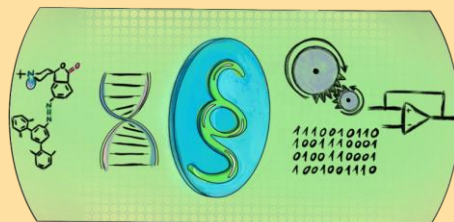




18



Priority right...

... has the effect that the date of priority counts as the day of filing the EPapp... → Art. 89 (1) EPC

... with respect to determining novelty ...

→ Art. 54 (2), (3) EPC

... and with respect to the right to the EPat.

→ Art. 60 (2) EPC

... can „heal“ late filing of parts of the EPapp in case missing parts are disclosed in the priority application,...

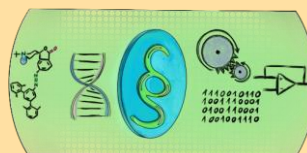
2M after filing or communication

→ R. 56 (3) EPC

(see day 1)

→ GL A-II, 5.4

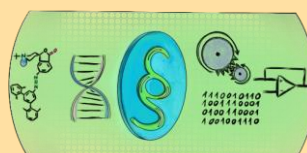
- ... but priority claim had to be in existence not later (= also simultaneous) than that request... → GL A-II, 5.4.1
- ... and the EPO checks requirements of priority claim then. → GL A-III, 6
- ... but does not apply for low quality figures or addition of technical content. → J 12/14



Actively claiming priority right... (1)

... by the App. with respect to a previous (first) application by ... → Art. 88 (1) EPC

- filing a declaration of priority containing
 - date of previous filing → R. 52 (1) EPC
 - State for which previous filing was made, being
 - party to Paris Convention (PC)
 - party to the World Trade Organization (WTO) or
 - granting PC-equivalent rights of priority based on EPO first-filing and Communication by EPO president stating this
 - file number
- on date of filing or max. 16M from earliest priority date claimed or until App. requests publication → R. 52 (2), (4) EPC
- Corrections up to 16M of earliest (corrected) priority date until expiry of 4M from date of filing or until App. requests publication → R. 52 (3), (4) EPC



Actively claiming priority right... (3)

... by further providing documents such as ...

→ Art. 88 (1) EPC

- copy of the previous application, only once and only if not available to EPO otherwise

→ R. 53 (1) S.1 EPC

→ R. 56 (2), (3) EPC

➤ within 16M of earliest priority date

→ R. 53 (1) S.1 EPC

- certification as correct by authority with which previous application was filed

→ R. 53 (1) S.2 EPC

... and if ...

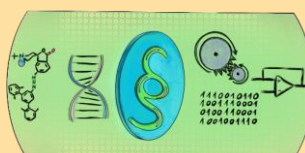
- ... previous application is not in an official EPO language, ...

- ... but relevant for determining patentability

⇒ invite to App. EPapp / Prop. EPat by EPO to file

→ R. 53 (3) EPC

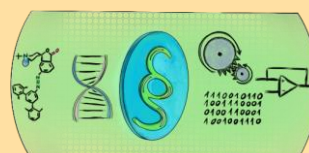
- translation into one official EPO language, or
- declaration EPapp is a complete translation



Legal consequences of non-compliance

→ GL A-III 6.5.3

- Loss of the right of priority
 - ✓ failure to provide date or state within 16M period from earliest (corrected) priority date → Art. 90 (5) EPC
- Invite by EPO after 16M period from earliest (corrected) priority date expired
 - ✓ failure to provide file number, copy of the previous application or providing the wrong file number → R. 59 EPC
- Correcting errors within the 16M period from earliest (corrected) priority date or in case apparent that it is an obvious mistake even later → A-V, 3



Earlier first application ... (1)

... filed in or for a PC or WTO member state or „special other state“, → Art. 87 (1),(2),(5) EPC

... was filed by same applicant or accessor in title (= one enough for joint App./Props. and without transfer of rights),

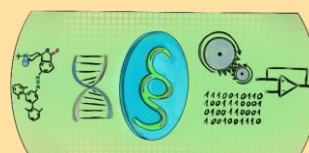
... was not filed prior to 12M from filing the EPapp where the priority is claimed for, → GL A-III, 6.6

... discloses the same invention as the EPapp, → GL A-III, 6.4; F-VI, 1.4

... was an application for one of the following:

- Patent application
- Utility model registration application
 - ✓ don't mix up (German) utility model and US utility patent, the later being a „normal“ patent
- Utility certificate

... was a first application in that sense to avoid priority chains.



