

When is it safe to refile or update a priority application?

Introduction

One of the most important aspects of the international patent system is the ability for a patent applicant to claim a priority right in one country based on a first patent application filed in another, usually the applicant's home country. The basis for this priority right is found in Article 4 of the Paris Convention. Most countries are members of the Paris Convention and have incorporated provisions giving effect to Article 4 into their respective patent laws. In relation to patents, the most important element of Article 4 is the 12 month priority period.

According to Article 4A(1), any person who has applied for a patent in a Paris Convention country, or their successor in title, enjoys a right of priority for a period which is "fixed". Articles 4C(1) and 4C(2) provide that this fixed period is 12 months starting from the filing date of the first patent application. Accordingly, the filing date of the first patent application made in a Paris Convention country is an important date for calculating the fixed priority period. In practice the question of what is the "first" patent application often arises, particularly when an applicant wishes to reset the starting date for the 12 months priority period.

Prior to the Lisbon revision of the Paris Convention in 1958 there was no officially recognised mechanism for replacing a "first" application with another subsequent application to reset the priority period. This was not a problem in the United Kingdom because of a practice which developed in the United Kingdom Patent Office following a decision by the Attorney General in *Van de Poelle's Patent*¹. According to that decision an earlier application could be ignored for the purpose of determining the priority period if, at the time a

subsequent application was filed, the first application was abandoned, and of no effect. See also *Whitin's Application*².

Although attempts were made by the German, Austrian and British delegations during the Paris Convention revision meeting held in London in 1934 to introduce a provision to allow an applicant to reset the priority period by filing a subsequent application, these attempts were unsuccessful³. A revised proposal was put forward by AIPPI in 1938 to allow the priority period to be reset, and it was this proposal that eventually provided the starting point for discussions at the Lisbon revision meeting in 1958⁴.

Unfortunately the AIPPI proposal was not accepted and a considerably more restrictive provision was adopted in 1958 which now appears as Article 4C(4):

"A subsequent application concerning the same subject as a previous first application within the meaning of paragraph (2), above, filed in the same country of the Union shall be considered as the first application, of which the filing date shall be the starting point of the period of priority, if, at the time of filing the subsequent application, the said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority."

Although most patent practitioners are aware that the Paris Convention provides an opportunity to reset the 12 month priority period, few appear to be aware of the detail of the provision, and the restrictions placed

on its operation during the Lisbon revision meeting. This paper discusses these restrictions by examining the language of Article 4C(4) itself, and its historical development, as well as the ways in which different Paris Convention countries have implemented Article 4C(4).

Comparison of AIPPI proposal with Article 4C(4)

The proposal which had been put forward by AIPPI was to insert the following words (shown in *italics*) between the two sentences which appear in Article 4C(2):

“These periods shall start from the date of filing of the first application. However, an application subsequently deposited in a country of the Union shall also be considered as a first application, the date of deposit of which shall be the starting point of periods of priority, if at any time a right of priority is claimed on the basis of this subsequent application, the original application, as well as any intermediate applications, has been withdrawn, abandoned or refused and if none of these applications has already served as the basis for a claim to a right of priority. The day of filing shall not be included in the period”.

There are some important differences between the text of Article 4C(4) and the amendment to Article 4C(2) proposed by AIPPI.

AIPPI proposal	Article 4C(4)
Subsequent application can be in any country of the Union.	Subsequent application must be in the same country as the first application.
Requirements are judged as of date of claiming priority, i.e. filing date of Convention application.	Requirements judged at time of filing the subsequent application.
Allows for first application and “any possible intermediate applications” to be disregarded.	Only allows previous first application to be disregarded.
No requirement that at date of filing subsequent application, or date of claiming priority, the original application (i) had not been laid open to public inspection, and (ii) had no rights left outstanding	Requirement that at date of filing subsequent application, the previous application (i) had not been laid open to public inspection, and (ii) had no rights left outstanding.

AIPPI proposal	Article 4C(4)
Maintains the ability to claim priority from the first application after priority claim is made from subsequent application.	Once subsequent application is filed (following withdrawal, abandonment, refusal etc. of first application), the first application cannot be used as a basis for claiming a priority right.

