

# PARIS CONVENTION PRIORITY PITFALLS WHEN SEEKING OVERSEAS PROTECTION UNDER THE *LEAHY SMITH AMERICA INVENTS ACT*

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In one sense, it is easy to understand Paris Convention priority that permits a one year period from a first filing in the United States to cover Europe, Asia and elsewhere with patent protection.

Yet, there are myriad procedural issues that confront the patent applicant that all too often result in a failed priority result. This paper explores the more common problems, and how to avoid them.

This work is an outgrowth and builds upon the writer's treatise, *FIRST TO FILE PATENT DRAFTING: A PRACTITIONER'S GUIDE* (Thomson Reuters 2017), <http://legalsolutions.thomsonreuters.com/law-products/Treatises/First-To-File-Patent-Drafting-2017-ed/p/104366885>.

*FIRST TO FILE PATENT DRAFTING: A PRACTITIONER'S GUIDE* is also available electronically on Westlaw.

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\*The writer's background is set forth under *About the Author* at page 65.

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## I. OVERVIEW

An American applicant who has filed a first application in the United States may *defer* the expiration of the Paris Convention year for purposes of foreign filing in Europe, Asia and elsewhere by *abandoning* the first application and restarting the Paris Convention year with a later, *second* domestic filing (while also meeting other requirements of the Paris Convention).

This work *presumes* a basic knowledge of the formalities for claiming foreign priority under 37 CFR § 1.55, *Claim for foreign priority*, which is set forth *in toto* as an appendix to this paper.

But, beyond the ordinary formalities of Rule 55, there are special conditions of the Paris Convention, Art. 4C(4), *Conditions for Priority to Second Application*, that expressly exclude restarting the priority year unless *as of the date of the second filing* “[a] the [first] application [must have] been withdrawn [or] abandoned \* \* \* [; (b)] without having been laid open to public inspection and [(c)] without leaving any rights outstanding, and [(d) where] it has not yet served as a basis for claiming a right of priority.” 35 USC § 119(c)(domestic implementation of Paris Convention Art. 4C(4)).

Prior to the *Leahy Smith America Invents Act* of 2011, the American inventor could follow this scheme to defer foreign filings, while also establishing a date of invention for purposes of the United States through an early reduction to practice date, often earlier than the first filing date. Of course, this scheme is no longer viable under the current first-to-file regime.

The one year priority period of the Paris Convention can be *restarted* under specific conditions set forth both in the Paris Convention as well as the *Leahy Smith America Invents Act* of 2011 that will thus delay the date for Paris Convention priority filings around the world. Legitimate reasons to restart the Paris Convention year with a new application include the situation where an original United States application – for whatever reason – does not provide effective support for an invention under 35 USC § 112(a), and thus may not serve as a *substantive* basis to establish a date of invention in the United States.

Prior to the *Leahy Smith America Invents Act* of 2011 it was also not uncommon for an American patent applicant to *reset* the Paris Convention deadline by weeks or even months by *replacing* the original United States filing with a *second* application to the same invention, and thereby extend the one year convention period to expire on the first anniversary of the filing of the *second* application. This scheme permitted the applicant to seek to enjoy *for the United States* his original invention date as of his first filing date (or possibly even earlier), while permitting a deferred filing in Europe, Asia and elsewhere under the Paris Convention.

This refiling strategy no longer is operative to retain the earliest American priority date, because the first-to-file system of the *Leahy Smith America Invents Act* of 2011 does not permit establishing an actual date of invention anterior to the actual filing date for purposes of the United States. Hence, to the extent that an American patent applicant seeks to defer his priority deadline in Europe, Asia and

elsewhere around the world while retaining his American priority date, it is thus not possible to do so.

This paper commences with the statutory scheme for Paris Convention priority under the *Leahy Smith America Invents Act* of 2011 which is set forth in 35 USC § 119(a). See § II, *The Statutory Scheme*.

Often, in the haste to file a first patent application, there may be a minor language or other glitch that inspires the writer of that application to *replace* the first filing. Here, the temptation is to “bury” the first application through eventual abandonment, never to see the light of day. See § III, *Replacing a First Filing to Clean Up the Text*. In some instances, the refiling is necessary because the original text is too vague or general to meet the disclosure requirements for priority. *Id.* In still other situations, the applicant may wish to defer the one year deadline for filing abroad by restarting the convention year with a new filing. *Id.*

Prior to the introduction of first-to-file in 2011, it was also routine for some applicants to *defer* the Paris Convention year for foreign filing purposes by replacing the first application with an identical or nearly identical second filing that was then to be used as the priority base for foreign filings, but with a deferral of the Paris Convention year based upon the restarted priority year. Of course, this scheme has lost its luster now that American priority rights may no longer be based upon a date of invention, but can only be keyed to a filing date. See § V, *Changed Circumstances of the New Patent Law*.

Restarting the Paris Convention year through a second filing is not a simple matter to be casually initiated. For example, if one files a second application to

replace the first application for the purpose of restarting the Paris Convention year, the first application must have *already* been abandoned as of the date of the second filing. *See* § VI, *Strict Statutory and Treaty Limitations*.

Another pitfall of Paris Convention priority rights is the need to consider priority based not upon what is *claimed* in the priority application but instead what is *disclosed* in the priority document. Thus, if one files a Paris Convention application within one year of the first foreign application that *claims* the invention, the filing is too late if the same applicant has a still earlier filed foreign application that *discloses* the same invention, but is more than one year before the filing date. *See* § VII, *Disclosed (Unclaimed) Invention in the First Filing*.

Older case law provides that where a common assignee files a first overseas application more than one year before the United States filing date in the name of a first inventive entity and then *within* the convention year files a second overseas application in the name of a different inventive entity (which is also the United States nominated inventive entity), the filing of the first overseas application does not disqualify the second overseas application from serving as a priority basis for the United States application. Whether this long line of case law will be distinguished in the future is an open question. *See* § VIII, *Earlier Filing by a Different Inventive Entity*.

The strategy to *restart* the convention year expiration is no longer considered sound in view of the sacrifice of domestic priority rights this may entail. Nevertheless, it is useful for rare situations to employ this practice to

understand the intricacies of the law. *See* § IX, *Old Law Deferral of Convention Expiration*

On occasion, an applicant on “Day One” may file a first patent application that is less than perfect in its details, but nevertheless discloses Invention “X”. Almost immediately aware of the imperfect nature of the first application, a decision is made to *replace* that first application – the “ghost” first filing – with an almost identical second patent application that is also designed to be the priority basis for protection in Europe, Asia and elsewhere under the Paris Convention. But, the “ghost” first filing will come back to haunt the applicant as it may negate any priority right based on the second filing. *See* § X, *“Ghost” First Filing May Destroy Convention Priority*

It should also be noted that it is often the case that there are two applications related by subject matter where there is a *difference* in the disclosures. It is perfectly proper, here, to rely upon the second application only and file a patent application within one year of that second application, and still claim priority rights based upon the *new matter* first disclosed in the second application. *See* § XI, *Second Application Disclosing New Matter*.

It should also be noted that the strict, one year period for filing a Paris Convention application has been softened to permit filing within fourteen months of the priority date if the delay was “unintentional” and various formalities are met. *See* § XIII, *Emergency Extension for Paris Convention Filings*.

## II. THE STATUTORY SCHEME

The statutory scheme for Paris Convention priority is set forth in the *Leahy Smith America Invents Act* of 2011 as follows:

### **35 USC § 119. Benefit of earlier filing date; right of priority**

(a) An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country [as defined in 35 USC § 104(b)(2)], shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within 12 months from the earliest date on which such foreign application was filed. The Director may prescribe regulations, including the requirement for payment of the fee specified in [35 USC §] 41(a)(7), pursuant to which the 12-month period set forth in this subsection may be extended by an additional 2 months if the delay in filing the application in this country within the 12-month period was unintentional.

\* \* \*

(c) In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application in the same foreign country instead of the first filed foreign application, provided that any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.

\* \* \*



The *Manual* provides an explanation of priority based on a first filing:

“The 12 months is from earliest foreign filing except as provided in 35 U.S.C. 119(c). If an inventor has filed an application in France on October 4, 1981, and an identical application in the United Kingdom on March 3, 1982, and then files in the United States on February 2, 1983, the inventor is not entitled to the right of priority at all; the inventor would not be entitled to the benefit of the date of the French application since this application was filed more than twelve months before the U.S. application, and the inventor would not be entitled to the benefit of the date of the United Kingdom application since this application is not the first one filed. *Ahrens v. Gray*, 1931 C.D. 9 (Bd. App. 1929). If the first foreign application was filed in a country which is not recognized with respect to the right of priority, it is disregarded for this purpose. 35 U.S.C. 119(c) extends the right of priority to ‘subsequent’ foreign applications if one earlier filed had been withdrawn, abandoned, or otherwise disposed of, under certain conditions.<sup>1</sup>

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<sup>1</sup> MPEP § 213, *Right of Priority of Foreign Application* [R-07.2015], § II, *First Foreign Application*.

### III. REPLACING A FIRST FILING TO CLEAN UP THE TEXT

It is not uncommon for a first application to miss the mark in terms of describing a patentable invention. In such a situation where later claims to the real invention are not supported in the first application, a substantive denial of the priority right exists where no claim of importance is supported in the first filing to meet the disclosure requirements of 35 USC § 112(a).

In some situations, the first filing may define a patentable invention but is too sketchy to reliably be considered to provide support for invention, raising an issue as to whether the first application provides a disclosure to permit priority. Thus, if a first application does not teach how to make and use the invention to meet the disclosure requirements of 35 USC § 112(a), that application is not basis to support a later application with a priority right under 35 USC § 119.<sup>2</sup>

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<sup>2</sup> “The identical substantive standard is used to judge whether priority should be granted based upon any form of parent application, whether the parent is a regular (non-provisional) application; a Paris Convention priority application; or a provisional application.” Wegner, *FIRST TO FILE PATENT DRAFTING*, § 5:9, *Identical Substantive Standard for All Varieties of Parent Filings* (Thomson Reuters 2017)(citing *In re Gosteli*, 872 F.2d 1008 (Fed. Cir. 1989) (Paris Convention priority); *In re Ziegler*, 992 F.2d 1197 (Fed. Cir. 1993) (*id.*); *Kawai v. Metlesics*, 480 F.2d 880, 885–89 (CCPA 1973) (*id.*); *Anderson v. Natta*, 480 F.2d 1392, 1399 (CCPA 1973) (*id.*); *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290 (Fed. Cir. 2002) (Michel, J.) (priority based on provisional application)).

In either situation, it may be wise to rely upon a second application that *does* properly describe the invention. To facilitate priority based on the second application, it is helpful to claim priority based upon the second application while also forfeiting priority based on the first application.

Art. 4C(4) involves the less frequent but still fairly common situation is where the second application is filed to *replace* the first application, and the second application is to be used for priority purposes. Here, important subject matter is *common* to the first application as explained by Dr. Bodenhausen:

“A subsequent application”: “[I]t frequently happens \*\*\* that the first application, made in a hurry \*\*\* does not adequately represent the applicant’s intentions. Failing a special provision regulating this matter[,] the applicant would be unable to replace his [original] application by a better[-drafted] one without losing the right of priority, because the [better-drafted] application would not be the *first* concerning the same subject and therefore could not be recognized for the priority right. In order to eliminate this difficulty [Art. 4C(4)] allows, *under certain precise conditions*, a subsequent application to replace the first application for the purpose of claiming the priority right.”<sup>3</sup>

Thus, “the filing date [of the subsequent application] shall be the starting point of the period of priority”: “The filing date which will be considered the starting point of the period of priority will be the date of [the] *subsequent* application[.] the first application [is] disregarded \*\*\*.”<sup>4</sup>

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<sup>3</sup> G.H.C. Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property as Revised at Stockholm in 1967*, note b (Geneva: BIRPI 1968).

<sup>4</sup> Bodenhausen, *supra*, note d.

It is further provided by Dr. Bodenhausen that:

“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.”

