

# WIPO



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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**  
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**INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)**

**ASSEMBLY**

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Geneva, September 20 to 29, 1999**

**CLAIMING PRIORITY UNDER THE PATENT COOPERATION TREATY (PCT):  
PROPOSED AMENDMENTS OF THE REGULATIONS**

*Memorandum of the Secretariat*

1. Article 2.1 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) provides that Members of the World Trade Organization (WTO) shall comply with Articles 1 to 12 and 19 of the Paris Convention for the Protection of Industrial Property. This has been taken to mean that a Member of the WTO is obliged to recognize a claim to priority based on an application for a patent or for the registration of a utility model, industrial design or trademark filed in or for (a) a State which is a party to the Paris Convention or (b) any Member of the WTO even if the latter is not a party to the Paris Convention.

2. Express account of this interpretation is taken by Article 6(1)(a) of the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs, adopted on July 2, 1999, which reads:

“The international application may contain a declaration claiming, under Article 4 of the Paris Convention, the priority of one or more earlier applications filed in or for any country party to that Convention or any Member of the World Trade Organization.”

It is to be noted that, while this provision refers to the possibility of claiming priority from an application filed either in a country party to the Paris Convention or in a Member of the WTO, in either case *the claim is made under Article 4 of the Paris Convention*. In other words, where the earlier application was filed in a Member of the WTO which is not a party to the Paris Convention, the claim to priority is considered to be made under Article 4 of the Paris Convention *as applied by Article 2.1 of the TRIPS Agreement*. It is also to be noted that, as stated in the Notes concerning Article 6(1)(a) as presented to the Diplomatic Conference which adopted the Geneva Act (document H/DC/5, paragraph 6.03), this provision would not oblige a Contracting Party which is not a Member of the WTO to recognize the effects of a priority claim based on an application filed in a State that is not party to the Paris Convention. The Geneva Act is, of course, not yet in force.

3. In contrast, the Patent Cooperation Treaty (PCT) (Articles 2(xi) and 8) and its Regulations (Rule 4.10) refer only to the Paris Convention, since the PCT was adopted long before the TRIPS Agreement. The text of those provisions as well as of PCT Rule 26*bis* is given in the Annex.

4. Bearing in mind the remarks in paragraph 2, above, to the effect that, whether the earlier application was filed in a country party to the Paris Convention or in a Member of the WTO, the claim to priority is always made under Article 4 of the Paris Convention, it will be seen that Article 8(1) of the PCT, which provides for a priority claim based on one or more earlier applications filed in or for any country party to the Paris Convention, is not at variance with the notion that, where a PCT Contracting State is also a Member of the WTO, it is under an obligation to recognize a claim to priority even where the earlier application was filed in a Member of the WTO which is not party to the Paris Convention. Furthermore, it is worth noting that, pursuant to Article 8(2) of the PCT, the conditions for, and the effect of, any priority claim declared under Article 8(1) “shall be as provided in Article 4 of the Stockholm Act of the Paris Convention”. Indeed, the according of a priority date where the earlier application was filed in a Member of the WTO which is not a party to the Paris Convention would not conflict with Article 8 of the PCT but would rather be complementary to it since priority claims made under the TRIPS Agreement are in fact made under Article 4 of the Paris Convention.

5. Since July 1, 1998, the date on which PCT Rule 26*bis* entered into force, where an international application contains a priority claim based on an earlier application filed in a Member of the WTO that is not a party to the Paris Convention, such a priority claim is, as a result of the procedure provided for by that Rule, considered not to have been made. However, upon request of the applicant and subject to certain conditions, information about such a priority claim is published together with the international application, which makes it easier for the designated States that are bound by Article 2.1 of the TRIPS Agreement to fulfil their obligation, under that Article, to recognize the priority regardless of the procedural treatment of that priority claim for the purposes of the PCT international phase.

6. In view of the fact that most of the Members of the WTO that are not yet bound by Article 2.1 of the TRIPS Agreement will become bound by that Article on January 1, 2000, and in order to ease the burden on applicants claiming a priority which a large number of PCT Contracting States must recognize if they are bound by Article 2.1 of the TRIPS Agreement, it would seem to be appropriate to permit applicants, as from that date, to include such priority claims in their international applications, on the understanding that a PCT Contracting State that is not a Member of the WTO would not be obliged to recognize its effects.

7. It should, however, be noted that the priority date, as defined in Article 2(xi) of the PCT, is used for computing a number of time limits under the PCT, for example, in connection with international publication, with elections of States in order to delay entry into the national phase, and with the entry itself into the national phase. If the proposed amendments are adopted, and if an international application claims the priority of an earlier application filed in a Member of the WTO that is not party to the Paris Convention, even the PCT Contracting States that are not Members of the WTO will be affected by the priority date to the extent that the above-mentioned time limits are computed on the basis of that date.

8. In conclusion, it is proposed to amend Rule 4.10 to read as follows:

“4.10 *Priority Claim*

(a) Any declaration referred to in Article 8(1) (“priority claim”) may claim the priority of one or more earlier applications filed either in or for any country party to the Paris Convention for the Protection of Industrial Property or in or for any Member of the World Trade Organization that is not party to that Convention. Any priority claim shall, subject to Rule 26bis.1, be made in the request; it shall consist of a statement to the effect that the priority of an earlier application is claimed and shall indicate:

(i) the date on which the earlier application was filed, being a date falling within the period of 12 months preceding the international filing date;

(ii) the number of the earlier application;

(iii) where the earlier application is a national application, the country party to the Paris Convention for the Protection of Industrial Property or the Member of the World Trade Organization that is not party to that Convention in which it was filed;

(iv) where the earlier application is a regional application, the authority entrusted with the granting of regional patents under the applicable regional patent treaty;

(v) where the earlier application is an international application, the receiving Office with which it was filed.