According to a report on the Lisbon revision meeting presented at a combined meeting of the Institute of Patent Attorneys of Australia and the Australian Group of AIPPI on 6 May 1959⁵, most countries considered the original AIPPI proposal to be “too wide and open to abuse”. It was for this reason that further limitations were included in Article 4C(4).

These further limitations, which restrict the applicant’s ability to reset the starting point of the Paris Convention priority period, have important consequences for applicants. Although it is difficult to appreciate today the rationale for some of these limitations, it is important to understand that the main reason Article 4C(4) was introduced in 1958 was to allow an applicant to file a corrected application to overcome a defect in an original application in a way which provided the applicant with a full 12 month priority period from the date of filing the corrected application⁶. Also, since patent applications were generally not published until acceptance or grant, there was great suspicion in relation to the ways in which applicants could potentially use such a provision to their advantage. The provision was clearly not introduced to allow applicants to refile priority applications to provide more time to further or better exemplify their inventions, to provide more time to obtain funding, or for any of the various other reasons why applicants today choose to refile priority applications.

The Lisbon revision meeting

At the Lisbon revision meeting consideration of the AIPPI proposal was assigned to one of the five working committees, (“the Committee”). Following initial review by the Committee the Belgian, British, Yugoslavian, French and German delegates proposed a number of amendments to the AIPPI proposal which were referred to a sub-committee. This sub-committee proposed the insertion of the following new provision between Article 4C(2) and C(3):

“When a person has filed two applications in the same Union member country on the same subject

on different dates, and the earlier application has been withdrawn, abandoned or denied and has not served as the basis to claim a right of priority pursuant to paragraph A(1) of this article, and when no right remains applicable in the country in question in relation to the earlier application, that person or its successor shall have the right, for the purposes of paragraph (2) above, to claim the application filed later as the first application and, in that case, no claim for a right of priority may be invoked thereafter that is based on the earlier application”.

In presenting this proposal, the sub-committee explained the following⁷:

- (1) the provision is intended to be limited to legitimate cases where there is a “false start”,
- (2) the restriction to two applications will “prevent applicant from choosing a starting point from among several applications”, and
- (3) the “same country” limitation will ensure provisions will only apply to cases “worthy of merit”.

During discussion of this revised proposal the French delegation proposed that before the second application was filed, all rights in the first application “must have disappeared completely”. The Dutch and Austrian delegates also proposed that the first application should not be published or publicly released prior to filing the second application. This resulted in the following amendments to the text⁸, where additions are shown by underlining and deletions are shown by brackets:

“When a person has filed two applications in the same Union member country [on the same subject] on different dates concerning the same object, and the earlier application has been withdrawn, abandoned or denied and has not been subject to public examination nor has served as the basis to claim a right of priority pursuant to paragraph A(1) of this article, and when no right [remains applicable in the country in question in relation] attendant to the earlier application subsists in that or any other country, then that person or its successor shall have the right to consider the later application to be the first application, for the purposes of paragraph (2) above, and in that case, no claim for a right of priority based on the earlier application may be subsequently invoked [thereafter that is based on the earlier application]”.

The Committee considered that the amended proposal was only acceptable if it was subject to the following two conditions:

- (1) Application of the provision must be limited to cases where inventor makes a mistake with first application and later revises and replaces it.
- (2) Measures must be taken to eliminate the possibility of multiple priority rights.

For these two conditions to apply:

- There could only be two applications filed in same country.
- At the time of filing of the second application the first application must have been withdrawn, abandoned or denied, should not have been published, should have no subsisting rights, and should not have served as the basis for a priority right.
- It was essential that first application could not provide a priority right if the second application has been invoked for that purpose.

This led to some redrafting of the provision, with “public inspection” replacing “published”, and renumbering of the provision as a new paragraph, now Article 4C(4)⁹.

What is evident from close examination of the Proceedings of the Lisbon revision meeting is that the restrictive nature of Article 4C(4) was by design and not by accident. In fact, in my view, Article 4C(4) operates to completely avoid the possibility of having two or more priority periods for a single invention running in parallel.