As emphasized by Dr. Bodenhausen, *each* of the several conditions must, without exception, be met for the application of this restarted right of priority to be effective. Thus, “the following conditions have to be fulfilled with respect to the previous first application filed *for the same subject matter in the same country*;

“the previous application must, *before* the subsequent application is filed, have been *withdrawn, abandoned or refused*;

“the previous application must *not* have been *laid open to public inspection*;

“the previous application must *not leave any rights outstanding*;

“the previous application must *not yet* have served *as a basis for claiming a right of priority*, either in the same or in any other country.

“If any of these [five] conditions is not fulfilled, the country of the Union in which priority is claimed on the basis of the subsequent application will refuse to recognize this priority.

“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 or another 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 [application].”<sup>5</sup>

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<sup>5</sup> Bodenhausen, *supra*, note 3.

After the subsequent filing, for priority to be maintained, “[t]he previous application may not thereafter serve as a basis for claiming a right of priority.”: Bodenhausen emphasizes that “[a]fter 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 country of the Union on the basis of the previous application.”<sup>6</sup>

While it may be justified to *add* disclosure in a later filing it is generally dangerous to *omit* subject matter in the later filing, effectively nullifying the priority basis for disclosure in the original application that has not been carried forward. Thus, it is important that while subject matter may be *added* to a regular application versus the original parent priority disclosure, it is dangerous to *change* the disclosure in the new application by *omitting* the original disclosure.<sup>7</sup>

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<sup>6</sup> Bodenhausen, *supra*, note f.

<sup>7</sup> “To minimize the consequences of the possibility that an intervening prior art publication will be found, *all* supporting disclosure from the original filing should be carried forward *verbatim* into the continuing application—together with any added material. Thus, while new material may be added, nothing from the original specification should be deleted.

“It should be recognized that *any change* in the scope of protection could be problematic, even if the disclosure is *narrowed*. See § 11:27, *Narrowed Range Barred by Intervening Disclosure* (discussing the application of *In re Ruscetta*, 45 255 F.2d 687 (CCPA 1958), to narrowing in *In re Lukach*, 442 F.2d 967, 968–70, (Lane, J).”

Wegner, *FIRST TO FILE PATENT DRAFTING*, § 4:6, *Identical Supporting Disclosure should be Maintained* (Thomson Reuters 2017).

#### IV. THE LAW PRIOR TO THE 2011 STATUTORY CHANGE

Prior to the *Leahy Smith America Invents Act* of 2011, an applicant who has reduced his invention to practice in the United States and contemporaneously filed a first application to that invention could *delay* the one year priority period of the Paris Convention for the purpose of foreign filings by filing a *second* United States application to the same invention, while *also* abandoning the first application under certain conditions. In this way, the applicant could maintain his domestic priority right by reliance upon his date of invention in the United States, while at the same time delaying his effective filing date so that foreign counterpart applications could be filed within one year of *second* United States application.

Here, the applicant could rely upon the “first inventor” system to establish a domestic priority right as of his invention date, but at the same time permit a delayed foreign filing up to one year from the *second* United States application.

## V. CHANGED CIRCUMSTANCES OF THE NEW PATENT LAW

The opportunity to have both an early domestic priority date (based upon a date of invention) coupled with a deferred priority date for overseas applications does not exist under the *Leahy Smith America Invents Act* of 2011.

On the one hand, it is still possible to abandon the first application and obtain a deferred priority date for foreign filings through the filing of a second United States application, thus deferring the expiration of the one year grace period to expire on the anniversary of that second filing.

On the other hand, it is no longer possible to prove a date of invention for purposes of the United States as of the first (abandoned) application, because under the first-to-file regime of the *Leahy Smith America Invents Act* of 2011 establishing a date of invention is outside the scope of the new patent law.

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## VI. STRICT STATUTORY AND TREATY LIMITATIONS

There is no “trick” or “gimmick” envisioned either in the treaty scheme of the Paris Convention nor under the *Leahy Smith America Invents Act* of 2011 whereby the first filing date can be restored in the context of international patent rights for Europe or Asia.

The text of Art. 4C(4) of the Paris Convention expressly provides as a condition for priority to a second application that “at the time of filing the [second,] subsequent application, the said previous [first] application has been \* \* \* abandoned \* \* \* without having been laid open to public inspection and without leaving any rights outstanding \* \* \*.”

“A [second,] subsequent application concerning the same subject [matter] as a previous first application \*\*\* filed in the same country of the Union shall be considered as the first application [which then becomes the] starting point of the [one year] period of priority, if, at the time of filing the [second,] subsequent application, the said previous [first] 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.”<sup>8</sup>

The priority deferral strategy made sense in limited situations for domestic applicants because under the “first inventor” system the applicant could rely upon an actual date of invention for priority purposes (retaining an effective date of invention without reliance on the first application) while opening the door to a delayed Paris Convention filing in Europe, Asia and elsewhere because of a reset priority date because “*at the time of filing* the [second,] subsequent application, the said previous [first] application has been withdrawn, abandoned, or refused,

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<sup>8</sup> Paris Convention Art. 4C(4), *Conditions for Priority to Second Application*.



without having been laid open to public inspection and without leaving any rights outstanding, and [where] it has not yet served as a basis for claiming a right of priority.”<sup>9</sup>

To the extent that an American patent priority right is important, this pre-2011 scheme to reset the priority right doesn't work: Thus, a condition of the scheme to reset the priority date for foreign filings is that by the time of filing the second (new domestic priority) filing, “the [first] application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding.”<sup>10</sup>

The critical difference versus the law prior to 2011 is that under the prior law *with* the benefit of the first inventor system, the domestic priority rights could be based on an actual first reduction to practice; but, since the 2011 change in the law, priority rights can no longer be based upon an actual date of invention but must be based upon the filing date of the earlier application.

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<sup>9</sup> Art. 4C(4), *Conditions for Priority to Second Application*.

<sup>10</sup> The full text of Art. 4C(4), *Conditions for Priority to Second Application*, is as follows: “A subsequent application concerning the same subject [matter] as a previous first application \*\*\* 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.”

The *Leahy Smith America Invents Act* of 2011 codifies the limitation to the Paris Convention of Art. 4C(4) through 35 USC § 119(c) that provides that “the [priority] right \* \* \* may be based upon a *subsequent* regularly filed application in the same foreign country instead of the *first filed* foreign application, provided that any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.”

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## VII. DISCLOSED (UNCLAIMED) INVENTION IN THE FIRST FILING

The Paris Convention, Art. 4H, *Substantive Disclosure Requirement for Priority*, makes it clear that priority is based upon a *disclosure* of the invention in the priority application, without regard to whether the disclosed feature is also *claimed* in that priority application: “Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application in the country of origin, provided that the application documents as a whole specifically disclose such elements.” Article 4H has been an integral part of the Paris Convention since its introduction as part of the 1934 London Revision.<sup>11</sup>

The United States domestic law is consistent with Paris Convention Art. 4H. Thus, according to *Olson v. Julia*, 209 USPQ 159, 1979 WL 25148, slip op. at 5-7 (PTO Bd.Pat.Inter. 1979), an invention that is *disclosed* in a foreign application is basis for priority even if it does not *claim* the invention. Thus, if the applicant in the United States seeks to *claim* an invention that is also *claimed* within one year of a foreign application, the fact that there is an application in that foreign country filed more than 12 months before the United States application is basis to deny

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<sup>11</sup> Bodenhausen, *supra*, note a. The origins of this provision are explained by Dr. Bodenhausen: “Most domestic laws require that the subject for which protection by a patent is claimed must be defined in the patent application in one or more claims, but in some countries these claims have to be very specific, whereas in other[ ] [countries] the indication of the principles of the invention suffices. In view of these differences the right of priority must be recognized even for elements of the invention which do *not* appear in the *claims* of the application on which the right of priority is based.” Bodenhausen Guide, *supra* note c.

priority where that earlier foreign application *discloses* but does not *claim* the same invention. As explained in *Olson v. Julia*, slip op. at 5-7:

The first question to be resolved in this case is what is meant by the expression “application for a patent for the same invention”. Julia insists that the same invention must be *claimed* in the foreign application (as concurred in by the Primary Examiner) while Olson states that the invention need only be *disclosed*. We are in agreement with Olson's interpretation [that the invention only needs to be disclosed] for the following reasons. 35 USC 119 provides for a right of priority in conformity with the Convention of Paris for the Protection of Industrial Property of 20th March 1883 (Paris Convention), a treaty between various countries including the United States and France (adhered to by the United States in 1887). Article 4 of the Convention relates to the right of priority and Section H, introduced into the Convention in 1934, provides the following:

“Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application in the country of origin, provided that the application documents as a whole specifically disclose such elements.”

Professor G.H.C. Bodenhausen, Director of the Bureau for the Protection of Intellectual Property (BIRPI) has written a book entitled “Guide to the Application of the Paris Convention for the Protection of Industrial Property” (as Revised at Stockholm in 1967), published by BIRPI in 1968 (Geneva, Switzerland). He comments as follows with respect to Article 4, Section H (page 58; original emphasis):

“(c) Most domestic laws require that the subject for which protection by a patent is claimed must be defined in the patent application in one or more claims, but in some countries these claims have to be very specific, whereas in others the indication of the principles of the invention suffices. In view of these differences the right of priority must be recognized even for elements of the invention which do *not* appear in the *claims* of the application on which the right of priority is based.

“(d) It will suffice for the claiming of the right of priority in a subsequent patent application if the elements of the invention for which priority is claimed are specifically disclosed in the documents of the previous application *as a whole*

(including the description of the invention, drawings (if any), charts, etc.). The administrative or judicial authorities of the country where priority is claimed will determine whether this condition is fulfilled.<sup>2</sup>” [footnote omitted]

The provision under consideration must, however, work in two directions. On the one hand, priority will be recognized on the basis of a previous application for all elements of the invention specifically disclosed in that application *as a whole*. On the other hand, if an even earlier application *as a whole* has already specifically disclosed these elements, that application will be considered the *first* application and priority cannot be recognized on the basis of the application mentioned earlier. In the case of *Nelson v. Wolf*, 97 F.2d 632 (CCPA 1938), the court held that Wolf was entitled to rely upon a German application which contained a claim to a process even though the interference counts in issue (and presumably the corresponding claims of Wolf's U.S. application) were drawn to compositions of matter, based on the fact that the subject matter of the counts was disclosed in the German application. The court commented as follows:

“Upon the general proposition that it is immaterial whether a foreign application *claims* the subject matter of the counts so long as it clearly *discloses* such subject matter, the decision of this court in the case of *Lorenz K. Braren v. George Horner*, 18 CCPA (Patents) 971, 47 F.2 358 is apropos. [38 USPQ 139]”

In the more recent case of *Kawai v. Metlesics*, 480 F.2d 880 (CCPA 1973), the court was concerned with the question of whether a foreign application had to contain an adequate disclosure of utility in order to provide benefit for the claimed compounds of a U.S. application. The court held the following:

In summary, it is our view that the purpose of the Paris Convention was to have an application made in a foreign country treated as the equivalent of a domestic filing. We believe that equivalent treatment is accorded when the foreign application is weighed under the first paragraph of section 112 in the same manner as would a U.S. application under section 120. [178 USPQ 165]

In that case the court looked to the disclosure of the Japanese application of Kawai to determine whether the requirements of 35 USC 112 were met as to the subject matter in issue in an interference.

We find no authority to support the view that a foreign application must claim the same invention as that being claimed in the U.S. application in order for the

applicant to be able to rely upon the foreign application for benefit under 35 USC 119. Indeed, such an interpretation would be inconsistent with the provisions of the above noted Paris Convention and contrary to the decisions of the court in *Nelson v. Wolf* and *Kawai v. Metlesics*, *supra*. Accordingly, we must look to the entire disclosure of the French application filed April 10, 1972 in order to determine whether the invention of the count is described therein.

In order for an earlier filed foreign application to defeat priority rights under 35 USC 119 that application should be in compliance with the requirements of the first paragraph of 35 USC 112. This is consistent with the requirements set forth in *Kawai v. Metlesics*, *supra*, regarding the right to benefit of the filing date of a foreign application. Thus, it is necessary that the French addition application filed April 10, 1972 contain an adequate description of the subject matter of the count in order to defeat Julia's priority rights. We hold that it does not.

