

## **Patent Cooperation Treaty (PCT) Working Group**

**Eighth Session**  
**Geneva, May 26 to 29, 2015**

### **SAME DAY PRIORITY CLAIMS**

*Document prepared by the International Bureau*

#### **SUMMARY**

1. In the context of discussions on the issue of incorporation by reference of missing parts, the question has arisen whether a priority claim contained in an international application based on an earlier application which has the same filing date as the international application (“same day priority claim”) is a valid priority claim under the Paris Convention and thus the PCT. The present document outlines a number of options as to possible ways to address the apparent differences in interpretation of the Paris Convention as to whether same day priority claims are permitted.

2. The Meeting of International Authorities under the PCT (PCT/MIA) discussed the matter of same day priority claims at its twenty-second session, held in Tokyo from February 4 to 6, 2015. These discussions are summarized in the Summary by the Chair (paragraphs 92 to 97 of document PCT/MIA/22/22, reproduced in the Annex to document PCT/WG/8/2).

#### **BACKGROUND**

3. The Working Group, at its sixth and seventh sessions, discussed how to address the apparently different interpretation by receiving Offices and designated/elected Offices of the provisions of Rules 4.18 and 20.5 and 20.6 with regard to the incorporation by reference of missing parts (see documents PCT/WG/6/20 and PCT/WG/7/19). In the context of those discussions, the question arose whether a same day priority claim is a valid priority claim under the Paris Convention and thus the PCT.

4. The responses received in reply to a questionnaire sent by the International Bureau to all Member States on the issue of incorporation by reference of missing parts, which also covered the issue of same day priority claims, showed that there is no consensus among Member States on this issue. While recognizing that the competent WIPO body for taking a decision on the matter would be the Assembly of the Paris Union, the Working Group at its seventh session nevertheless requested the International Bureau to prepare a working document on the issue of same day priority claims for consideration by the Working Group at its present session.

## **SAME DAY PRIORITY CLAIMS**

### **EARLIER DISCUSSION BY PCT UNION ASSEMBLY**

5. The issue of same day priority claims has been previously discussed (albeit inconclusively) by PCT Member States during the eighteenth session of the PCT Union Assembly, held in Geneva in July 1991, based on a document prepared by the International Bureau (document PCT/A/XVIII/4). Unfortunately, the PCT Union Assembly at its eighteenth session in July 1991 did not decide on the issue, due to a lack of time. For ease of reference, the document will be made available to the Working Group in the form of a non-paper; it is also available from the WIPO web site at [http://www.wipo.int/meetings/en/details.jsp?meeting\\_id=35593](http://www.wipo.int/meetings/en/details.jsp?meeting_id=35593).

### **TODAY'S SITUATION**

6. In the view of the International Bureau, for the most part, the same considerations as those set out in document PCT/A/XVIII/4 should guide the discussions on the issue today.

7. However, compared to the situation back in 1991, it would appear that one specific assumption which formed the basis for the considerations set out in paragraph 5 and 8 of document PCT/A/XVIII/4 has changed. Specifically, as the discussions on the issue of incorporation by reference of missing parts have revealed, today, a number of Offices of PCT Contracting States, in their capacity as both receiving Offices and designated Offices, have adopted the interpretation that same day priority claims are to be permitted under the Paris Convention and thus the PCT.

8. Consequently, today, PCT applicants relying on such an interpretation by a receiving Office do gain a "practical benefit" from such interpretation, as it allows them to incorporate by reference a missing element or part contained in such an "earlier" application filed on the same day as the international application (noting that the inclusion in the international application of a priority claim to such an earlier application is a requirement for validly requesting incorporation by reference of missing elements or parts).

