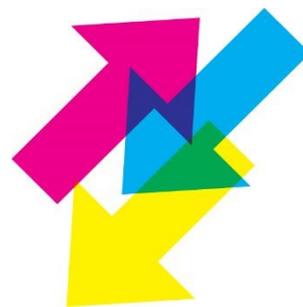


High Priority!



Maintain the chain

Failure to maintain a precise and timely chain of title between priority and subsequent applications can cause loss of priority entitlement in Europe.

The transfer of priority rights

When a proposed applicant for a new filing is not identical to the applicant for the priority application (e.g. US provisional, which may have been filed in the name of the inventor rather than the employer), it is advisable for the right to claim priority and all rights in the invention to be transferred by a **written executed assignment, explicitly transferring the priority right** and the rights in the invention, **before the subsequent application** is filed.

The most common example we see is where a later application is a PCT application and claims priority from an earlier US application. However, the points here will apply to other types of earlier and later applications in Europe, such as those made as direct EPs.

Under EPO and English case law it is **not** possible to assign priority rights **retrospectively**. To avoid an uncertain and expensive post-grant challenge we recommend that the following practice points are considered **before** filing a patent application claiming at least one priority:

- Check the entitlement of the applicant to claim the priority right(s) of **all** the priority applicants.
- Where necessary, ensure that assignments of the priority rights: (a) are valid assignments under the relevant national law; and (b) have been executed by **all** priority applicants in favour of the intended applicant, **before** filing the later application.
- These assignments should be in writing, signed by both parties (unless this is clearly not required under relevant national law), and should expressly assign the right to claim priority in addition to any rights in the invention itself.
- If not all relevant assignments are in place, or there is any doubt as to the intended applicant's entitlement, the later filing should name as applicants all individuals and/or companies with whom priority entitlement can be shown to rest (whether because they are the named priority applicants or through valid executed assignments) **at the date of filing** the later application. If you **do not have a paper trail** demonstrating a proposed applicant's entitlement to claim priority – **do not name them** as an applicant.

To date, EPO examiners have not generally questioned the assignment of priority entitlement during examination and lack of validly assigned priority entitlement is unlikely to be used as the basis for an objection pre-grant. However, priority entitlement is becoming a routine attack in oppositions and invalidity actions. In both cases, if an error is discovered it may be too late to correct. The loss of entitlement to priority can, therefore, in the worst cases contribute to a finding that the patent is invalid.

If a suitable explicit assignment has not been put in place, it may still be possible to establish the applicant's right to claim priority as successor through relevant national law, by operation of law, contract, or in equity. The EPO, in T-517/14, confirmed that whether or not priority rights have transferred in the absence of a formal written assignment has to be determined on the **balance of**

probabilities. The UK also adopts the same standard of proof. However, as the judge (Mr. Justice Arnold) noted in a recent UK case, this amounts to “a trial within a trial” involving disputed issues of primary fact, of foreign law and of domestic law.

Both the UK and the EPO have emphasised the **importance of evidence** as to the situation in national law where there is no formal written assignment. As a result, the parties may be forced into engaging local experts on national law of the country of first filing and/or the country/state governing the inventors’ employment contracts (if different), adding time, cost, and risk to the proceedings. This **cost and uncertainty could be avoided** by executing a written assignment before the later application is filed, or by maintaining identity of applicant.

If the applicant was not entitled to claim the priority right of all priority applicants at the filing date, correction of the later application may be possible. Correction should be considered at an early stage as it may be more convenient and cost effective to deal with this under the PCT or regionally rather than nationally. However, correction needs to be approached with caution as it could make public a possible priority problem.

Relevant provisions

Article 4A(1) Paris Convention (Stockholm Revision):

Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, **or his successor in title**, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

Article 8(2)(a) PCT incorporates Article 4 Paris Convention (including the above Article 4A(1)) into the PCT.

Article 87(1) European Patent Convention:

Any person who has duly filed, in or for (a) any State party to the Paris Convention for the Protection of Industrial Property or (b) any Member of the World Trade Organization, **an application** for a patent, a utility model or a utility certificate, **or his successor in title**, shall enjoy, for the purpose of filing a European patent application in respect of the **same invention**, a right of priority during a period of twelve months from the date of filing of the first application.

In the UK, the priority date of an invention is dealt with by section 5 Patents Act which, by section 130(7), is to be construed in conformity with the corresponding provisions of the EPC (including Article 87).

Need advice?

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