There is no specific example of any compound within generic formula VII in the French application of April 1972. It is thus necessary to pick and choose from two lists of substituents for R and A (in compound VII) in order to arrive at a compound within the scope of the count. R is defined as alkyl, aryl-alkyl or aryl radical that may be substituted. A is defined as follows (according to the translation supplied by Olson):

In this formula A represents a hydrocarbon radical containing a number of carbon atoms equal to  $5n + 1$ , with n possibly being one of the numbers 0, 1, 2, 3, 4 or 5; this radical may be saturated or unsaturated, a conjugated or nonconjugated polyene; when n is between 1 and 5, this radical may be functionalized or substituted by alkyl groups; when n is equal to or exceeding 2, this radical may include a ring to which may be attached alkyl groups and/or functional groups such as O= or OH-, which can be protected or unprotected.

A may also be a functional group corresponding to one of the definitions given below for Q, while it is not necessary that A be identical with Q.

Q stands for a methyl radical, which may be substituted by a halogen atom or a -SR' or -SO<sub>2</sub>R' group in which R' represents the definition given above for R and may be identical with or different from this.

Q may also represent: -a primary alcohol group  $-CH_2 OH$ , the ethers corresponding to this group or the esters formed by this group with inorganic or organic acids; -a protected or unprotected aldehyde group; -an acid group  $-COOH$ , its acid chloride, its esters or corresponding nitrile; -a hydrocarbon radical corresponding to the definition of A, given above, but which may be identical with or different from it. The single example shows the production of a final product wherein R is phenyl, but this final product is not produced from an intermediate of formula VII. Thus, we find no directions in the French addition application which would lead one to select phenyl as the R substituent in conjunction with  $CH_2 OH$  as the A substituent for a compound encompassed by formula VII.

Although it is not essential that compounds of the counts be named, it is a requirement that the specification contain a description which would reasonably lead one of ordinary skill to such compounds in order to provide adequate support therefor. *Flynn v. Eardley*, 479 F.2d 1393 (CCPA 1973); *Fields v. Conover*, 443 F.2d 1386 (CCPA 1971). Also see *In re Ruschig*, 379 F.2d 990 (CCPA 1967). Here, we do not find such a description and are of the opinion that selection of the appropriate substituents to obtain a compound of the count, based on the disclosure of the French addition application of April 1972, would be merely fortuitous. Olson has noted that in Example 10 of the French parent application of February 1972 a compound is disclosed which is the methyl ether of the hydroxy compound of the count. This compound has the closest structural similarity to the compounds of the count.<sup>3</sup> However, despite the additional example in the parent application we are of the opinion that the description of a single compound within formula VII, in which R is a phenyl group is not enough to lead one to fix R as a phenyl substituent and to then choose  $CH_2OH$  as the substituent for A in conjunction therewith.

We conclude that French application 72/12477 filed April 10, 1972 as an addition to application 72/03482 filed February 2, 1972 does not satisfy the description requirement of 35 USC 112 regarding the subject matter of the count. Accordingly, the earliest filed foreign application for the invention of the count which complies with the requirements of 35 USC 112 was filed by Julia within 12 months of the filing date of his U.S. application. Thus, Julia is entitled to the benefit of the French applications filed in December 1972.

## VIII. EARLIER FILING BY A DIFFERENT INVENTIVE ENTITY

Looking to the history of 35 USC § 119(a), the court in *Vogel v. Jones* held that “[s]ince under United States law an application for patent must be made by the inventor, that practice was based on the requirement that the foreign application, regardless of the identity of the applicant, must have been filed for an invention actually made by the inventive entity seeking to rely upon it for priority purposes.”<sup>12</sup>

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<sup>12</sup> *Vogel v. Jones*, 486 F.2d 1068, 1071 (CCPA 1973). More fully, the court stated that:

Vogel ... contends that on its face 35 U.S.C. § 119 precludes Jones from relying upon [Jones British application] 41976 for priority. In support of this contention, Vogel looks to the language of § 119 which reads, in pertinent part, as follows:

**§ 119. Benefit of earlier filing date in foreign country; right of priority**

An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was *first filed* in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed \* \* \*. [Emphasis added.]

Vogel's position is that Brit. 41976 is not the “first filed” application referred to in § 119. Instead, if one assumes that the Dewing patent discloses the subject matter of the counts, a point considered irrelevant to its decision by the board, the application underlying that patent was the “first filed.” According to him, ICI was, under British practice, not merely Jones' and Dewing's assignee but the actual applicant for patents on their inventions. Therefore, of necessity Brit. 41976 must be considered the second filed application by ICI, Jones' assignee, for the same invention covered by the counts and therefore cannot be relied upon for priority under § 119.

For his part, Jones argues that § 119 gives rise to a right of priority that is personal to the United States applicant. Therefore, an application made by an inventor's assignee in a foreign country cannot be the basis for priority unless made on his behalf. Carrying this logic one step further, the existence of an application made by that assignee in a foreign country on behalf of one other than the United States inventor is irrelevant to his right of priority based on applications made on his behalf. We agree.



Priority via 35 USC § 119(a) under *Vogel v. Jones* applicable prior to the *Leahy Smith America Invents Act* of 2011 is *identically* carried forward in the 2011 law as follows:

“[Priority is awarded to] any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States \*\*\*.”

Judge Cocks in his opinion in *Valeo North America* explains the continued validity of *Vogel v. Jones*:

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The predecessor statute (R.S. 4887) to § 119 was enacted on March 3, 1903 (32 Stat. 1225) to implement the Paris Convention<sup>4</sup> to which the United States was an adherent. Unlike § 119, that statute did not expressly provide for a right of priority based on applications filed by “legal representatives or assigns” rather than the inventor himself. Nevertheless, it was early recognized that an application made by another could be the basis for a claim for priority by a United States applicant. See, for example, *Steel v. Myers*, 1914 C.D. 74, and *De Jahn v. Gaus*, 23 F.2d 762 (App. D.C. 1927).

This practice arose because it was recognized that in many foreign countries, unlike in the United States, the actual applicant for a patent can be other than the inventor, e. g., an assignee. In light of this, we regard the language in § 119 referring to legal representatives and assigns to merely represent a codification of the actual practice under R.S. 4887. *Since under United States law an application for patent must be made by the inventor, that practice was based on the requirement that the foreign application, regardless of the identity of the applicant, must have been filed for an invention actually made by the inventive entity seeking to rely upon it for priority purposes.* We think § 119 must be construed to the same end. Therefore, this means that an applicant for a United States patent can rely for priority on the “first filed” application by an assignee on his behalf.

In view of our holding, one caveat is in order. 35 U.S.C. § 115 requires that an applicant for a patent “\* \* \* shall make oath that he believes himself to be the original and first inventor \* \* \* [of the subject matter] for which he solicits a patent \* \* \*. Our holding in this case *presumes* that inasmuch as Jones made such an oath, he believed himself to be the first inventor of the subject matter. Certainly no attack has been made upon the validity of that oath.

*Vogel v. Jones*, 486 F.2d at 1071-72 (emphasis supplied in part; footnote omitted).

In *Vogel* [*v. Jones*, 486 F.2d 1068 (CCPA 1973)], an inventor Jones had assigned the rights to a U.S. patent application to Imperial Chemical Industries Ltd. (“ICI”). That U.S. patent application claimed priority to a British application. Vogel took the position that Jones could not claim the benefit of priority to the British application because of the existence of another prior patent application filed by different inventors, but also assigned to ICI. The [CCPA] rejected Vogel's argument. The court concluded that the right to priority arising under § 119 was “personal” to Jones and that the existence of a foreign application with the same assignee (ICI), but filed on behalf of different inventors, was “irrelevant” to Jones's right of priority based on his own applications. *Vogel*, 486 F.2d at 1072. In *Boston Scientific*, the Court of Appeals for the Federal Circuit held that *Vogel* remained “binding” precedent. *Boston Scientific Scimed, Inc. [v. Medtronic Vascular, Inc.]*, 497 F.3d 1293, 1297 (Fed. Cir. 2007).<sup>13</sup>

The view of Judge Cocks in *Valeo North America* in dicta is consistent with *Cragg v. Martin* that explains that while over the years there have been statutory changes that modify priority rights as to domestic priority as foreign priority under “35 U.S.C. § 119, [this section] still includes the language concerning filing in a foreign country by assigns or legal representatives of the one who files for that invention in the United States.”<sup>14</sup>

<sup>13</sup> In *Valeo North America, Inc. v. Schaeffler Technologies AG & Co. KG*, 2017 WL 2791164, slip op. at 3 (Patent Tr. & App. Bd. 2017)(Cocks, APJ).

<sup>14</sup> *Cragg v. Martin*, 2001 WL 1339890, slip op. at 4 (Bd.Pat.App. & Interf., (date appr. 2001)(Lee, APJ)(“Our view is consistent with the opinion of the Court of Customs and Patent Appeals in *Vogel v. Jones*, 486 F.2d 1068, 1072 (CCPA 1973), wherein the court determined that a foreign application made by the assignee of a U.S. applicant, on behalf of one other than the United States inventor, is irrelevant to the rights of priority of the U.S. inventor. The *Vogel* case concerns 35 U.S.C. § 119, not 35 U.S.C. § 116 or § 120. \* \* \* *Vogel* has not been made outdated by statutory amendments to 35 U.S.C. § 116 and § 120 in 1984. The inventive entity may not always be identical between a U.S. application as a whole and an ancestral corresponding application in a foreign application. *E.g., Reitz v. Inoue*, 39 USPQ2d 1838, 1840) (Bd. Pat. App. & Int. 1996)(“the proposition that the inventive entity must be the same in both the foreign and the corresponding U.S. application in order to obtain benefit can no longer be accepted, if it ever was, as a hard and fast rule in view of the liberalization of the requirements for filing a U.S. application as joint inventors wrought by the 1984 amendment of 35 U.S.C. § 116.”). But with regard to any particular invention at issue or involved in an interference, 35 U.S.C. § 119 still

In *dictum* in the *Fioravanti* case (a trademark matter), citing *Olson v. Julia*, 209 USPQ 159, 164 (Bd. Pat. Int. 1979), the Board explains *Vogel v. Jones* does *not* bar priority based upon an earlier filing by a different inventive entity:

“[S]ince the earlier application, albeit by the same applicant [assignee] as the applicant of the application on the basis of which priority was claimed, was filed on behalf of a different inventor, the earlier filing was not by the same inventive entity and, hence, did not render the priority claim inoperative.”<sup>15</sup>

Consistent with *Vogel v. Jones* is *Olson v. Julia*, 209 USPQ 159, 1979 WL 25148 (PTO Bd.Pat.Inter. 1979), where a common assignee filed a first overseas application more than one year before the United States filing date in the name of a first inventive entity and then *within* the convention year files a second overseas

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*includes the language concerning filing in a foreign country by assigns or legal representatives of the one who files for that invention in the United States.”*(emphasis added).

<sup>15</sup> *Fioravanti v. Fioravanti Corrado S.R.L.*, 1 U.S.P.Q.2d 1304, 1986 WL 83309, slip op. at 3 (Trademark Tr. & App. Bd. 1986), 1986 WL 83309 (PTO Trademark Trial and Appeal Board 1985)(\*\*\* [U]nder [United States] patent law [ ] a claimed right of priority under 35 U.S.C. § 119 \* \* \* is rendered inoperative if an earlier application disclos[es] the same subject matter (invention was filed by the same inventive entity). [The only exception is where the earlier application has been ‘withdrawn, abandoned or otherwise disposed of without having been laid open to inspection and without leaving any rights outstanding . . . etc.,’ the exception provided as a result of the Lisbon revision of the Paris Convention. *See generally*, I Ladas, PATENTS, TRADEMARKS, AND RELATED RIGHTS §264 (1975).] *Vogel v. Jones*, 486 F.2d 1068 (CCPA 1973). In *Vogel*, in considering whether an earlier application, rather than the one on the basis of which priority was claimed, was the ‘first filed’ application, the court above recognized that the fact that the earlier application had been filed by the assignee of the inventor/applicant in the United States was not crucial, it having long been recognized that the language of § 119 accommodated a procedural difference between practice here and in foreign countries, namely that in the United States an application for patent must be made by the inventor whereas in most foreign countries the applicant can be other than the inventor, e.g., an assignee. However, since the earlier application, albeit by the same applicant as the applicant of the application on the basis of which priority was claimed, was filed on behalf of a different inventor, the earlier filing was not by the same inventive entity and, hence, did not render the priority claim inoperative. *See also*, *Olson v. Julia*, 209 USPQ 159, 164 (Bd. Pat. Int. 1979).”

application in the name of a different inventive entity (which is also the United States nominated inventive entity), the filing of the first overseas application does not disqualify the second overseas application from serving as a priority basis for the United States application.