9. On the other hand, the responses by Member States received in reply to the questionnaire clearly revealed that the interpretation of the Paris Convention that same day priority claims are to be permitted under the Paris Convention (and thus the PCT) is not shared by all Offices. Thus, today, applicants depend on the interpretation by the receiving Office with which the application is filed and by designated Offices and their applicable national laws as to the "fate" of any same day priority claim contained in the international application. The results can be summarized as follows:

	Position of Receiving Office	
	Allows Same Day Priority Claim	Does Not Allow Same Day Priority Claim
<b>Effect in international phase</b> <i>priority claim</i> <i>incorporation by reference</i> <i>international search</i>	Remains on file. Permitted (unless RO has notified under Rule 20.8(a)). Takes into account any incorporation by reference.	Declared void. Not possible. Takes place on the basis of the international application as actually filed.
<b>Risks for applicants in national phase</b> <i>priority claim</i>  <i>incorporation by reference</i>	May be declared invalid in some designated Offices (causing administrative work for Office and applicant of no practical value), but has no substantive effect in the absence of incorporation by reference.  May be found invalid, even in Offices normally allowing incorporation – either effective filing date would change or material incorporated by reference would be ignored.	Options for restoration of priority claim need to be followed up in each designated Office (no substantive effect – only necessary if incorporation by reference required to fix errors).  Would need to be considered separately in each designated Office permitting both restoration of the same day priority claim and incorporation by reference.

10. The number of same day priority claims made is relatively small (just over 200 in 2013), the largest numbers coming (in decreasing order) from the receiving Offices of the Republic of Korea, the United States of America and China. Of these, it appears that, in 2013, only two cases have been the subject of confirmations of incorporation by reference. Consequently, it can be seen that the scale of the issue is small and should not put a major burden on receiving Offices or designated Offices. Nevertheless, the instrument of “incorporation by reference” is used and important to a few applicants.

#### OPTIONS

11. The following paragraphs look into the four main possible options which appear to exist as to how to address the apparent differences in interpretation of the Paris Convention by Offices of PCT Member States as to whether same day priority claims are permitted.

##### Option 1: Refer the Matter to the Paris Union Assembly

12. The first option for PCT Member States would be for the PCT Union Assembly to refer the matter to the Paris Union Assembly to seek a common interpretation of Article 4 of the Paris Convention by all Paris Union Member States. When making the referral, the PCT Union Assembly could optionally make a recommendation to the Paris Union Assembly on this matter. It has to be noted, though, that the divergent views expressed by PCT Contracting States in reply to the questionnaire suggest that achieving such an agreement would require further clarifications and discussions.

13. If the matter were to be referred to the Paris Union Assembly, one possibility for the Paris Union Assembly would be to adopt a common Understanding as to how to interpret the Paris Convention with regard to same day priority claims.

14. The alternative to adopting a common Understanding would be for the Paris Union to formally amend Article 4 of the Paris Convention. For any such formal amendment of the Paris Convention, a Revision Conference would have to be convened, and a unanimous vote of all of all States participating in a Revision Conference would be required<sup>1</sup>. Furthermore, noting that the issue of how to interpret Article 4 of the Paris Convention, in particular its provisions regarding the “priority period” set out in Article 4(C), also concerns industrial designs and trademarks, pursuant to Article 13(2)(b) of the Paris Convention<sup>2</sup>, any decision of the Paris Union Assembly could only be taken after having taken the advice of the Coordination Committee, as the issue would clearly also be “of interest” to the Hague Union and the Madrid Union, respectively.

15. Any revised Act of the Convention so agreed would have to be ratified or acceded to by a number of States already members to an earlier Act of the Paris Convention—the exact number to be determined by the Revision Conference—before it would enter into force.

16. Clearly, thus, a formal revision of the Paris Convention would be a cumbersome and lengthy procedure and might be considered disproportionate to the size of the problem.

#### Option 2: Have the PCT Union Assembly Decide on the Matter

17. A second possible option might be to seek an agreement among PCT Member States on how to interpret the Paris Convention with regard to same day priority claims, with effect for international applications. In this context, several questions arise.