The Restrictions in Article 4C(4)

The main restrictions present in Article 4C(4) can be summarised as follows:

1. The subsequent application must be filed in the same country as the first application

This restriction was initially proposed by the Yugoslavian¹⁰ delegation to provide clarity. It was also thought to provide a safeguard to ensure the provisions only applied to cases “worthy of merit”¹¹.

It is difficult to justify this restriction in the modern era where applicants routinely file priority applications outside their country of residence. This may be done, for example, in circumstances where the invention is the result of an international collaboration, or where an applicant seeks to take advantage of a beneficial local law, such as 35 USC §102(e), or to obtain an early search by a particular Patent Office.

2. The first application must satisfy particular requirements at the time the subsequent application is filed

For a subsequent application to be considered the “first” application, and the starting point for calculation of the 12 month priority period, the first application must (a) be withdrawn, abandoned or refused, (b) without having been laid open to public inspection, (c) without leaving any rights outstanding, and (d) have not yet served as a basis for claiming a right of priority.

It is very clear from the wording of Article 4C(4) that these particular requirements need to be satisfied on the date the subsequent application is filed. This means that before filing a subsequent application an applicant will need to consider whether or not the priority period is to be reset at the time of filing the subsequent application. If the Article 4C(4) requirements are satisfied in relation to the “first” application when the subsequent application is filed, the priority period is automatically reset from the date of the subsequent filing and, in my view, the original “first” application is no longer available as a priority application. If the Article 4C(4) requirements are not satisfied, then the priority period continues to run from the filing date of the “first” application and the applicant will have no further opportunity to reset the priority date for that invention.

While requirements (a), (b) and (d) mentioned above are relatively self explanatory, requirement (c) requires some explanation. How does one withdraw or abandon an application, or have it refused, “without leaving any rights outstanding”?

Article 4A of the Paris Convention defines the types of national filings which can give rise to a right of priority. Article 4A(3) clarifies that the regular national filing can be “*any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application*” [emphasis added].

Accordingly, the act of withdrawing or abandoning an application, or having it refused, is insufficient of itself to remove the ability of the application to serve as a priority application. Some applicants when withdrawing an application specifically indicate in their request that the application is to be withdrawn “leaving no rights outstanding”. However, such a statement filed with the Patent Office of original filing may not be considered binding on the applicant by a Patent Office or court of another country. It would certainly not be considered binding under Australian law which requires a specific request filed under s96

to disregard an earlier withdrawn or abandoned filing. It therefore appears to me that the “rights” referred to in Article 4C(4) do not include the priority rights which arise from Article 4 itself. Instead, those “rights” are the rights in the application itself and relate to the ability of the application to proceed as an application under the national laws of the country in which it was filed.

Support for this proposition can be found in Article 4C(4) itself. There would be no need for the last sentence of Article 4C(4) if all priority rights needed to be extinguished prior to the filing of the subsequent application. Further support can be found in the Proceedings of the Lisbon revision meeting in which the words “*when no right attendant to the earlier application subsists in that or any other country*” [emphasis added] were replaced with “and without leaving any rights outstanding” in the final version of the provision. While the exact reason for removal of the reference to “any other country” is not evident from the Proceedings, it may have been removed to remove the suggestion that the “rights” which must be extinguished could be priority rights existing in another country. Accordingly, in my view, the requirement that there are no rights left outstanding is satisfied if the application has been withdrawn, abandoned or refused such that it is beyond restoration or reinstatement in the country in which it was filed. It does not, and in my view cannot, have the effect of requiring the applicant to extinguish a right which may exist under the domestic law of another country.

It also follows from the interpretation above that once a subsequent application is filed during the pendency of an earlier application for the same invention, the ability to reset the priority period by invoking Article 4C(4) is removed. In this regard it is not possible under Article 4C(4) to withdraw two or more co-pending earlier applications and replace them with a subsequent application to reset the priority period. This is clear from the Proceedings of the Lisbon revision meeting where the Committee stated that “there can only be two applications filed in the same country”. It is also supported by Professor Georg H. C. Bodenhausen in his book on the Paris Convention where he states :

“Furthermore, the replacement of a previous application by a subsequent application will not be accepted if in the period between these applications another application has been filed for the same subject by the same applicant in the same country of the Union. This is so because in such cases the subsequent application, at the time of its filing, cannot be considered as being the first”.