Thus, an application filed by a different inventive entity in a foreign country more than one year before the United States filing date does not preclude a valid claim of priority based upon a filing within the one year period before the United States filing which is filed by the same inventive entity as the United States application, as explained in *Olson v. Julia*, slip op. at 8:

[T]he French applications of February and April 1972 [filed more than a year before the United States filing date] \*\*\* could \*\*\* not be used to defeat Julia's priority claim [based on an application filed in France within the convention year] unless [the earlier French applications] were filed on behalf of Julia. In *Vogel v. Jones*, 482 F.2d 1068, (CCPA 1973), the court made the following statement:

“For his part, Jones argues that §119 gives rise to a right of priority that is personal to the United States applicant. Therefore, an application made by an inventor's assignee in a foreign country cannot be the basis for priority unless made on his behalf. Carrying this logic one step further, the existence of an application made by that assignee in a foreign country on behalf of one other than the United States inventor is irrelevant to his right of priority based on applications made on his behalf. We agree.”

Also see *Schmitt v. Babcock*, 377 F.2d 994 (CCPA 1967) wherein the court held that in order for applicants to obtain the benefit of the filing date of a foreign application under 35 USC 119, the inventive entity must be the same in both the foreign and the corresponding U.S. application.<sup>[\*]</sup>

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<sup>[\*]</sup>*Schmitt v. Babcock* is dismissed as contrary to a later court decision in *Cragg v. Martin*, 2001 WL 1339890, slip op. at 5 (Bd.Pat.App. & Interf. published 2001)(Lee, EIC): “*Schmitt v. Babcock*, 377 F.2d 994 (CCPA 1967), \*\*\* from a pre-1984 era, relates to an inconsistency or disagreement in inventorship between the U.S. application and the foreign application and a

Thus, the burden is on Olson to show that the French applications of February and April 1972 were filed on behalf of Julia and Menet since this is what he alleges. Initially we note that the February 1972 application, on page 1, contains the statement that Pierre Chabardes, Marc Julia and Albert Menet collaborated in the invention described therein (as concerning new polyene sulfones and their use as materials for organic synthesis). The April 1972 application is described as an addition to the February 1972 application and does not name the inventors. Thus, the only listed inventive entity in the earliest French applications is not the same as that of Julia's involved application. In view of this discrepancy and in the absence of any other evidence, we have no reason to conclude that the earliest French applications were filed by the assignee on behalf of Julia and Menet. Accordingly, based on the record before us, these earliest French applications were not the first filed by Julia for the invention of the count. On this additional basis Julia is entitled to benefit of the French applications filed in December 1972.

The requirement for an identity of the priority filing and U.S. filing inventive entities is also stated by Examiner-in-Chief Downey in her opinion in *Quinolinecarboxylic Acid Derivatives*, 1990 WL 354602, 18 U.S.P.Q.2d 1362 (Bd.Pat.App. & Interf. 1990). Citing *Olson v. Julia*, 209 USPQ 159 (Bd.Pat.Int.1979), she explains that “35 USC 119 requires that the previously filed foreign application must have been filed within twelve months prior to the filing date of the United States application and it must have been filed on behalf of the same inventive entity as in the domestic application.” *Id.*, slip op. at 6.

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resolution of that disagreement prior to accordance of benefit. Here, inconsistency or disagreement in inventorship is not the issue. Nothing in *Schmitt* purports to not recognize the filing by assigns requirement of 35 U.S.C. § 119. Even if it does, that would be contrary to [*Vogel v. Jones*, 486 F.2d 1068, 1072 (CCPA 1973),] which is later in time and thus takes precedent over *Schmitt*.”

Distinguishing *sub silentio* *Quinolinecarboxylic Acid Derivatives* in *Reitz v. Inoue*, 39 U.S.P.Q.2d 1838, 1995 WL 877192, slip op. at 2-4 (Bd.Pat.App. & Interf. 1995), the inventive entities are permitted to differ between a priority and U.S. application, as explained by Judge Caroff:

We agree with Inoue that Reitz's position [attacking the benefit accorded to Inoue as to Japan '809 because of a difference in inventive entities] does not pass muster. Reitz argues that Inoue is not entitled to the benefit of the filing date of Japan '809 under 35 U.S.C. § 119 because the inventive entity in Japan '809 (Akio Inoue alone) is not the same as in Inoue's corresponding U.S. application (Akio Inoue and Yoshio Suzuki). According to Reitz, the inventive entity must be the same in both the foreign and corresponding U.S. application for Inoue to obtain benefit of the filing date of the earlier-filed foreign application under 35 U.S.C. § 119. In making this argument, Reitz relies primarily upon *Schmitt v. Babcock*, 377 F.2d 994 (CCPA 1967); *Olson v. Julia*, 209 USPQ 159, 164 (Bd.Pat.Int.1979); and *Irikura v. Petersen*, 18 USPQ2d 1362, 1367 (Bd.Pat.App. & Int.1990). Upon careful perusal of these cases, we find that they are not controlling here.

In *Schmitt*, the court apparently deferred to the MPEP guidelines extant at the time by referring to them with evident approval. Since those guidelines have subsequently been changed to be consistent with amendments made to the statutory section dealing with joint inventorship (35 U.S.C. § 116), Inoue is correct in stating that *Schmitt* is outdated. Our approach here is essentially no different than that taken in *Schmitt* with, of course, some accommodation being made for changes in the law and in current practice regarding inventorship. In *Schmitt*, the court refers to MPEP § 201.15 which then, as now, essentially required that where the inventive entity differs in the foreign and in the United States application, the examiner should refuse to recognize the priority date until the inconsistency or disagreement is resolved. In *Schmitt*, the court took notice of the conversion in France of the foreign application there involved to joint inventorship status, which was consistent with the joint inventive entity named in the corresponding U.S. application. Thus, the “disagreement” was resolved. Here, the apparent inconsistency between inventive entities has been satisfactorily resolved/explained by Inoue's reliance upon the amended version of 35 U.S.C. § 116, the corresponding revised MPEP guidelines, and the declarations of Inoue and Suzuki which indicate that Inoue is the sole inventor with respect to subject matter embraced by at least some of Inoue's claims corresponding to the count. Cf. 37

C.F.R. § 1.110. No evidence has been adduced by Reitz that Inoue and Suzuki, or their assignee, did not cause to be filed in Japan a regular application, or that Inoue is not a sole inventor with respect to at least some involved claims. Accordingly, we must conclude that the party Inoue has complied with all of the relevant provisions of 35 U.S.C. § 119 as those provisions have been construed in Schmitt. In effect, the proposition that the inventive entity must be the same in both the foreign and the corresponding U.S. application in order to obtain benefit can no longer be accepted, if it ever was, as a hard and fast rule in view of the liberalization of the requirements for filing a U.S. application as joint inventors wrought by the 1984 amendment of 35 U.S.C. § 116.

*Olson* and *Irikura* are inapposite since in both of those cases, unlike the present factual situation, the involved U.S. application was apparently filed in the name of less than all of the inventors listed on the foreign counterpart application at issue.

Reitz insists that we should refuse to follow the MPEP guidelines since they do not have the force of law. While the MPEP may not have the force of law, or wield as much authority as the rules of practice, its interpretation of the statutes and rules is nevertheless entitled to considerable deference with respect to issues not specifically addressed by the courts. Cf. *Morganroth v. Quigg*, 885 F.2d 843, 848 (Fed.Cir.1989). We have such an issue here, i.e., interpretation of one statutory provision (35 U.S.C. § 119) in light of changes made in another section of the statute (35 U.S.C. § 116).

## Wegner, *Paris Convention Priority Pitfalls*

We believe the MPEP correctly interprets the current state of the law as follows:

Joint inventors A and B in an application filed in the United States Patent and Trademark Office may properly claim the benefit of an application filed in a foreign country by A and another application filed in a foreign country by B, i.e., A and B may each claim the benefit of their foreign filed applications [MPEP § 201.13].

Where two or more foreign applications are combined to take advantage of the changes to 35 U.S.C. 103 or 35 U.S.C. 116, benefit as to each foreign application may be claimed if each complies with 35 U.S.C. 119 and the U.S. application inventors are the inventors of the subject matter of the foreign applications. For example, if foreign applicant A invents X; and files a foreign application. Applicant B invents Y and files a separate foreign application. A + B combine inventions X + Y and file U.S. application to X + Y and claim 35 U.S.C. 119 benefit for both foreign applications: then 35 U.S.C. 119 benefit will be accorded for each foreign application if 35 U.S.C. 119 requirements are met [MPEP § 605.07].

In our opinion, this is a reasonable and logical interpretation of 35 U.S.C. § 119 in light of the changes to 35 U.S.C. § 116, and is not contrary to law. Any other conclusion would be inconsistent with the spirit and scope of amended section 116 of the statute.

Reitz postulates that had Congress intended to change 35 U.S.C. § 119, it would have done so explicitly when it amended 35 U.S.C. § 116 and 35 U.S.C. § 120. However, we agree with Inoue that the failure of Congress to expressly amend § 119 is not dispositive. Rather, an equally rational explanation is that Congress did not amend § 119 because no amendment was necessary. As we have explained above, section 119, in its present form, permits the result reached here. In contrast, § 116 and § 120 contain more explicit language regarding inventorship than does § 119. Thus, prior to amendment in 1984, § 116 and § 120 clearly would not permit what is now expressly provided for by broadened statutory language.



Moreover, as noted by *Inoue*, case law recognizes the parallels between sections 119 and 120. *In re Gosteli*, 872 F.2d 1008 (Fed.Cir.1989); *Kawai v. Metlesics*, 480 F.2d 880 (CCPA 1973). Thus, since 35 U.S.C. § 116 and 35 U.S.C. § 120 now accommodate situations where different claims in an application may have different inventive entities, § 119 can and should be construed to accommodate those situations as well to preserve symmetry of treatment between sections 119 and 120.

For all of the above reasons, we agree with *Inoue* that Reitz has failed to satisfy his burden of persuasion.

*Reitz v. Inoue* is followed by *Cragg v. Martin*, 2001 WL 1339890, slip op. at 4-5 (Bd.Pat.App. & Interf. published 2001)(Lee, APJ):

The statutory basis of Fogarty's preliminary motion [to deny the senior party the benefit of earlier European applications on the grounds that neither application was filed by (i) the individual now identified as the inventor or (ii) on his behalf by his legal representatives or assigns] is 35 U.S.C. § 119, which states, in pertinent part:

“(a) An application for patent for an invention filed in this country by **any person who has, or whose legal representatives or assigns have**, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; ....” (Emphasis added [by the Board].)

[W]e agree [with the motion panel's decision on reconsideration] and adopt herein:

“We interpret the above-quoted ‘any person who has, or whose legal representatives or assigns have’ language as meaning that the previously filed foreign application must have been filed by the person or one who was, at the time of filing of the previously filed foreign application, already a legal representative or assign of that person. This view is necessary to ensure a link between the presently involved application and the earlier filed foreign application with respect to the particular inventor. A contrary interpretation would cause entitlement to benefit to be negotiable as a commodity between unrelated entities. Note that if party Martin or party Fogarty now assigned its involved patent or application to MINTEC, that does not and should not mean party Martin or party Fogarty's involved case should suddenly be entitled to the benefit of the earlier filing dates of party Cragg's European applications, on the basis that the European applications were previously filed by MINTEC who is now the assignee of party Martin or party Fogarty's involved patent or application.”