#### *Competency of PCT Assembly*

18. The first question is whether the PCT Union Assembly would be competent to deal with this matter. The answer to that question appears to be largely a matter of interpretation. On the one hand, PCT Article 53(2)(a)(ii), according to which the PCT Assembly “shall deal with all matters concerning ... the implementation of this Treaty”, could be interpreted as providing the basis for any decision by the PCT Assembly on this matter, given that the PCT Treaty and the Regulations contain certain provisions dealing with priority matters.

19. On the other hand, with regard to the main issues concerning the right of priority, namely, the conditions for and the effect of any priority claim contained in an international application, PCT Article 8(2)(a) simply refers to Article 4 of the Paris Convention. It could thus be argued that the issue at hand does not concern the implementation of the PCT but only the implementation of the Paris Convention, and that it should thus only be dealt with by the Paris Union Assembly (see Article 13(2)(a)(i) of the Paris Convention). That argument appears to be further supported by the fact that the requirement for all PCT Member States to respect and apply the provisions of the Paris Convention does not appear to be based on the fact that they are Member States of the PCT but on the fact that they are (and must be, see PCT Article 62(1)) Member States of the Paris Union.

<sup>1</sup> While Article 18 of the Paris Convention is silent on the question as to the majority required to amend any of the Articles of the Paris Convention other than Articles 13 to 17 (with regard to those Article, see Article 17 of the Paris Convention), Bodenhausen, in his “Guide to the Application of the Paris Convention for the Protection of Industrial Property” (WIPO Publication No. 611), speaks of the “established rule considered by the various Revision Conferences that a unanimous vote of all States participating in such Conferences ... was necessary for revision of all of the provisions of the Convention (under the Stockholm text, with the exception of Articles 13 to 17: see Article 17). This established rule must be considered binding on the Union until changed by a contrary provision adopted under the same rule.”

<sup>2</sup> Article 13(2)(b) of the Paris Convention: “With respect to matters which are of interest also to other Unions administered by the Organization, the Assembly shall make its decisions after having heard the advice of the Coordination Committee of the Organization.”

20. Again, any decision of the PCT Assembly could only be taken after having taken the advice of the Coordination Committee.

#### *Scope of PCT Assembly Decision*

21. The second question which arises in this context—if the PCT Union Assembly were to be seen as competent to address the question as to how to interpret Article 4 of the Paris Convention with regard to same day priority claims in the context of the PCT—is whether the PCT Union Assembly could address that issue with effect for both the international phase and the national phase of the PCT procedure, or whether it would be limited to address that issue with effect for the international phase only.

22. That question appears to boil down to the question as to whether the provisions in the PCT Treaty and the Regulations dealing with priority issues, in particular the provisions of PCT Article 8(2)(a), are “requirements relating to the form or contents of the international application” (PCT Article 27(1)), or whether they are provisions relating to “substantive conditions of patentability ... concerning the definition of prior art” (PCT Article 27(5)). In the case of the former (“form or contents”), the PCT Union Assembly—if considered competent—could adopt a common interpretation of the Paris Convention with effect for both the international and the national phases of the PCT procedure, in line with PCT Article 27(1). In the case of the latter (“substance”), however, the PCT Union Assembly could adopt such an interpretation only with regard to the international phase of the PCT procedure and would have to leave the matter, as far as the national phase is concerned, to the national law applicable by the designated Offices concerned, noting the clear wording of PCT Article 27(5).

23. While the answer to the above question again would appear to be largely a matter of interpretation, it would appear reasonable to argue that the question as to what constitutes a prior art disclosure for the purposes of novelty, for instance, is a substantive condition of patentability, that an earlier disclosure on the same day as the patent filing could amount to prior art (as paragraph 8 of document PCT/A/XVIII/4 has argued), and that the provisions dealing with the “periods of priority” set out in Article 4(C) of the Paris Convention, incorporated by reference into the PCT by virtue of PCT Article 8(2)(a), are thus indeed provisions setting out “substantive conditions of patentability ... concerning the definition of prior art” within the meaning of PCT Article 27(5).