I believe Bodenhausen's book on the Paris Convention carries significant weight in the interpretation of the provision introduced following the Lisbon revision meeting. Not only was Professor Bodenhausen a law professor at the University of Utrecht and President of AIPPI in the Netherlands at the time of the Lisbon revision meeting, but he was also one of the delegates for the Netherlands at the Lisbon revision meeting and Vice President of one of the editorial boards. He also went on to become the Director General of the United International Bureaux for the Protection of Intellectual Property (BIRPI) from 1963 to 1970, and was the first Director General of WIPO from 1970 to 1973.

The consequence explained by Bodenhausen follows from the wording of Article 4C(4). Consider the situation where Application A is filed on 1 July 2011 and an updated version of the application is filed as Application B on 1 August 2011. Since Application A was pending at the time of filing Application B, Article 4C(4) is not invoked and Application A remains the "first" application and the starting point for the 12 month priority period. Now consider whether it is possible to reset the priority period by withdrawing Applications A and B on 1 April 2012, leaving no rights outstanding in either of them, and filing a new Application C the following day. In these circumstances Application A is the "first" application, but can Application C be considered the "subsequent" application?

The clear recommendation by the Committee that the provisions can only apply to two applications suggests that the "subsequent" application must be the next one in sequence rather than any application filed after the first application. Also, if Application C can be the subsequent application, and the act of filing it extinguishes Application A making Application C the notional "first" application, what is the status of Application B which has an earlier filing date than Application C? Although Article 4C(4) explains in detail the fate of the original withdrawn "first" application, in this case Application A, it says nothing about any intermediate application. This view is also consistent with the fact that the words of the original AIPPI proposal which referred specifically to withdrawal, abandonment or refusal of the original application, "as well as any intermediate applications", were rejected. In summary I believe the view of Bodenhausen is likely to be correct, and that the filing of a second application in respect of an invention during the pendency of a first application for that invention removes any possibility of resetting the priority period for that invention by the applicant.

Although there can only be two applications in existence at the time Article 4C(4) takes effect, I

believe it is possible to invoke Article 4C(4) on more than one occasion for the same invention. Accordingly, when a subsequent application becomes the "first" application, effectively extinguishing the original application, I believe there is nothing in the wording of Article 4C(4) which would prevent withdrawal or abandonment of the new "first" application followed by replacement with a further subsequent application.

3. Once the subsequent application has been filed it is no longer possible to claim priority from the original first application

This restriction of Article 4C(4) is by far the most contentious. Reading the Proceedings of the Lisbon revision meeting and subsequent reports of that meeting one would be forgiven for believing that this restriction only applies after priority is claimed from the subsequent application and that, up until that time, the applicant has the choice of claiming priority from the first application or the subsequent application. This is because, despite the concern expressed in relation to multiple priority periods running in parallel, the summary of the provision provided by the Committee when the wording of Article 4C(4) was settled suggests that the restriction on claiming priority from the original withdrawn, abandoned or refused application only applies when a priority claim is made from the subsequent application. In this regard the Committee stated that it was essential that "the first application cannot provide a priority right if [the] second application has been invoked for that purpose". This language suggests that the prohibition on claiming priority from the first application is conditional on the making of a priority claim based on the subsequent application. However, in my view, the language of Article 4C(4) does not include this condition.

The only "time" referred to in Article 4C(4) is the "time of filing the subsequent application". Accordingly, when the last sentence uses the word "thereafter" it can, in my view, only relate to the time after the subsequent application has been filed. When interpreted in this way, Article 4C(4) ensures that it is not possible for an applicant to have two priority periods running concurrently in respect of a single invention, the new 12 month "fixed" priority period being set on the date the subsequent application is filed. This opinion is contrary to that expressed by some commentators, but is consistent with the view of Bodenhausen, who states the following in his book on the Paris Convention :

"After the replacement of a previous application by a subsequent application as a basis for the right of priority, priority may no longer be recognized in any

by a subsequent application as a basis for the right of priority, priority may no longer be recognized in any country of the Unions on the basis of the previous application”.