Our view is consistent with \* \* \* *Vogel v. Jones*, 486 F.2d 1068, 1072 (CCPA 1973), wherein the court determined that a foreign application made by the assignee of a U.S. applicant, on behalf of one other than the United States inventor, is irrelevant to the rights of priority of the U.S. inventor. The *Vogel* case concerns 35 U.S.C. § 119, not 35 U.S.C. § 116 or § 120. \* \* \* *Vogel* has not been made outdated by statutory amendments to 35 U.S.C. § 116 and § 120 in 1984. The inventive entity may not always be identical between a U.S. application as a whole and an ancestral corresponding application in a foreign application. E.g., *Reitz v. Inoue*, 39 USPQ2d 1838, 1840 (Bd. Pat. App. & Int. 1996) (“the proposition that the inventive entity must be the same in both the foreign and the corresponding U.S. application in order to obtain benefit can no longer be accepted, if it ever was, as a hard and fast rule in view of the liberalization of the requirements for filing a U.S. application as joint inventors wrought by the 1984 amendment of 35 U.S.C. § 116.”). But with regard to any particular invention at issue or involved in an interference, 35 U.S.C. § 119 still includes the language concerning filing in a foreign country by assigns or legal representatives of the one who files for that invention in the United States.

We have reviewed *Schmitt v. Babcock*, 377 F.2d 994 (CCPA 1967), a case mentioned by Cragg during oral argument at final hearing as somehow being in support of its position, but it does not help Cragg's position. The *Schmitt* case, from a pre-1984 era, relates to an inconsistency or disagreement in inventorship between the U.S. application and the foreign application and a resolution of that disagreement prior to accordance of benefit. Here, inconsistency or disagreement in inventorship is not the issue. Nothing in *Schmitt* purports to not recognize the filing by assigns requirement of 35 U.S.C. § 119. Even if it does, that would be contrary to the *Vogel* case which is later in time and thus takes precedent over *Schmitt*.

It is noted that the *Manual of Patent Examining Procedure* provides that for purposes of Paris Convention priority “the foreign application must have been filed by the same applicant as the applicant in the United States \*\*\*. Consistent with longstanding Office policy, this is interpreted to mean that *the U.S. and foreign applications must \* \* \* have at least one joint inventor in common.*”<sup>16</sup>

<sup>16</sup> MPEP § 213.02, *Formal Requirements Relating to Foreign Priority Application* [R-07.2015], § II, *The Same Inventor Or at Least One Common Joint Inventor* (emphasis added). *In toto*, the MPEP provision states: “Pursuant to 35 U.S.C. 119(a), the foreign application must have been filed by the same applicant as the applicant in the United States, or by his or her legal representatives or assigns. Consistent with longstanding Office policy, this is interpreted to mean that the U.S. and foreign applications must name the same inventor or have at least one joint inventor in common. For example, a right of priority does not exist in the case of an application of sole inventor A in the foreign country and sole inventor B in the United States, even though the two applications may be owned by the same party. The application in the foreign country may have been filed by the assignee, or by the legal representative or agent of the inventor, rather than by the inventor, but in such cases the name of the inventor is usually given in the foreign application on a paper filed therein. Joint inventors A and B in a nonprovisional application filed in the United States Patent and Trademark Office may properly claim the benefit of an application filed in a foreign country by A and another application filed in a foreign country by B, i.e., A and B may each claim the benefit of their foreign filed applications. See MPEP § 602.09.”

## IX. OLD LAW DEFERRAL OF CONVENTION EXPIRATION

Until the effective date of the *Leahy Smith America Invents Act* of 2011 it was a not uncommon practice to *defer* the expiration of the one year period for obtaining foreign priority based upon a United States first filing by employing Art. 4C(4) of the Paris Convention to *abandon* the United States first filing and *replacing* that first filing with a *second* United States application that would *restart* the one year Paris Convention deadline for foreign filing in Europe, Asia and elsewhere. Critical to this strategy was reliance upon establishment of a date of invention under the “first inventor” law prior to the *Leahy Smith America Invents Act* of 2011: But, to the extent that an early United States priority date is important under the new law – where a date of invention can no longer be relied upon to establish priority – the old system to extend the period for foreign filing no longer is operative: As a condition to reset the priority date for foreign filings to the date of a second United States application, under Art. 4C(4) the Paris Convention the first application had to have been “abandoned \* \* \* without having been laid open \* \* \* without leaving any rights outstanding \* \* \*.”

Thus, the text of Art. 4C(4) of the Paris Convention was not changed contemporaneously with the *Leahy Smith America Invents Act* of 2011 which expressly provides as a condition for priority to the second application that “at the time of filing the [second,] subsequent application, the said previous [first] application has been \* \* \* abandoned \* \* \* without having been laid open to public inspection and without leaving any rights outstanding \* \* \*.”

The Paris Convention further provides:

“A [second,] subsequent application concerning the same subject [matter] as a previous first application \*\*\* filed in the same country of the Union shall be considered as the first application [which then becomes the] starting point of the [one year] period of priority, if, at the time of filing the [second,] subsequent application, the said previous [first] 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.”<sup>17</sup>

Thus, the priority deferral strategy made sense in limited situations for domestic applicants because under the “first inventor” system the applicant could rely upon an actual date of invention for priority purposes (retaining an effective date of invention without reliance on the first application) while opening the door to a delayed Paris Convention filing in Europe, Asia and elsewhere because of a reset priority date because “*at the time of filing* the [second,] subsequent application, the said previous [first] application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and [where] it has not yet served as a basis for claiming a right of priority.”<sup>18</sup>

To the extent that an American patent priority right is important, this pre-2011 scheme to reset the priority right doesn't work: Thus, a condition of the scheme to reset the priority date for foreign filings is that by the time of filing the second (new domestic priority) filing, “the [first] application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and

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<sup>17</sup> Paris Convention Art. 4C(4), *Conditions for Priority to Second Application*.

<sup>18</sup> Art. 4C(4), *Conditions for Priority to Second Application*.

without leaving any rights outstanding.”<sup>19</sup> In other words, *with* the benefit of the first inventor system applicable to the law prior to 2011, the domestic priority rights could be based on an actual first reduction to practice; but, since the 2011 change in the law, priority rights can no longer be based upon an actual date of invention but must be based upon the filing date of the earlier application.

The *Leahy Smith America Invents Act* of 2011 codifies the limitation to the Paris Convention of Art. 4C(4) through 35 USC § 119(c) that provides that “the right provided \* \* \* may be based upon a *subsequent* regularly filed application in the same foreign country instead of the *first filed* foreign application, provided that any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.”

The origins of Article 4(C) date from the 1958 Lisbon Revision which “deal[s] with the exceptional circumstances in which a subsequent application for the subject concerned (patent, registration of utility model, industrial design \*\*\*) may be considered the *first* application, on which the right of priority is based[.]”<sup>20</sup>

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<sup>19</sup> The full text of Art. 4C(4), *Conditions for Priority to Second Application*, is as follows: “A subsequent application concerning the same subject [matter] as a previous first application \*\*\* 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.”

<sup>20</sup> Bodenhausen, *supra*, note a.

The issue here involves *identical* subject matter in two potential priority applications, where the *identity* of the matter means that without invoking the special procedures of this section, priority based upon the second application will be a nullity. (This is distinct from the situation of *related* subject matter in the two applications where priority may be based upon *both* applications, which is governed by Art. 4(F).)

Art. 4C(4) involves the less frequent but still fairly common situation is where the second application is filed to *replace* the first application, and the second application is to be used for priority purposes. Here, important subject matter is *common* to the first application as explained by Dr. Bodenhausen:

“A subsequent application”: “[I]t frequently happens \*\*\* that the first application, made in a hurry \*\*\* does not adequately represent the applicant’s intentions. Failing a special provision regulating this matter[,] the applicant would be unable to replace his [original] application by a better[-drafted] one without losing the right of priority, because the [better-drafted] application would not be the *first* concerning the same subject and therefore could not be recognized for the priority right. In order to eliminate this difficulty [Art. 4C(4)] allows, *under certain precise conditions*, a subsequent application to replace the first application for the purpose of claiming the priority right.”<sup>21</sup>

Thus, “the filing date [of the subsequent application] shall be the starting point of the period of priority”: “The filing date which will be considered the starting point of the period of priority will be the date of [the] *subsequent* application[;] the first application [is] disregarded \*\*\*.”<sup>22</sup>

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<sup>21</sup> Bodenhausen, *supra*, note b.

<sup>22</sup> Bodenhausen, *supra*, note d.

It is further provided by Dr. Bodenhausen that:

“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.”

As emphasized by Dr. Bodenhausen, *each* of the several conditions must, without exception, be met for the application of this restarted right of priority to be effective. Thus, “the following conditions have to be fulfilled with respect to the previous first application filed *for the same subject matter in the same country*;

“the previous application must, *before* the subsequent application is filed, have been *withdrawn, abandoned or refused*;

“the previous application must *not* have been *laid open to public inspection*;

“the previous application must *not leave any rights outstanding*;

“the previous application must *not yet* have served *as a basis for claiming a right of priority*, either in the same or in any other country.

“If any of these [five] conditions is not fulfilled, the country of the Union in which priority is claimed on the basis of the subsequent application will refuse to recognize this priority.

“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 or another 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 [application].”<sup>23</sup>

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<sup>23</sup> Bodenhausen, *supra*, note e.



After the subsequent filing, for priority to be maintained, “[t]he previous application may not thereafter serve as a basis for claiming a right of priority.”: Bodenhausen emphasizes that “[a]fter 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 country of the Union on the basis of the previous application.”<sup>24</sup>

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<sup>24</sup> Bodenhausen, *supra*, note f (original emphasis).

## X. “GHOST” FIRST FILING MAY DESTROY CONVENTION PRIORITY

On occasion, an applicant on “Day One” may file a first patent application that is less than perfect in its details, but nevertheless discloses Invention “X”. Almost immediately aware of the imperfect nature of the first application, a decision is made to *replace* that first application – the “ghost” first filing – with an almost identical second patent application that is also designed to be the priority basis for protection in Europe, Asia and elsewhere under the Paris Convention.

The “ghost” first filing is abandoned after the filing of the second patent application, and never again mentioned or used, so that the second, the “ghost”, becomes the priority application. Foreign filings in Europe, Asia and elsewhere are accomplished within one year from the date of the “ghost” first filing, but with a priority claim only to the second filing.

While the “ghost” is apparently buried, once uncovered, it dooms the priority right to the second application because the abandonment of the first filing has taken place *after* the filing of the second application, which therefore cannot be basis for priority for common subject matter shared by the first and second applications. Even if the first application had been abandoned prior to the filing date of the second application, there are other possible pitfalls that would negate a priority right based on the first application such as failure to have blocked laying the application open to public inspection, failure to deny leaving any rights outstanding or failure to have denied any claim of a priority right.<sup>25</sup>

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<sup>25</sup> Paris Convention Art. 4C(4), *Conditions for Priority to Second Application* (““A [second,] subsequent application concerning the same subject [matter] as a previous first application \*\*\*

One safe remedy in lieu of reliance on the Paris Convention is at the time of filing the second application to concurrently file a Patent Cooperation Treaty application nominating states that would normally be the subject of a later, Paris Convention filing. This PCT filing would be a *non-convention* application that would rely upon the actual filing date of the PCT application, and thereby avoid any issue of violation of the Paris Convention.

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filed in the same country of the Union shall be considered as the first application [which then becomes the] starting point of the [one year] period of priority, if, at the time of filing the [second,] subsequent application, the said previous [first] 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.”

## XI. SECOND APPLICATION DISCLOSING NEW MATTER

The *Manual* explains that the where a second filing foreign has new matter the 12 month period to file an application to such new matter expires one year from the date of the second filing:

The 12 months is from earliest foreign filing except as provided in 35 U.S.C. 119(c). If an inventor has filed an application in France on October 4, 1981, and an identical application in the United Kingdom on March 3, 1982, and then files in the United States on February 2, 1983, the inventor is not entitled to the right of priority at all; the inventor would not be entitled to the benefit of the date of the French application since this application was filed more than twelve months before the U.S. application, and the inventor would not be entitled to the benefit of the date of the United Kingdom application since this application is not the first one filed. *Ahrens v. Gray*, 1931 C.D. 9 (Bd. App. 1929). If the first foreign application was filed in a country which is not recognized with respect to the right of priority, it is disregarded for this purpose. 35 U.S.C. 119(c) extends the right of priority to “subsequent” foreign applications if one earlier filed had been withdrawn, abandoned, or otherwise disposed of, under certain conditions.

