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ASSEMBLY

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PCT RULE 4.10 (d)
(PRIORITY CLAIM)

Memorandum prepared by the International Bureau

1. Under PCT Rule 4.10(d), if the filing date of an earlier application as indicated in the request does not fall within the period of one year preceding the international filing date, the applicant is invited either to cancel the declaration made under PCT Article 8(1) or, if the date of the earlier application was indicated erroneously, to correct the date so indicated. If the applicant fails to act accordingly within one month from the date of the invitation, the declaration made under PCT Article 8(1) is cancelled ex officio.
2. The question has recently arisen as to whether an invitation under PCT Rule 4.10(d) must be issued if the relevant declaration under PCT Article 8(1) relates to another application whose filing date is the same as the international filing date.

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3. Under PCT Article 8(1), the priority may be claimed of “one or more earlier applications filed in or for any country party to the Paris Convention for the Protection of Industrial Property” PCT Article 8(2)(a) makes it clear that, in general, “the conditions for, and the effect of, any priority claim declared under [PCT Article 8(1)] shall be as provided for in Article 4 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property”. That Article of the Paris Convention refers to “any subsequent filing” (Article 4B), “subsequent application” (Articles 4C(4), 4D(3) and 4F) and “previous application” (Article 4C(4)) as well as “previous filing” (Article 4D(1) and (5)). Furthermore, it is clear from Article 4A(1) of the Paris Convention that the right of priority is enjoyed only during the period fixed in that Convention, the relevant period being twelve months as fixed in Article 4C(1). It should be noted, however, that Article 4C(2) of the Paris Convention expressly provides that the period “shall start from the date of filing of the [priority] application” but that the day of filing shall not be included in the period”. The Paris Convention contains no express reference to the possibility of claiming priority of an application filed earlier on the same day as the application claiming priority.

4. The provisions of the PCT and the Paris Convention referred to in the preceding paragraph appear to allow different interpretations. On one view, they could be interpreted as indicating that a “same day” filing does not fall under the scope of the priority provisions of the Paris Convention (and hence of the PCT). This view would regard the word “previous” as indicating that the application used as the basis for priority needs to have been filed on a previous day rather than at a previous time, and might be supported by Article 4C(2) of the Paris Convention according to which the day of filing (of the priority application) is not to be included in the priority period. Such a view would reflect the repeated references in the Paris Convention to the “date” of filing rather than the “time” of filing. It would also avoid difficulties which might arise in ascertaining which was the earlier of two applications filed in different geographical time zones.

5. Moreover, while Article 4 of the Paris Convention makes a number of references to applications or filings using the words “previous” and “subsequent,” unqualified by a restriction referring to a previous or subsequent date, certain provisions in Article 4 of the Paris Convention seem to operate on the assumption that it is the date and not the precise time of filing which is important. For example, the second sentence of Article 4B of the Paris Convention only reserves the rights of third parties if they were acquired before the date (not the time) of the first application. In addition, if a claim for priority of an application filed on the same day were admitted, it is not clear what practical benefit could arise from such a situation, since prior art is generally citable against an application only if it became available earlier than the date of filing the application in respect of which patentability is being determined (cf. the relevant words of PCT Rule 33.1(a): “provided that the making available occurred prior to the international filing date”; the same approach has been adopted in Article 11(2)(b) of the draft Patent Law Treaty, see document PLT/DC/3, page 21).

6. On another view, the words “earlier” and “previous” should be accorded their ordinary meanings so as to apply to any application filed at an earlier time. Under this interpretation, Article 4C(2) of the Paris Convention should be read as excluding the day of filing (of the priority application) from the priority period only for the purposes of computing the end, and not the beginning, of the period during which the priority right is to be enjoyed by the applicant.

7. It is noted that, under PCT Article 27(5), “nothing in this Treaty and the Regulations is intended to be construed as prescribing anything that would limit the freedom of each Contracting State to prescribe such substantive conditions of patentability as it desires. In particular, any provision in this Treaty and the Regulations concerning the definition of prior art is exclusively for the purposes of the international procedure and, consequently, any Contracting State is free to apply, when determining the patentability of an invention claimed in an international application, the criteria of its national law in respect of prior art and other conditions of patentability not constituting requirements as to the form and contents of applications.”

8. It seems that the provisions of PCT Article 27(5) can be interpreted as permitting national law to take into account, for the purposes of ascertaining the prior art, an application filed earlier on the same day as the application in respect of which patentability is being determined. If any Contracting State adopts such an interpretation in practice, the disallowance during the international phase of a claim of priority based on an application filed earlier the same day, would entail the rejection of the later application in that Contracting State if that Contracting State does not have a rule against self-collision and if neither application is withdrawn before publication. On the other hand, the International Bureau is not aware of any PCT Contracting State having adopted the above-mentioned interpretation. Nor is it aware of any provision of any national law which would afford any particular advantage to the applicant in a case where priority is claimed from a “same day” filing.

9. In considering the questions raised in the specific context of PCT Rule 4.10(d), it must be borne in mind that a priority claim made in an international application serves two purposes. First, it has effect in the national phase as a priority claim under national law. Second, it serves as the basis of the computation of a wide variety of time limits under the PCT procedure. For neither of these purposes does any substantive assessment need to be made in the international phase of the validity of the priority claim, a matter which is ultimately for the national law, giving proper effect to the Paris Convention. On the other hand, to be permitted to stand as a priority claim under the PCT, there should be no evident conflict with the Paris Convention and there should also be as little uncertainty as possible.

10. Should the Assembly agree with the second view outlined in paragraph 6, above, or should it at least not exclude it, it may be desirable to amend PCT Rule 4.10 so as to leave it open during the international phase whether, in case priority is claimed, the filing date of the earlier application may be the same as the international filing date. As a consequence, it would be up to the national law of each designated State to give an answer to that question.

11. A new paragraph (d-bis) could be added to PCT Rule 4.10 with the following wording:

“(d-bis) For the purposes of paragraph (d), the filing date of the earlier application shall be considered by the receiving Office and the International Bureau as falling within the period of one year preceding the international filing date even where the filing date of the earlier application is the same date as the international filing date. It

12. The Assembly is invited to consider the questions raised in this document and to take a decision thereon.

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