This restriction has important consequences for patent applicants, especially those wishing to file updated versions of original priority applications during the initial 12 month priority period. Such applicants will be faced with the difficult decision of whether or not to withdraw the original priority application before filing the revised application. If the original application is withdrawn leaving no rights outstanding, not being published or previously used as the basis for the priority right, then the filing of the subsequent revised application in respect of that invention will automatically reset the priority period to commence from the date of filing the subsequent revised application. It will no longer be possible to claim priority from the original application even if a PCT application or Convention application is filed within 12 months of its filing date. This is because Article 4C(4) has been invoked, the subsequent revised application is, by definition, “considered as the first application”, and the fixed priority period has been reset from the filing date of the “subsequent” revised application. The last sentence of Article 4C(4) confirms that the original application, which now has a filing date earlier than commencement of the new fixed priority period, can no longer provide the basis for a right of priority.

On the other hand, if the original application is not withdrawn prior to filing the revised application, it will no longer be possible to reset the priority period, and any application made by the applicant in respect of that invention seeking to claim priority under the Paris Convention will need to be filed within 12 months of the original application. For this reason it is important for the applicant to assess at the time of filing the subsequent application whether or not they will be in a position to file a PCT application or Convention application within 12 months of the original priority filing. If not, then withdrawing the original application before filing a revised application may be advisable. The other option for the applicant is to pursue applications in the various Paris Convention countries on a non-Convention basis.

It is apparent that some patent applicants, especially in the United States, file provisional applications with a simultaneous request for express abandonment so that the application is effectively abandoned as of its filing date. In some countries it is also possible to file an application to obtain a filing date without payment of fees, after which the application lapses with no rights left outstanding. According to Article 4A(3) of

the Paris Convention, these abandoned applications can serve as a basis for priority rights.

While filing applications in this manner may be advantageous if an applicant wishes to be in a position to quickly reset the priority period, if necessary, by the filing of a subsequent application, it can, in my view, be disadvantageous if the applicant decides it wishes to file a supplemented or revised version of the original priority application during the initial fixed 12 month priority period. In my view, the filing of a revised patent application in respect of the invention by the applicant during the priority period will, by the operation of Article 4C(4), reset the priority period and remove the ability of the applicant to claim priority under the Paris Convention from the original “first” application. This consequence of the wording of Article 4C(4) does not appear to be well understood.

National Implementation of Article 4C(4)

In 2011 I completed a study for FICPI which looked at the ways in which different countries have implemented Article 4C(4). My interest in the national implementation of Article 4C(4) stemmed from an analysis of s96 of the Australian Patents Act 1990, Australia’s implementation of Article 4C(4). In its present form, this provision requires applicants to specifically request that earlier withdrawn or abandoned applications be disregarded before a priority claim based on a subsequent filing can be acknowledged. Failure to make such a request prior to grant of the patent results in a defect in the priority claim which cannot be corrected after grant.

My study of 28 different countries and regions revealed that most have implemented the provisions of Article 4C(4) without significant change. However, several countries, including Australia, Canada, New Zealand, Singapore, South Africa, United Kingdom and the United States, have provisions which have been drafted in a manner which avoid the restriction which appears in the last sentence of Article 4C(4), that is, that the previous application “may not thereafter serve as a basis for claiming a right of priority”. Accordingly, in these countries the act of filing the subsequent application after withdrawal, abandonment or refusal of the first application does not remove the ability to claim priority from the first withdrawn, abandoned or refused application.

The restriction inherent in the wording of Article 4C(4), that particular requirements must apply to the “first” application at the time the subsequent application is filed, is avoided in Australia and the United States where these requirements in relation to the “first” application are judged at the date of filing of a PCT application or Convention application, rather

than at the date of filing the subsequent application. Accordingly, so long as all earlier applications in the same foreign country have been withdrawn, abandoned or refused leaving no rights outstanding, and all Article 4C(4) requirements are satisfied at the time the PCT or Convention application is filed, priority can be claimed in Australia and the United States from a subsequent application filed in that foreign country. This applies even if earlier applications were still pending in the foreign country at the time the subsequent application is filed.