The United Kingdom and a few other countries have a system of “post-dating” whereby the filing date of an application is changed to a later date. This “post-dating” of the filing date of the application does not affect the status of the application with respect to the right of priority; if the original filing date is more than one year prior to the U.S. filing no right of priority can be based upon the application. See *In re Clamp*, 151 USPQ 423 (Comm’r Pat. 1966).

If an applicant has filed two foreign applications in recognized countries, one outside the year and one within the year, and the later application discloses additional subject matter, a claim in the U.S. application specifically limited to the additional disclosure would be entitled to the date of the second foreign application since this would be the first foreign application for that subject matter.<sup>26</sup>

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<sup>26</sup> MPEP § 213.03, Time for Filing U.S. Nonprovisional Application [R-07.2015], § II, *First Foreign Application*.

## XII. SECOND APPLICATION HAVING A DIFFERENT SCOPE

It is interesting to note the view of the highest body within the European Patent Office when faced with a similar issue: In *Priority Interval*, [1994] E.P.O.R. 521 (EPO Enlarged Board of Appeal 1994), the highest body within the European Patent Office answered “no” to the question: “Does a document published during the priority interval and whose technical contents correspond to that of the priority document constitute prior art citable under Article 54(2) against a European patent application where the claim to priority is not valid because said application comprises subject-matter not disclosed in the priority document?”<sup>27</sup>

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<sup>27</sup> The reasoning is explained thusly, *Priority Interval*, [1994] E.P.O.R. at 525-26:

“Pursuant to Article 87 EPC, the coming into existence of a right of priority depends on the fulfilment of certain requirements, one of these being that the European patent application claiming the right of priority from an earlier application in a state party to the Paris Convention must be ‘in respect of the same invention’ disclosed in the said earlier application. Article 89 deals with the effect of possessing a right to priority on the premise that the conditions precedent to having that right have been satisfied, including the requirement that the inventions be the same. If these preconditions are not met, no right to priority exists; consequently in such case a claim to priority from a previous application has no effect, either under Article 87 EPC or under the Paris Convention.

“Where priority is claimed but cannot be allowed because the essential condition precedent, that the inventions are the same, is not met, there is no right to priority. In consequence, any publication of the contents of the priority document in the interval between the filing thereof as a patent application and the filing of the European application claiming priority therefrom, constitutes prior art citable against elements of the European application which are not entitled to priority. The United States Court of Appeals for the Federal Circuit decided likewise (*In re Gosteli*, 10 USPQ 2d 1614 (1989); GRUR Int. 1990, p. 994).”

### XIII. EMERGENCY EXTENSION FOR PARIS CONVENTION FILINGS

Where the failure to file an application within the 12 month period of the Paris Convention is *unintentional* and under the circumstances provided in the *Manual*, the period for filing the Paris Convention application may be extended up to 14 months from the priority date.<sup>28</sup>

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<sup>28</sup> MPEP § 213.03, *Time for Filing U.S. Nonprovisional Application* [R-07.2015], § III, *Restoring the Right of Priority*, provides that:

“Effective December 18, 2013, title II of the Patent Law Treaties Implementation Act (PLTIA) provides for restoration of the right of priority under 35 U.S.C. 119(a) through (d) and (f), 172, and 365(a) or (b). As provided in 37 CFR 1.55(c), if the subsequent application has a filing date which is after the expiration of the twelve-month period (or six-month period in the case of a design application), but within two months from the expiration of the period, the right of priority in the subsequent application may be restored under PCT Rule 26bis.3 for an international application, or upon petition under 37 CFR 1.55(c), if the delay in filing the subsequent application within the period was unintentional. Thus, an application may now validly claim priority under 35 U.S.C. 119(a) through (d) and (f), 172, 365(a) or (b), or 386(a) or (b) to a foreign application filed up to fourteen months earlier (or eight months earlier in the case of a design application). As a result of title I of the PLTIA, 37 CFR 1.55(c) was amended effective May 13, 2015, to provide that restoration of the right of priority is available for priority claims under 35 U.S.C. 386(a) or (b). In addition, 37 CFR 1.55(c) was amended to provide that a petition to restore the right of priority filed on or after May 13, 2015, must be filed in the subsequent application, or in the earliest nonprovisional application claiming benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the subsequent application, if such subsequent application is not a nonprovisional application.

“A petition under 37 CFR 1.55(c) requires:

“(A) the priority claim under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b), or 386(a) or (b) in an application data sheet, identifying the foreign application to which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing (unless previously submitted in an application data sheet);

“(B) the petition fee as set forth in 37 CFR 1.17(m); and

“(C) a statement that the delay in filing the subsequent application within the twelve-month period (or six-month period in the case of a design application) set forth in 37 CFR 1.55(b) was unintentional.

#### **XIV. RUSCETTA TRAP OF A MODIFIED GENREIC DEFINITION<sup>r</sup>**

The “Ruscetta trap” is reference to the still all too common failing where a Paris Convention application is filed with a genus of a different scope than supported in the priority document, and, particularly, where the original generic scope of the parent application is not maintained in the text of the new application (making it impossible to reinsert the original scope into the application.)

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“The Director may require additional information where there is a question whether the delay was unintentional.

“Where the subsequent application is not a nonprovisional application, the Office may not have an application file established for the subsequent application. This would occur, for example, where an international application designating the United States was filed in a foreign Receiving Office and the applicant filed a continuation of an international application under 35 U.S.C. 111(a) rather than entering the national stage under 35 U.S.C. 371. Thus, in this situation, the petition under 37 CFR 1.55(c) may be filed in the earliest nonprovisional application claiming benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) to the subsequent application. However, the statement required under 37 CFR 1.55(c)(3) must still relate to the unintentional delay in filing the subsequent application, i.e., the international application.

“If a petition under 37 CFR 1.55(c) to restore the right of priority is granted, a further petition under 37 CFR 1.55(c) is not required in an application entitled to claim the benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) of the subsequent application for which the right of priority was restored.

“It should be noted that although an application may now validly claim priority under 35 U.S.C. 119(a) through (d) and (f), 172, 365(a) or (b), or 386(a) or (b) to a foreign application filed up to fourteen months earlier (or eight months earlier in the case of a design application) in view of the restoration provision of 37 CFR 1.55(c), an application subject to examination under pre-AIA first to invent laws (rather than the first inventor to file provisions of the AIA) would still be subject to the 12-month statutory time periods in pre-AIA 35 U.S.C. 102(b) and (d) which are measured from the U.S. filing date. Thus, the application may still be subject to a rejection under pre-AIA 35 U.S.C. 102(b) or (d) despite the priority claim. See MPEP §§ 2133 and 2135 et seq.”

It has long been well established that a generic claim may not be entitled to priority based upon an earlier application where the genus in the later application does not find “written description” support in the earlier application. This is particularly important in the case of a strategy of sequential filings where the earliest application has sparse (if any) generic disclosure and then a later application *does* have a generic claim and disclosure:

Under cases that include *Steenbock* and *Ruscetta*, there is a two-fold inquiry. *In re Steenbock*, 83 F.2d 912 (CCPA 1936); *In re Ruscetta*, 255 F.2d 687 (CCPA 1958) (Rich, J.). *First*, for a claim to a generic invention in a daughter application, does the parent application provide a “written description” basis for that genus? Phrased differently, if an amendment had been made to add the later generic invention, would that amended generic definition find basis for support in the original parent application?

If the answer to the question of support is “no”, there is no written description of the generic claim in the parent, then the daughter application that claims priority to the earlier application would *not* be entitled to priority based upon the parent application, and hence would stand naked as of the later filing date.

Given that the *Leahy Smith America Invents Act* broadens the scope of prior art, there is a greater likelihood that there will be intervening prior art either by the applicant or a third party. To be sure, a large percentage of the case law prior to the *Leahy Smith America Invents Act* involved factual situations such as in *Steenbock* and *Ruscetta*.

In simplified form, the first *Ruscetta* and Jenny filing claimed a method of etching a metal species—tantalum – while the application at the Court claimed a method of etching the same species—tantalum—or a related metal (zirconium, niobium or titanium). Intervening prior art was the *Ruscetta* and Jenny publication essentially *identical* to the parent: It was the British counterpart published application to the method with tantalum. There clearly was *priority* for the tantalum species. But, priority was not the issue in *Ruscetta*: Rather, the issue was whether *Ruscetta* and Jenny were entitled to rely on the parent filing date under what is today 35 U.S.C.A. § 112(a). They clearly were not.



Therefore, the *Ruscetta and Jenny* claims at the court stood naked as of their later filing date; hence, their claims were barred by their own disclosure of the tantalum species in the British counterpart application. *Ruscetta* broke no new legal ground but essentially reprised the *Steenbock* case. As explained by Judge Rich in *Ruscetta*:

“The application [in *In re Steenbock*, 83 F.2d 912 (1936),] disclosed and claimed the irradiation of fungus material broadly. It was filed [in 1932] as a continuation-in-part of an application filed [in] 1926, which did not disclose the broad genus ‘fungus material,’ but only a specific fungus, yeast. [As to *Steenbock*'s British counterpart specification published in 1926,] *Steenbock* was allowed his specific yeast claims, supported by his parent application, because there was no [ ] statutory bar against them .... But as to the broad fungus material claims, [the intervening British specification and other prior art] were held to be statutory bars ... [B]ecause of the lack of supporting disclosure for broad fungus claims in the parent applications, *Steenbock* had to rely on his 1932 filing date and therefore the references were ... statutory bars as to it [because they were] ‘published more than two years prior to the filing of the involved application[.]’ [In *re Ruscetta*, 255 F.2d 687 (CCPA 1958) (quoting Board decision in *In re Steenbock*, 83 F.2d 912 (CCPA 1936); see also *In re Ellis*, 37 App. D.C. 203, 1911 WL 20026 (App. D.C. 1911); *In re Dosselman*, 37 App. D.C. 211, 1911 WL 20064 (App. D.C. 1911); *In re Langmuir*, 62 F.2d 93 (CCPA 1932); *In re Walker*, 70 F.2d 1008 (CCPA 1934), *In re Burk*, 74 F.2d 547 (CCPA 1935); *In re Lukach*, 442 F.2d 967 (CCPA 1971); *In re Smith*, 458 F.2d 1389 (CCPA 1972).]”

*Steenbock* in turn cites to case law that is now more than 100 years old for the proposition that “[t]he principle is well established ... that the disclosure of a species in a cited reference is sufficient to prevent a later applicant from obtaining generic claims, although the disclosure in an application of a species may not be a sufficient basis for a generic claim.” *In re Steenbock*, 83 F.2d 912 (CCPA (1936) (citing *In re Ellis*, 37 App. D.C. 203, 1911 WL 20026 (App. D.C. 1911); *In re Dosselman*, 37 App. D.C. 211, 1911 WL 20064 (App. D.C. 1911); *In re Langmuir*, 62 F.2d 93 (CCPA 1932); *In re Walker*, 70 F.2d 1008 (CCPA 1934), *In re Burk*, 74 F.2d 547 (CCPA 1935)).

In *In re Herschler*, 591 F.2d 693 (CCPA 1979), a parent application (the “great-grandfather” case) disclosed various species (gluco-corticosteroids) whereas the instant claims on appeal are much broader, some directed to steroids, generally, or

to a group of steroids broader than the gluco-corticosteroids of the great-grandfather case. Intervening prior art was held to bar the broader claims because the narrow disclosure in the earlier case did not provide basis for the generic claim in the later case: “[T]he great-grandparent case ... disclosure is limited to gluco-corticosteroids whereas all of the present claims on appeal are drawn either to steroids in general or to steroids not limited to glucocorticosteroids[ ]. It is now well settled law that disclosure of a species is insufficient to provide descriptive support for a generic or sub-generic claim.” *Herschler*, 591 F.2d at 696 (citing *In re Ruscetta*, 255 F.2d 687 (CCPA 1958); *In re Lukach*, 442 F.2d 967 (1971); *In re Smith*, 458 F.2d 1389 (1972)).

