and patent offices. At its 51st meeting, the Committee on Patent Law gave a favourable opinion on the convergence of practice programme (CA/PL 14/19). Accordance of a date of priority was identified as an area for a possible convergence of practice. Pursuant to the working method established by the Committee on Patent Law, a working group, namely Working Group 3 – Accordance of a date of priority, was set up to explore possible common practices in this area. The work of the group was planned to be concluded by the end of 2021.

A call for interest was launched in December 2020, whereupon 22 EPC contracting states and 2 extension states indicated their interest in participating in the discussions of Working Group 3. At its 52nd meeting, the Committee on Patent Law followed the proposal of the Office to have BusinessEurope and epi participating as observers in the discussions of the next convergence Working Groups. Accordingly, BusinessEurope and epi were invited to nominate a representative. The composition of the Working Group was as follows:

Albania (AL), Belgium (BE), Bosnia & Herzegovina (BA), Bulgaria (BG), Croatia (HR), Czech Republic (CZ), Denmark (DK), France (FR), Germany (DE), Greece (GR), Hungary (HU), Italy (IT), Latvia (LV), Monaco (MC), Montenegro (ME), Netherlands (NL), Norway (NO), Portugal (PT), San Marino (SM), Serbia (RS), Spain (ES), Sweden (SE), Turkey (TR), the United Kingdom (GB), epi, BusinessEurope and the European Patent Office (EPO).

In February 2021, the chairperson of the Working Group (a representative of the EPO) issued a detailed questionnaire to identify the administrative practices regarding the different formal requirements concerning the accordance of a date of priority in the participating states and to determine any differences and similarities among these practices. The answers from the participants were compiled in a summary document which served as a basis for the discussions within the Working Group.

The Working Group held four virtual meetings (24 March 2021, 27 April 2021, 17 June 2021 and 15 September 2021). Based on the discussions in these meetings and taking into account the results of the questionnaire, the Working Group identified seven areas where a convergence of practice was considered to particularly benefit both users and patent offices.

On 24 November 2021, at its 53rd meeting, the Committee on Patent Law was provided with an update on the work of Working Group 3.

In parallel to the discussions in the Working Group and in accordance with the methodology agreed by the Committee on Patent Law (see CA/PL 14/19, point 21), users were regularly consulted and updated on the progress of the work via the SACEPO Working Party on Rules on 25 March 2021 and 14 October 2021. In order to further broaden the scope of the consultation process, on 23 September 2021 the EPO organised a virtual discussion platform for the convergence topics of Working Groups 3 and 4. The EPO informed users and offices of the results achieved within the Working Group until then.

At its fourth meeting on 15 September 2021, the Working Group agreed to recommend to the Administrative Council the enclosed common practice as regards the accordancy of a date of priority for adoption and any subsequent voluntary implementation.

At its 170th meeting on 22 March 2022, the Administrative Council approved the proposed common practice as regards the accordancy of a date of priority.

## **2. Explanatory remarks to the common practice**

The Working Group took note of the fact that the implementation of any common practice in the seven identified areas may be subject to a revision of the applicable legal framework. In this regard, it is reiterated that the implementation of any given agreed common practice takes place on a voluntary basis (CA/PL 14/19, point 16). In order for the benefits of the convergence of practice to fully materialise, the aim should be to achieve the implementation of the agreed common practice in as many contracting and extension states as possible.

### **2.1 Publication of the particulars of the declaration of priority**

The results of the questionnaire showed that almost all respondents publish the particulars of the declaration of priority in both the patent application and the granted patent. In only two jurisdictions the particulars are published in either the patent application or in the granted patent. Given this discrepancy, the Working Group agreed to recommend that the particulars of the declaration of priority (i.e. date of previous filing, file number and country in or for which the earlier application was filed) should be published with both the patent application and the granted patent. This was recommended given the advantages for users of the system in terms of legal certainty, transparency and patent information.

### **2.2 Express exemptions from filing the priority document**

The results of the questionnaire showed that in several jurisdictions, applicants are exempt from the obligation of filing a copy of the priority document where the priority document is available from WIPO Digital Access Service (DAS).

The EPO also provides exemptions for applicants from the obligation of filing a copy of the priority document using a priority document exchange system based on bilateral agreements. The EPO includes a copy of the earlier application free of charge in the file of the European patent application for certain types of applications (European patent application, international application filed with the EPO as receiving Office under the PCT, a Chinese or Korean patent or utility model application, or a US provisional or non-provisional patent application).