Earlier first application ... (2)

... cannot be an industrial design ... → J 15/80

... because the EPC is a special agreement in the sense of the PC ... → Art. 19 PC

... and as such, the EPO is not directly bound by the priority provisions of the PC since it is not a member itself to the PC ... not applicable → Art. 4 PC

... despite the president's potential capability to sign international agreements, treaties and contracts.

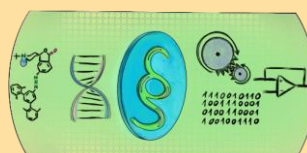
(see day 7) → Art. 33 (4) EPC

⇒ EPC's priority provisions: „complete, self-contained code of rules of law on the subject of claiming priority for the purpose of filing an [EPapp]“

→ J 15/80

→ Art. 87-89 EPC

→ R. 52, 53 EPC (= R. 38 EPC 1973)



Earlier first application ... (3)

But:

- ✓ EPapp can provide the basis for right of priority (PC time limit: 6M) on industrial design, or ...

→ Art. 4 A, C PC

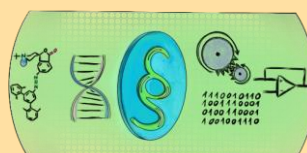
- ✓ ... after first disclosure (= day of publication) for the EU can even set an Unregistered Community design into force (= „what is seen is what you get“) ...

→ COUNCIL REGULATION (EC) No 6/2002; No 18921/2006; No 40/94

- ✓ ... while publication of EPapp triggers itself a 12M grace period for Community designs. → Art 67, R. 68 EPC

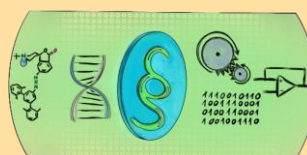
Be aware of the difference between grace period and priority period:

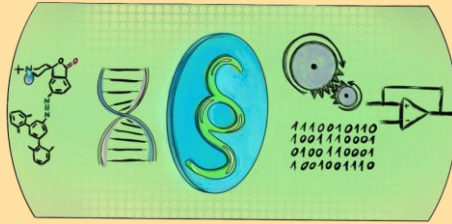
- Grace period: your own disclosure is not novelty threatening to your later application / registration
- Priority period allows „to date back“ your date of filing



Examination, issueing, giving rise to right of priority

- Formal examination after according a filing date and during formal examination by the EPO with respect to formal requirements of claiming the priority.
(see day 1 and 2) → Art. 90 (3), R. 59 EPC
- Substantive examination only in case it is relevant to the determination on patentability → R. 53 (3) EPC
- EPO issues a priority document (= certified copy of the EPapp)
 - (administrative fee)
 - on request
- First filing with the EPO also gives rise to right of priority, because...
 - EPC governs this in itself → Art. 87 (2) EPC
 - is equivalent to national filing, (CS = WTO & PC members)
→ Art. 87 (2), (3), Art. 66 EPC





*Manuel
Pescher*

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Patents - Designs - Trademarks

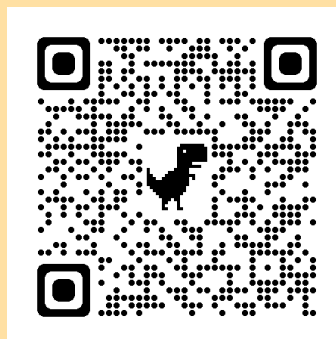
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