Therefore, “appellant may not rely upon his great-grandparent case to support any of the claims on appeal and thus the [intervening] prior art ... can be properly applied against the claims under 35 U.S.C.A. 102(b) and 103.” *Herschler*, 591 F.2d at 697.

Whether a new generic or subgeneric definition of an invention is entitled to priority is a very case-specific determination, as shown in a footnote citing a variety of cases in *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1568–69 n.6 (Fed. Cir. 1991) (Rich, J.) (“*Chester v. Miller*, 906 F.2d 1574 (Fed.Cir.1990) (parent application's disclosure of chemical species constituted 102(b) prior art against continuation-in-part (c-i-p) application on appeal, but did not provide sufficient written description to support c-i-p's claims to encompassing genus); *In re Gosteli*, 872 F.2d 1008 (Fed.Cir.1989) (foreign priority application's disclosure of chemical subgenus was insufficient written description to support genus claims of corresponding U.S. application); *In re Wright*, 866 F.2d 422 (Fed.Cir.1989) (application in ‘clear compliance’ with Sec. 112 ‘written description’ requirement with respect to claim limitation that microcapsules were ‘not permanently fixed’); *Utter v. Hiraga*, 845 F.2d 993, 998 (Fed.Cir.1988) (holding generic interference count to scroll compressor supported by written description of foreign priority application, the court stated, ‘A specification may, within the meaning of 35 U.S.C. Sec. 112 ¶ 1, contain a written description of a broadly claimed invention without describing all species that claim encompasses’); *Kennecott Corp. v. Kyocera Int'l, Inc.*, 835 F.2d 1419 (Fed.Cir.1987) (parent application's lack of express disclosure of inherent ‘equiaxed microstructure’ property did not deprive c-i-p's claims to a sintered ceramic body having said property of the benefit of parent's filing date); *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570 (Fed. Cir. 1985) (parent application's disclosure provided adequate written description support for certain claim limitations respecting protein content, temperature, and

moisture content, but not others); *In re Wilder*, 736 F.2d 1516 (Fed. Cir. 1984) (broadly worded title, general description of drawing, and objects of invention of parent patent application did not adequately support reissue application claims directed to genus of indicating mechanisms for dictating machines); *In re Kaslow*, 707 F.2d 1366 (Fed.Cir.1983) (claims to method of redeeming merchandise coupons, comprising step of providing an audit of coupon traffic, were not supported by specification of parent application).”<sup>29</sup>

## XV. CONVENTION INTERVAL PUBLICATION AS PRIOR ART

It is well settled that a generic claim covering a broad range of species where the priority document discloses a narrower scope of species is not entitled to priority based upon the narrower disclosure in the priority document, yet, the inventor’s publication corresponding to the narrower scope of the priority document may be prior art to defeat the generic claim, assuming that the publication date of the narrower scope disclosure (stripped of any priority right) is sufficiently early to constitute prior art against the later filing.<sup>30</sup>

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<sup>29</sup> Wegner, *FIRST TO FILE PATENT DRAFTING*, § 11:24, *Priority to Genus of Different Scope* (Thomson Reuters 2017).(footnote integrated into text in brackets).

<sup>30</sup> See Wegner, *FIRST TO FILE PATENT DRAFTING*, § 11:24, *Priority to Genus of Different Scope* (Thomson Reuters 2017):

“Under *In re Steenbock*, 83 F.2d 912 (CCPA 1936), and *In re Ruscetta*, 255 F.2d 687 (CCPA 1958)], there is a two-fold inquiry[:]

*First*, for a claim to a generic invention in a daughter application, does the parent application provide a “written description” basis for that genus? Phrased differently, if an amendment had been made to add the later generic invention, would that amended generic definition find basis for support in the original parent application?

“If the answer to the question of support is ‘no’, there is no written description of the generic claim in the parent, then the daughter application that claims priority to the earlier application

It is interesting to note the view of the highest body within the European Patent Office when faced with the issue whether an inventor's publication *during* the convention year is patent-defeating where an earlier corresponding text is not basis for priority. Thus, in *Priority Interval*, 1994 E.P.O.R. 521 (EPO Enlarged Board of Appeal 1994), the highest body within the European Patent Office answered "no" to the question: "Does a document published during the priority interval and whose technical contents correspond to that of the priority document constitute prior art citable under Article 54(2) against a European patent application where the claim to priority is not valid because said application comprises subject-matter not disclosed in the priority document?"<sup>31</sup>

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would *not* be entitled to priority based upon the parent application, and hence would stand naked as of the later filing date."

<sup>31</sup> The reasoning is explained thusly, *Priority Interval*, [1994] E.P.O.R. at 525-26:

"Pursuant to Article 87 EPC, the coming into existence of a right of priority depends on the fulfilment of certain requirements, one of these being that the European patent application claiming the right of priority from an earlier application in a state party to the Paris Convention must be 'in respect of the same invention' disclosed in the said earlier application. Article 89 deals with the effect of possessing a right to priority on the premise that the conditions precedent to having that right have been satisfied, including the requirement that the inventions be the same. If these preconditions are not met, no right to priority exists; consequently in such case a claim to priority from a previous application has no effect, either under Article 87 EPC or under the Paris Convention.

"Where priority is claimed but cannot be allowed because the essential condition precedent, that the inventions are the same, is not met, there is no right to priority. In consequence, any publication of the contents of the priority document in the interval between the filing thereof as a patent application and the filing of the European application claiming priority therefrom, constitutes prior art citable against elements of the European application which are not entitled to priority. The United States Court of Appeals for the Federal Circuit decided likewise (*In re Gosteli*, 10 USPQ 2d 1614 (1989); GRUR Int. 1990, p. 994)."

## XVI. COMMON ASSIGNMENT AS OF THE PRIORITY DATE

As held in an opinion by Circuit Judge Mayer in *Boston Scientific Scimed*, “a foreign application may *only* form the basis for [foreign] priority under section 119(a) if that application was filed by either the U.S. applicant himself, or by someone acting on his behalf *at the time the foreign application was filed.*”<sup>32</sup>

This holding is explained in more detail by Circuit Judge Mayer:

At issue here is whether 35 U.S.C. § 119(a) permits an applicant for a United States patent to benefit from the priority of a foreign application previously filed by an entity that was not acting on behalf of the U.S. applicant at the time of filing. We hold that it does not.

A similar issue was addressed by the Court of Customs and Patent Appeals in *Vogel v. Jones*, 486 F.2d 1068 (CCPA 1973), which, to the extent relevant here, is binding upon us, *South Corp. v. United States*, 690 F.2d 1368, 1370 (Fed.Cir.1982) (en banc). According to *Vogel*, “§ 119 gives rise to a right of priority that is personal to the United States applicant.” 486 F.2d at 1072. Due to the personal nature of this right, an applicant for a U.S. patent may only benefit from the priority of a foreign application if it was filed by the U.S. applicant or “on his behalf.” *Id.*

Scimed argues that *Vogel* does not require the foreign applicant to have been acting on behalf of the U.S. applicant *at the time the foreign application was filed*. It points to the following passage in support:

“This practice [of allowing a U.S. applicant to claim priority from a foreign application filed by someone else] arose because it was recognized that in many foreign countries, unlike in the United States, the actual applicant for a patent can be other than the inventor, e.g., an assignee. In light of this, we regard the language in § 119 referring to legal representatives and assigns to merely represent a

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<sup>32</sup> *Boston Scientific Scimed, Inc. v. Medtronic Vascular, Inc.*, 497 F.3d 1293, 1297-98 (Fed. Cir. 2007)(original emphasis by the Court).

codification of the actual practice under [the predecessor statute to § 119]. Since under United States law an application for patent must be made by the inventor, that practice was based on the requirement that the foreign application, regardless of the identity of the applicant, must have been filed for an invention actually made by the inventive entity seeking to rely upon it for priority purposes. We think § 119 must be construed to the same end.”

*Id.* (footnote omitted). Scimed attempts to construe this language as permitting a U.S. applicant to benefit from a foreign application's earlier filing date whenever “the invention described in the foreign application [is the same] one actually made by the U.S. applicant,” “ ‘regardless of the identity of the applicant’ of the foreign application.” According to its interpretation, “the *Vogel* court did *not* hold that the foreign application must have been filed by a person who was an assignee or legal representative of the U.S. inventor *at the time the foreign application was filed*, or that the foreign application must have been filed on his behalf in order for there to be priority benefit.” We disagree.

*Vogel* clearly held that the above-quoted passage “means that an applicant for a United States patent can rely for priority on the ‘first filed’ application by an assignee *on his behalf*.” *Id.* (emphasis added). Moreover, “the existence of an application made by [the inventor's] assignee in a foreign country on behalf of one other than the United States inventor is irrelevant to his right of priority based on applications made on his behalf.” *Id.* In other words, while the foreign application must obviously be for the same invention and may be filed by someone other than the inventor, section 119(a) also requires that a nexus exist between the inventor and the foreign applicant at the time the foreign application was filed. Indeed, as a matter of pure logic, an entity could not have filed a foreign application “on behalf of” an inventor without the inventor's knowledge or consent; that the foreign application may have been filed in accordance with the laws of the country in which it was filed has no bearing here. Therefore, to the extent that there may have been any uncertainty or ambiguity in *Vogel*, we now explicitly hold that a foreign application may *only* form the basis for priority under section 119(a) if that application was filed by either the U.S. applicant himself, or by someone acting on his behalf *at the time the foreign application was filed*.

## XVII. VALUE OF A PROVISIONAL PRIORITY APPLICATION

There are various procedural benefits to filing a provisional patent application for priority purposes (which are outside the scope of this priority paper); but, there is no *substantive* benefit to a filing of a provisional application versus any other priority application.<sup>33</sup>

The statutory basis for priority has identical substantive requirements whether the priority application is provisional or otherwise.<sup>34</sup>

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<sup>33</sup> Wegner, *FIRST TO FILE PATENT DRAFTING: A PRACTITIONER'S GUIDE*, § 8:19, *Discrete but Limited Value of a Provisional Application* (Thomson Reuters 2017)(“Filing a provisional application as a first filing provides no *substantive* benefit to a patent applicant seeking priority under the Paris Convention. There is no *substantive* value to a *provisional* application filing as a way to defer providing proper claims and supporting disclosure to avoid [a § 112] basis to deny patentability. In terms of gaining an *offensive* generic claim to cover “downstream” innovations, there is no substantive benefit.”).

<sup>34</sup> Wegner, *FIRST TO FILE PATENT DRAFTING: A PRACTITIONER'S GUIDE*, § 5:9, *Identical Substantive Standard for All Varieties of Parent Filings* (Thomson Reuters 2017)(discussing denial of priority in such situations, citing *In re Gosteli*, 872 F.2d 1008 (Fed. Cir. 1989)(Paris Convention priority); *In re Ziegler*, 992 F.2d 1197 (Fed. Cir. 1993)(*id.*); *Kawai v. Metlesics*, 480 F.2d 880, 885-89 (CCPA 1973)(*id.*); *Anderson v. Natta*, 480 F.2d 1392, 1399 (CCPA 1973)(*id.*); *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290 (Fed. Cir. 2002)(Michel, J.)(priority based on provisional application)).

## XVIII. CONCLUSION

*Prospective* understanding the ground rules for Paris Convention priority is necessary if one is to avoid one of the many pitfalls that remain as traps for the unwary, pitfalls that in some situations cannot be retroactively cured.

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## APPENDIX: PTO RULE FOR CLAIMING FOREIGN PRIORITY

### 37 CFR § 1.55 Claim for foreign priority.

(a) ***In general.*** An applicant in a nonprovisional application may claim priority to one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a) through (d) and (f) , 172 , 365(a) and (b) , and 386(a) and (b) and this section.

(b) ***Time for filing subsequent application.*** The nonprovisional application must be:

(1) Filed not later than twelve months (six months in the case of a design application) after the date on which the foreign application was filed, subject to paragraph (c) of this section (a subsequent application); or

(2) Entitled to claim the benefit under 35 U.S.C. 120 , 121 , 365(c) , or 386(c) of a subsequent application that was filed within the period set forth in paragraph (b)(1) of this section.