The responses showed that one jurisdiction provides an exemption for applicants from the obligation of filing a copy of the priority document where it can download the document from PATENTSCOPE. A small number of states indicated that they provide exemptions where the priority document is a PCT application entering the national phase. Finally, in six jurisdictions, exemptions from the obligation of filing a copy of the priority document are provided where the priority document is an application which was previously filed with the Office.

On this basis, the Working Group agreed to recommend that express exemptions from the obligation to file a (certified) copy of the earlier application should be provided where the earlier application was filed with the Office concerned or is available to that Office from a digital library which is accepted by the Office for that purpose. The term "express" implies that the exemptions are explicitly set forth by normative texts such as laws, regulations or Guidelines, or an equivalent text. The aim of this recommendation is to reduce the burden on applicants of providing copies of earlier applications as well as, where applicable, certifications of the copy and of the date of filing. Where the earlier application is filed with an Office, it serves no useful purpose for the applicant to request a copy of the earlier application from that Office and re-file it with the same Office. Similarly, in those circumstances, certification of the copy and of the filing date serves no purpose since it would be that Office which provides the certification.

Moreover, where copies of earlier applications can be obtained by Offices from digital libraries which are accepted for that purpose, such as WIPO-DAS, applicants should also be expressly exempted from filing these copies. This takes into account the expanding possibilities for Offices to retrieve priority documents from digital libraries.

### **2.3 Electronic priority documents**

As regards the retrieval of electronic priority documents, the replies to the questionnaire showed that around half of the Offices currently participate in WIPO Digital Access Service (DAS), whilst a few Offices indicated that they are in the process of joining WIPO DAS.

The results of the questionnaire further showed that not all Offices accept the filing of electronic copies of priority documents. In addition to this, the formal conditions vary, for instance as to whether the applicant must file a certification or whether a qualified electronic signature is needed.

Only four Offices issue certified electronic copies of priority documents. More specifically, these certified electronic copies are provided in PDF format. They are submitted to applicants either by e-mail or via the Office's online portal for download. Most Offices digitally sign these electronic copies. Half of the respondents can provide copies of priority documents in colour, whereas the other half provides electronic copies of priority documents in greyscale only.

Based on these results and considering the growing use of electronic means for the provision, storage, dissemination and exchange of priority documents, the Working Group recommends that Offices should ensure access to electronic priority documents via digital libraries, such as WIPO DAS. Further, they should issue and accept (certified) electronic copies of priority documents as it is particularly advantageous for users to be able to obtain and submit priority documents in electronic form.

### **2.4 Translations of the earlier application**

The results of the questionnaire showed that most jurisdictions require a translation to be filed only where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable. However, some jurisdictions always require a translation to be filed. Furthermore, only five jurisdictions provide an option for applicants to declare that an application claiming priority is a complete translation of the earlier application.

Based on these results, the Working Group, aiming to reduce the burden on applicants, agreed to make the following recommendation: where the earlier application is not in a language accepted by the Office, a translation of the earlier application should only be required where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable where such an examination is carried out by the Office. That is in particular the case where relevant prior art is published between the priority date and the filing date of the application concerned. It is to be noted that this recommendation only applies to Offices conducting a substantive examination process. Non-examining patent Offices participating in the Working Group underlined the need for the public to always have access to a translation so as to be able to verify the validity of the priority claim.

The Working Group also recommends that where the earlier application is not in a language accepted by the Office, the option should be provided that instead of filing a translation into a language accepted by the Office, the applicant may submit a declaration that the patent application is a complete translation of the earlier application. Such a declaration considerably reduces administrative costs and complexity for both the users and Offices. It is to be noted that in some cases a declaration may not be accepted by Offices, in particular if the text of the patent application as filed is not an exact translation of the text of the earlier application, i.e. if for example something has been added or omitted vis-à-vis the text of the earlier application. In such a case, Offices can request the applicant to file a complete translation within the applicable period.

## **2.5 Invitations from the Office**

Where a particular of the declaration of priority has not been provided within the required period, most Offices invite the applicant to provide the information. A few Offices, however, do not provide the applicant with such an invitation. Moreover, where a copy of the earlier application has not been provided within the required period, only half of the Offices invite the applicant to provide the copy.