24. If so, the PCT Union Assembly could not address how to interpret Article 4 of the Paris Convention with effect for both the international phase and the national phase of the PCT procedure. Rather, it would be—in accordance with Article 27(5)—within the freedom of each PCT Contracting State to prescribe, when determining the patentability of an invention claimed in an international application, the criteria of its national law as to how to define the term “period of priority” and thus the “fate” of same day priority claims

25. Another way to look at the question at hand would be to argue that the provisions of PCT Article 8(2)(a) simply don't fit into the categories “form or contents” or “substance” within the meaning of PCT Articles 27(1) and (5), respectively, and that PCT Article 8(2)(a) should simply be seen as what it is, namely, a simple reference to the provisions of the Paris Convention. If one were to follow this line of argument, the most plausible action in the case of doubt on how to give proper effect to a provision of the Paris Convention would appear to be to refer that matter to the Paris Union Assembly as the (only) competent decision-making body.

#### *Desirability of PCT Assembly Decision*

26. The third and final question arising in this context is whether it would even be desirable to seek such an agreement by PCT Member States only, that is, by only a “subset” of Member States of the Paris Union Assembly.

27. Noting the importance of the consideration set out in paragraph 9 of document PCT/A/XVIII/4 that “there should be no evident conflict with the Paris Convention and there should also be as little uncertainty as possible”, it would appear that having only a subset of Paris Union Assembly members agree on a common interpretation of the Paris Convention would do little to overcome the uncertainty on the interpretation of the Paris Convention with regard to same day priority claims.

28. Moreover, having only a subset of all Paris Union Assembly members agree on a common interpretation of the Paris Convention, even if with effect for both the international phase and the national phase of the PCT procedure, would do little to reduce the complexity of the international patent system for both applicants and Offices, as it would not address the issue in a comprehensive manner for both national (Paris Convention) and international (PCT) filings, and independently of the capacity (national or international) in which an Office acted. Such a comprehensive solution could only be achieved by an agreed common interpretation of the Paris Convention by the Paris Union Assembly.

#### Option 3: Amend the PCT Regulations to Prepare Ground for Decision on the Matter by Designated Offices in the National Phase

29. A third possible option—in line with the considerations set out in paragraph 9 of document PCT/A/XVIII/4 as to the need for a substantive assessment in the international phase of the validity of a priority claim—would be to at least put an end to the differing practices of receiving Offices with regard to same day priority claims. The PCT Regulations could be amended to expressly require receiving Offices to *not* cancel any same day priority claim, so as to prepare the ground for decisions on the matter to be taken by designated Offices in the national phase of the PCT procedure, under the applicable national laws, similar to what had been proposed and discussed in 1991. All applicants would thus be on an “equal footing” with regard to the validity of same day priority claims for the purposes of the international phase, no matter what receiving Office had been used to file the international application.

30. Under this option, in the absence of a formal revision of the Paris Convention (see option 1, above), the final decision on whether same day priority claims were to be permitted under the Paris Convention would still be left to the national law of each designated State. This option would thus retain all the complexity referred to in paragraph 9, above, for both applicants and Offices, as it would not address the issue of same day priority claims in a comprehensive manner with effect for both the international and national phase of the PCT procedure; it would also not address the issue with effect for national (Paris Convention) filings.

31. On the other hand, noting the considerations set out in paragraphs 12 to 16, above, it would appear that this option, despite those shortcomings, could be considered to be the most realistic way to proceed, at least in the short term.

#### Option 4: Leave Interpretation to Individual Receiving Offices

32. A fourth and final option would be to do nothing and leave the current situation described in paragraph 9, above, “as is”, leaving the “fate” of same day priority claims, as far as the international phase is concerned, to the interpretation of the receiving Office with which the international application is filed and, as far as the national phase is concerned, to the differing interpretations by the designated Offices pursuant to applicable national laws. If this approach is taken, it may nevertheless be desirable to modify the PCT Receiving Office Guidelines and Applicant’s Guide to indicate that this is an area where practices vary between receiving Offices.

33. *The Working Group is invited to comment on the issues set out in this document.*

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