My study also revealed, interestingly, that India does not appear to have any provisions in its patent law implementing Article 4C(4), and it is unclear whether a priority claim based on a refiled or revised application would be recognised in that country. All countries examined, with the exception of Portugal, have adopted the “same country” limitation.

Conclusions

Article 4C(4) was drafted at a time prior to universal adoption of 18 month publication of patent applications, and at a time when there was great suspicion in relation to the ways in which an applicant might abuse an ability to reset the 12 month priority period. As a result, Article 4C(4) includes a number of restrictions which were designed to limit its application to the correction of defects in an original application. With the general acceptance of 18 month publication and the general passage of time these fears and suspicions appear to me to be largely unjustified. It is also now apparent that there are many legitimate reasons, beyond the simple correction of a defect in an original application, why an applicant may wish to reset the 12 month priority period. Further complicating the present situation is the fact that different countries have implemented the provisions of Article 4C(4) in different ways, such that a priority claim which may be effective in one jurisdiction may not be effective in another. In my view, the International patent system would be improved with further consistency in the way in which priority can be claimed based on previously filed applications.

I have brought this issue to the attention of IP Australia and new legislation has been passed¹⁸ which removes the requirement in s96 of the Australian Patents Act for an applicant to specifically request that an earlier withdrawn, abandoned or refused application be disregarded. At the same time s96 will be amended to remove the “same country” limitation. Steps have also been taken to ensure that an earlier withdrawn, abandoned or refused application can serve as a basis for a priority claim if filed within the 12 months prior to the Australian filing date. Accordingly,

none of the three restrictions described above will apply in Australia when the new law takes effect in 2013. While it would be helpful for applicants, and improve the International patent system, if other countries could amend their laws in a similar way, it is recognised that some countries may be bound by the wording of the Paris Convention, including these restrictions. In Australia the view has been taken that the Paris Convention provides minimum requirements which must be met in relation to recognising priority based on foreign patent filings. If Australia wishes to recognise priority in circumstances beyond the application of Article 4C(4) then this is not considered to contravene its international obligations. Since several other countries have also introduced provisions which are more generous than Article 4C(4) of the Paris Convention, it is clear that other countries also do not believe they are constrained by the strict wording of this Article.

In the meantime, applicants and their attorneys should be careful when claiming priority from refiled or updated priority applications, particularly if they wish to claim priority in a country which has implemented the strict provisions of Article 4C(4).

Finally, it is interesting to consider whether the restrictions of Article 4 can be avoided by filing an application in a different name. Article 4 accords the right of priority to the applicant or the applicant's successor in title. Could the refiling of the application or the filing of an updated version of the application in the name of the applicant's predecessor in title, for example in the name of the inventor, establish a new priority right for the predecessor in title?

Endnotes

1. Van de Poêle's Patent (7 RPC 69)
2. Whitin's Application (54 RPC 278)
3. Actes de la Conférence Réunie à Londres p364
4. Actes de la Conférence de Lisbonne p328
5. Proceedings of the Institute of Patent Attorneys of Australia Volume XLI, Session 1959, pp136-158
6. G.H.C. Bodenhause, Guide to the Application of the Paris Convention for the Protection of International Property, as revised at Stockholm in 1967, United International Bureaux for the Protection of Intellectual Property, 1968, p45
7. Actes de la Conférence de Lisbonne p334-5
8. Actes de Lisbonne p337
9. Actes de Lisbonne p338
10. Actes de Lisbonne p331
11. Actes de Lisbonne p335
12. Actes de Lisbonne p338
13. Actes de Lisbonne p337
14. GHC Bodenhause supra p46
15. Actes de Lisbonne p337
16. GHC Bodenhause supra p46
17. www.ficpi.org/library/11CapeCET/CET-1305+annexes&slides.pdf
18. Intellectual Property Laws Amendment (Raising the Bar) Bill 2011

Authors:
Michael Caine, Partner

Davies Collison Cave
Melbourne

For further information about refiling or updating priority applications safely or any patent related matters please contact Michael Caine on 03 9254 2777