

PATENT PRIMER

Priority patent applications

Philip M. Webber

The Paris Convention allows an inventor to file an initial 'priority' patent application and then to file foreign patent applications on the basis of that 'priority' application up to 1 year later. This year gives the inventor time to evaluate the invention before committing to the expense of filing foreign patent applications.

Paris Convention

Under the Paris Convention (BOX), an inventor can file an initial patent application (a 'priority application') at one patent office (usually the patentee's own country's) and then — within 1 year — file patent applications in other countries on the basis of that priority application. After a priority application has been filed, any public disclosure of the invention that is defined in that priority application will not affect the validity (for example, the novelty or inventive step) of any later patent applications, but only if those later patent applications define the invention in the same terms that were used in the priority application and those later patent applications were filed within the 1-year period.

Advice should be taken regarding where the first priority application is filed because a number of countries have strict laws on this subject. For example, US 'citizens' must file their first priority applications at the US Patent and Trademark Office; other countries have laws applying to 'residents' of that country.

This 'priority year' provides a number of benefits, the most important of which are described below.

Further development time

The priority year allows time for the inventor to develop the invention further. This time can be used to obtain more experimental data to support the patent application or to refine more precisely the aspects of the invention that are likely to be the most commercially important and, therefore, where the claims of the patent application should be directed. If further experimental data are produced, one or more further priority applications can be filed in the priority year, on the basis of the text of the first priority application but including the additional new data.

Potential investors

For lone inventors and small companies, the priority year provides time to seek investment. Up to this time, the patenting expenses will probably have been limited to the drafting and filing of the priority application. If further patent applications are envisaged, possibly in a number of foreign countries, financial support for this endeavour may need to be secured.

Early search and examination

In some countries, it is possible to have the priority application searched and examined

by the patent office within the priority year. This can give the inventor (and potential investors) a useful early indication of whether or not patents are likely to be granted in due course in other countries — that is, before the expense of filing numerous foreign patent applications is incurred. For example, the UK Patent Office can usually produce a Search and Examination Report on the merits of the invention within 3–6 months of the filing date of the priority application. Such reports often highlight relevant disclosures ('prior art') of which the inventor was unaware; and the claims of any later applications can be amended to take this prior art into consideration.

The end of the priority year

At the end of the priority year, the text to be used for any further patent applications has to be finalized. This text can include all available experimental data which supports the invention; and the description and claims can be tailored to take into account all prior art known to the inventor at that time. Once the text is finalized and further patent applications are filed on the basis of it, no new material can be added to it (although amendments can be made later under specified circumstances). These further patent applications should claim priority from all of the priority applications that were filed in the preceding year.

Further patent applications

A further question then arises: where should the further patent applications be filed? The inventor has the choice of an international (PCT) application, regional applications (such as a European patent application) and one or more national (that is, single-country) patent applications. The inventor should particularly take into consideration the locations of the main markets for the invention and of potential infringers. Costs also need to be considered, because patent attorney fees and patent office fees will be payable for each further patent application.

Philip M. Webber is at Frank B. Dehn & Co., Patent and Trademark Attorneys, 179 Queen Victoria Street, London, EC4V 4EL, England. e-mail: philipw@frankbdehn.com Website: www.frankbdehn.com

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THE PARIS CONVENTION

The Paris Convention for the Protection of Industrial Property (1883) established a number of common rules for the protection of patents, trademarks and designs, including a right of priority. Article 4A(1) states that "Any person who has duly filed an application for a patent ... shall enjoy, for the purpose of filing in the other countries, a right of priority..." Article 4C sets the patent priority period as 12 months. Article 4B states that "any subsequent filing in any of the other countries of the [Convention] before the expiration [of the 12 month period] shall not be invalidated by reason of any acts accomplished in the interval, in particular, ... the publication or exploitation of the invention..."

For example, a UK inventor could file a priority application at the UK Patent Office and then publish details of his invention. He could then still validly file patent applications for the same invention in the US, Japan and Canada on the basis of the UK priority application, provided that the later applications were filed within 12 months of the date of the priority application.

Currently 169 countries have signed the Paris Convention, including the vast majority of industrialized nations.