The Working Group notes that it is beneficial for users to receive an invitation where deficiencies are noted as to the particulars of the declaration of priority, or where the (certified) copy of the earlier application has not been submitted in due time. It therefore recommends that where a deficiency is noted in accordance with the applicable law as to the particulars of the declaration of priority, or where the (certified) copy of the earlier application has not been filed in due time, the Office should send an invitation to the applicant to remedy the deficiency noted within the relevant period.

## **2.6 Means of legal redress**

The results of the questionnaire showed that most jurisdictions do provide a means of legal redress (such as re-establishment of rights, further processing or similar remedies) for failure to observe the period for filing the declaration of priority. However, such a means of legal redress is not provided in five jurisdictions.

Moreover, where the period for correcting the declaration of priority has expired, two thirds of the participating states do not provide any means of legal redress.

Similarly, after the expiration of the period provided for in an invitation to file a missing particular of the declaration of priority, only a select number of states provide for any means of legal redress.

Where a copy of the priority document has not been provided within the required period, half of the Offices invite the applicant to provide the information. After expiration of the period provided for in the invitation, several Offices do not provide for any means of legal redress.

While most Offices provide means of legal redress where the period for filing the translation or declaration that the application is a complete translation of the earlier application is not observed, a few Offices do not provide legal redress in the circumstances.

The Working Group considers that the risk of a loss of rights with respect to the requirements governing the accordane of a date of priority can be mitigated by means of legal redress provided in accordance with national law. It therefore recommends that Offices should provide a means of legal redress in accordance with the applicable law where a loss of rights with respect to the right of priority occurs due to the failure to meet the relevant periods for: filing or correcting the declaration of priority, responding to an invitation requesting particulars of the declaration of priority, filing a (certified) copy of the earlier application or a translation of the earlier application. It is to be noted that this recommendation does not in any way intend to prescribe any particular means of legal redress which are at the choice of the Office in accordance with the applicable national law.

## **2.7 Period for correction or addition of declaration of priority (priority claim) and period for filing a copy of the earlier application**

As regards the period for correction or addition of the declaration of priority and the priority for filing a copy of the earlier application, the results of the questionnaire showed some strong differences between the jurisdictions which can be summarised as follows:

The majority of Offices provide for a period of 16 months from the date of filing of the earlier application for filing the declaration of priority. Relatively few states provide for a period of 12 months from the date of filing of the earlier application. A couple of Offices provide for a period of two months from the date of filing of the national application, whilst one Office provides for a period of six months from that date. One Office indicated that no period is provided for and that the declaration of priority must be made on the request for grant.

As regards the period for correcting the declaration of priority, the majority of Offices provide that it can be corrected within sixteen months from the priority date or, if the correction or addition would cause a change in the priority date, sixteen months from the priority date as changed, whichever sixteen-month period expires first, provided that such a request is filed within four months from the filing date of the national application. Other Offices provide for periods of respectively one, two, three or four months from the date of filing of the national application. Some other Offices set a period of one or two months from the date of invitation of the Office. Finally, an Office outlined that it generally allows for a correction of errors in patent applications to be requested at any point in the application process.



Disparities were also found when it comes to the period for filing a copy of the earlier application. The majority of respondents provide for a period of 16 months from the date of filing of the earlier application. Four Offices provide for a period of three months from the date of filing of the national application, whilst another Office provides for a period of two months from that date. Also showing further disparities, two Offices provide for six months from the filing date or 16 months from the earliest priority date, whichever expires later. One Office provides a period of three months from filing of the national application or 16 months from the earliest priority date, whichever expires earlier. In another Office, the copy is to be preferably filed when filing the national patent application but may also be filed within six months from the date of filing of the national application.

In view of these differences, the Working Group is of the opinion that an alignment of the periods for adding or correcting the declaration of priority and for submitting a (certified) copy of the earlier application would be very advantageous for the users. It therefore recommends that Offices should provide for a period for the correction or the addition of a declaration of priority (priority claim) and for the filing of a (certified) copy of the earlier application in line with the provisions of the Patent Cooperation Treaty (Rule 26bis.1(a) PCT; Rule 17.1 PCT).

The period under Rule 26bis.1(a) PCT for the correction or addition of a priority claim is 16 months from the priority or, where that correction or addition would cause a change in the priority date, 16 months from the priority date as so changed, whichever 16-month period expires first, provided that such a priority claim may be submitted until the expiration of four months from the international filing date. Under Rule 17.1 PCT, the copy of the earlier application shall be submitted no later than 16 months from the date of filing of the earlier application.