(b) In addition to any indication required under paragraph (a)(iv) or (v):

(i) where the earlier application is a regional application or an international application, the priority claim may indicate one or more countries party to the Paris Convention for the Protection of Industrial Property for which that earlier application was filed;

(ii) where the earlier application is a regional application and at least one of the countries party to the regional patent treaty ~~are not all~~ is neither party to the Paris Convention for the Protection of Industrial Property nor a Member of the World Trade Organization, the priority claim shall indicate at least one country party to that Convention or one Member of that Organization for which that earlier application was filed.

(c) For the purposes of paragraphs (a) and (b), Article 2(vi) shall not apply.”

*9. The Assembly of the PCT Union is invited to adopt the amendments to Rule 4.10 proposed in paragraph 8, above, and to decide that those amendments shall enter into force on January 1, 2000.*

[Annex follows]

ANNEX

PROVISIONS OF THE PCT AND ITS REGULATIONS  
THAT CONCERN PRIORITY

**Article 2**  
**Definitions**

For the purposes of this Treaty and the Regulations and unless expressly stated otherwise:

[...]

(xi) “priority date,” for the purposes of computing time limits, means:

(a) where the international application contains a priority claim under Article 8, the filing date of the application whose priority is so claimed;

(b) where the international application contains several priority claims under Article 8, the filing date of the earliest application whose priority is so claimed;

(c) where the international application does not contain any priority claim under Article 8, the international filing date of such application;

[...]

**Article 8**  
**Claiming Priority**

(1) The international application may contain a declaration, as prescribed in the Regulations, claiming the priority of one or more earlier applications filed in or for any country party to the Paris Convention for the Protection of Industrial Property.

(2)(a) Subject to the provisions of subparagraph (b), the conditions for, and the effect of, any priority claim declared under paragraph (1) shall be as provided in Article 4 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property.

(b) The international application for which the priority of one or more earlier applications filed in or for a Contracting State is claimed may contain the designation of that State. Where, in the international application, the priority of one or more national applications filed in or for a designated State is claimed, or where the priority of an international application having designated only one State is claimed, the conditions for, and the effect of, the priority claim in that State shall be governed by the national law of that State.

**Rule 4**  
**The Request (Contents)**

[...]

4.10 *Priority Claim*

(a) Any declaration referred to in Article 8(1) (“priority claim”) shall, subject to Rule 26bis.1, be made in the request; it shall consist of a statement to the effect that the priority of an earlier application is claimed and shall indicate:

(i) the date on which the earlier application was filed, being a date falling within the period of 12 months preceding the international filing date;

(ii) the number of the earlier application;

(iii) where the earlier application is a national application, the country party to the Paris Convention for the Protection of Industrial Property in which it was filed;

(iv) where the earlier application is a regional application, the authority entrusted with the granting of regional patents under the applicable regional patent treaty;

(v) where the earlier application is an international application, the receiving Office with which it was filed.

(b) In addition to any indication required under paragraph (a)(iv) or (v):

(i) where the earlier application is a regional application or an international application, the priority claim may indicate one or more countries party to the Paris Convention for the Protection of Industrial Property for which that earlier application was filed;

(ii) where the earlier application is a regional application and the countries party to the regional patent treaty are not all party to the Paris Convention for the Protection of Industrial Property, the priority claim shall indicate at least one country party to that Convention for which that earlier application was filed.

(c) For the purposes of paragraphs (a) and (b), Article 2(vi) shall not apply.

[...]

**Rule 26bis**  
**Correction or Addition of Priority Claim**

26bis.1 *Correction or Addition of Priority Claim*

(a) The applicant may correct or add a priority claim by a notice submitted to the receiving Office or the International Bureau within a time limit of 16 months from the priority date or, where the 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 notice may be submitted until the expiration of four months from the international filing date. The correction of a priority claim may include the addition of any indication referred to in Rule 4.10.

(b) Any notice referred to in paragraph (a) received by the receiving Office or the International Bureau after the applicant has made a request for early publication under

Article 21(2)(b) shall be considered not to have been submitted, unless that request is withdrawn before the technical preparations for international publication have been completed.

(c) Where the correction or addition of a priority claim causes a change in the priority date, any time limit which is computed from the previously applicable priority date and which has not already expired shall be computed from the priority date as so changed.

*26bis.2 Invitation to Correct Defects in Priority Claims*

(a) Where the receiving Office or, if the receiving Office fails to do so, the International Bureau, finds that a priority claim does not comply with the requirements of Rule 4.10 or that any indication in a priority claim is not the same as the corresponding indication appearing in the priority document, the receiving Office or the International Bureau, as the case may be, shall invite the applicant to correct the priority claim.

(b) If, in response to an invitation under paragraph (a), the applicant does not, before the expiration of the time limit under Rule 26bis.1(a), submit a notice correcting the priority claim so as to comply with the requirements of Rule 4.10, that priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made and the receiving Office or the International Bureau, as the case may be, shall so declare and shall inform the applicant accordingly, provided that a priority claim shall not be considered not to have been made only because the indication of the number of the earlier application referred to in Rule 4.10(a)(ii) is missing or because an indication in the priority claim is not the same as the corresponding indication appearing in the priority document.

(c) Where the receiving Office or the International Bureau has made a declaration under paragraph (b), the International Bureau shall, upon request made by the applicant and received by the International Bureau prior to the completion of the technical preparations for international publication, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish, together with the international application, information concerning the priority claim which was considered not to have been made. A copy of that request shall be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3).

[End of Annex and of document]