(c) ***Delayed filing of subsequent application.*** If the subsequent application has a filing date which is after the expiration of the period set forth in paragraph (b)(1) of this section, but within two months from the expiration of the period set forth in paragraph (b)(1) of this section, the right of priority in the subsequent application may be restored under PCT Rule 26bis.3 for an international application, or upon petition pursuant to this paragraph, if the delay in filing the subsequent application within the period set forth in paragraph (b)(1) of this section was unintentional. A petition to restore the right of priority under this paragraph filed on or after May 13, 2015, must be filed in the subsequent application, or in the earliest nonprovisional application claiming benefit under 35 U.S.C. 120 , 121 , 365(c) , or 386(c) to the subsequent application, if such subsequent application is not a nonprovisional application. Any petition to restore the right of priority under this paragraph must include:

(1) The priority claim under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b) , or 386(a) or (b) in an application data sheet (§ 1.76(b)(6) ), identifying the foreign application to which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, unless previously submitted;

(2) The petition fee as set forth in § 1.17(m); and

(3) A statement that the delay in filing the subsequent application within the period set forth in paragraph (b)(1) of this section was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

**(d) *Time for filing priority claim*—**

**(1) *Application under 35 U.S.C. 111(a)*** . The claim for priority must be filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application in an original application filed under 35 U.S.C. 111(a) , except as provided in paragraph (e) of this section. The claim for priority must be presented in an application data sheet (§ 1.76(b)(6) ) and must identify the foreign application to which priority is claimed by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. The time periods in this paragraph do not apply if the later-filed application is:

- (i) An application for a design patent; or
- (ii) An application filed under 35 U.S.C. 111(a) before November 29, 2000.

**(2) *Application under 35 U.S.C. 371*** . The claim for priority must be made within the time limit set forth in the PCT and the Regulations under the PCT in an international application entering the national stage under 35 U.S.C. 371 , except as provided in paragraph (e) of this section.

**(e) *Delayed priority claim***. Unless such claim is accepted in accordance with the provisions of this paragraph, any claim for priority under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b) , or 386(a) or (b) not presented in the manner required by paragraph (d) or (m) of this section during pendency and within the time period provided by paragraph (d) of this section (if applicable) is considered to have been waived. If a claim for priority is considered to have been waived under this section, the claim may be accepted if the priority claim was unintentionally delayed. A petition to accept a delayed claim for priority under 35 U.S.C. 119(a) through (d) or (f), 365(a) or (b) , or 386(a) or (b) must be accompanied by:

(1) The priority claim under 35 U.S.C. 119(a) through (d) or (f) , 365(a) or (b) , or 386(a) or (b) in an application data sheet (§ 1.76(b)(6) ), identifying the foreign application to which priority is claimed, by specifying the application number,

country (or intellectual property authority), day, month, and year of its filing, unless previously submitted;

(2) A certified copy of the foreign application, unless previously submitted or an exception in paragraph (h), (i), or (j) of this section applies;

(3) The petition fee as set forth in § 1.17(m) ; and

(4) A statement that the entire delay between the date the priority claim was due under this section and the date the priority claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

**(f) *Time for filing certified copy of foreign application***—

**(1) *Application under 35 U.S.C. 111(a)*** . A certified copy of the foreign application must be filed within the later of four months from the actual filing date of the application, or sixteen months from the filing date of the prior foreign application, in an original application under 35 U.S.C. 111(a) filed on or after March 16, 2013, except as provided in paragraphs (h), (i), and (j) of this section. The time period in this paragraph does not apply in a design application.

**(2) *Application under 35 U.S.C. 371*** . A certified copy of the foreign application must be filed within the time limit set forth in the PCT and the Regulations under the PCT in an international application entering the national stage under 35 U.S.C. 371 . If a certified copy of the foreign application is not filed during the international stage in an international application in which the national stage commenced on or after December 18, 2013, a certified copy of the foreign application must be filed within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or sixteen months from the filing date of the prior foreign application, except as provided in paragraphs (h), (i), and (j) of this section.

(3) If a certified copy of the foreign application is not filed within the time period specified [in] paragraph (f)(1) of this section in an application under 35 U.S.C. 111(a) or within the period specified in paragraph (f)(2) of this section in an international application entering the national stage under 35 U.S.C. 371 , and an exception in paragraph (h), (i), or (j) of this section is not applicable, the certified copy of the foreign application must be accompanied by a petition including a

showing of good and sufficient cause for the delay and the petition fee set forth in § 1.17(g).

**(g) Requirement for filing priority claim, certified copy of foreign application, and translation in any application.**

(1) The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) or PCT Rule 17 must, in any event, be filed within the pendency of the application, unless filed with a petition under paragraph (e) or (f) of this section, or with a petition accompanied by the fee set forth in § 1.17(g) which includes a showing of good and sufficient cause for the delay in filing the certified copy of the foreign application in a design application. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and § 1.323.

(2) The Office may require that the claim for priority and the certified copy of the foreign application be filed earlier than otherwise provided in this section:

(i) When the application is involved in an interference (see § 41.202 of this chapter) or derivation (see part 42 of this chapter) proceeding;

(ii) When necessary to overcome the date of a reference relied upon by the examiner; or

(iii) When deemed necessary by the examiner.

(3) An English language translation of a non-English language foreign application is not required except:

(i) When the application is involved in an interference (see § 41.202 of this chapter) or derivation (see part 42 of this chapter) proceeding;

(ii) When necessary to overcome the date of a reference relied upon by the examiner; or

(iii) When specifically required by the examiner.

(4) If an English language translation of a non-English language foreign application is required, it must be filed together with a statement that the translation of the certified copy is accurate.

**(h) *Certified copy in another U.S. patent or application.*** The requirement in paragraphs (f) and (g) of this section for a certified copy of the foreign application will be considered satisfied in a reissue application if the patent for which reissue is sought satisfies the requirement of this section for a certified copy of the foreign application and such patent is identified as containing a certified copy of the foreign application. The requirement in paragraphs (f) and (g) of this section for a certified copy of the foreign application will also be considered satisfied in an application if a prior-filed nonprovisional application for which a benefit is claimed under 35 U.S.C. 120 , 121 , 365(c) , or 386(c) contains a certified copy of the foreign application and such prior-filed nonprovisional application is identified as containing a certified copy of the foreign application.

**(i) *Foreign intellectual property office participating in a priority document exchange agreement.*** The requirement in paragraphs (f) and (g) of this section for a certified copy of the foreign application to be filed within the time limit set forth therein will be considered satisfied if:

(1) The foreign application was filed in a foreign intellectual property office participating with the Office in a bilateral or multilateral priority document exchange agreement (participating foreign intellectual property office), or a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy;

(2) The claim for priority is presented in an application data sheet (§ 1.76(b)(6) ), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and the applicant provides the information necessary for the participating foreign intellectual property office to provide the Office with access to the foreign application;

(3) The copy of the foreign application is received by the Office from the participating foreign intellectual property office, or a certified copy of the foreign application is filed, within the period specified in paragraph (g)(1) of this section; and

(4) The applicant files in a separate document a request that the Office obtain a copy of the foreign application from a participating intellectual property office that permits the Office to obtain such a copy where, although the foreign application was not filed in a participating foreign intellectual property office, a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office that permits the Office to obtain such a copy. The request must identify the participating intellectual property office and the subsequent application by the application number, day, month, and year of its filing in which a copy of the foreign application was filed. The request must be filed within the later of sixteen months from the filing date of the prior foreign application, four months from the actual filing date of an application under 35 U.S.C. 111(a), four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), or four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or the request must be accompanied by a petition under paragraph (e) or (f) of this section.

**(j) *Interim copy.*** The requirement in paragraph (f) of this section for a certified copy of the foreign application to be filed within the time limit set forth therein will be considered satisfied if:

(1) A copy of the original foreign application clearly labeled as "Interim Copy," including the specification, and any drawings or claims upon which it is based, is filed in the Office together with a separate cover sheet identifying the foreign application by specifying the application number, country (or intellectual property authority), day, month, and year of its filing, and stating that the copy filed in the Office is a true copy of the original application as filed in the foreign country (or intellectual property authority);

(2) The copy of the foreign application and separate cover sheet are filed within the later of sixteen months from the filing date of the prior foreign application, four months from the actual filing date of an application under 35 U.S.C. 111(a), four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) (§ 1.491(a)), four months from the date of the initial submission under 35 U.S.C. 371 to enter the national stage, or with a petition under paragraph (e) or (f) of this section; and

(3) A certified copy of the foreign application is filed within the period specified in paragraph (g)(1) of this section.

**(k) Requirements for certain applications filed on or after March 16, 2013.** If a nonprovisional application filed on or after March 16, 2013, other than a nonprovisional international design application, claims priority to a foreign application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date as defined in § 1.109 that is on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the nonprovisional application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior foreign application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the nonprovisional application. An applicant is not required to provide such a statement if the applicant reasonably believes on the basis of information already known to the individuals designated in § 1.56(c) that the nonprovisional application does not, and did not at any time, contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

**(l) Inventor's certificates.** An applicant in a nonprovisional application may under certain circumstances claim priority on the basis of one or more applications for an inventor's certificate in a country granting both inventor's certificates and patents. To claim the right of priority on the basis of an application for an inventor's certificate in such a country under 35 U.S.C. 119(d), the applicant, when submitting a claim for such right as specified in this section, must include an affidavit or declaration. The affidavit or declaration must include a specific statement that, upon an investigation, he or she is satisfied that to the best of his or her knowledge, the applicant, when filing the application for the inventor's certificate, had the option to file an application for either a patent or an inventor's certificate as to the subject matter of the identified claim or claims forming the basis for the claim of priority.

**(m) Time for filing priority claim and certified copy of foreign application in an international design application designating the United States.** In an international design application designating the United States, the claim for priority may be made in accordance with the Hague Agreement and the Hague Agreement Regulations. In a nonprovisional international design application, the priority claim, unless made in accordance with the Hague Agreement and the Hague Agreement Regulations, must be presented in an application data sheet (§ 1.76(b)(6)), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. In a nonprovisional international design application,

the priority claim and certified copy must be furnished in accordance with the time period and other conditions set forth in paragraph (g) of this section.

**(n) *Applications filed before September 16, 2012.*** Notwithstanding the requirement in paragraphs (d)(1), (e)(1), and (i)(2) of this section that any priority claim be presented in an application data sheet (§ 1.76), this requirement in paragraphs (d)(1), (e)(1), and (i)(2) of this section will be satisfied by the presentation of such priority claim in the oath or declaration under § 1.63 in a nonprovisional application filed under 35 U.S.C. 111(a) before September 16, 2012, or resulting from an international application filed under 35 U.S.C. 363 before September 16, 2012. The provisions of this paragraph do not apply to any priority claim submitted for a petition under paragraph (c) of this section to restore the right of priority to a foreign application.

**(o) *Priority under 35 U.S.C. 386(a) or (b).*** The right of priority under 35 U.S.C. 386(a) or (b) with respect to an international design application is applicable only to nonprovisional applications, international applications, and international design applications filed on or after May 13, 2015, and patents issuing thereon.

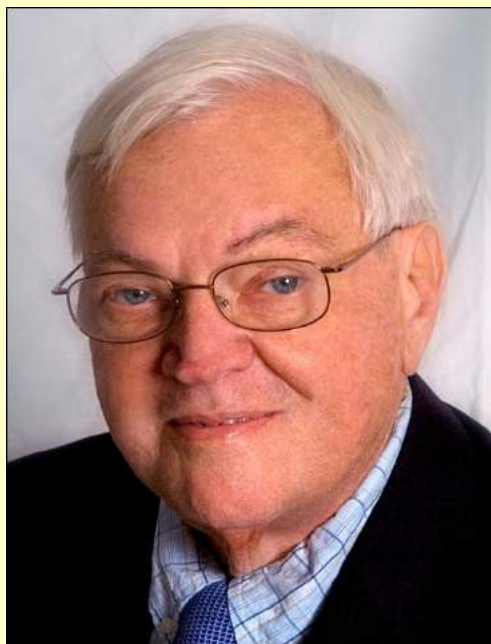
**(p) *Time periods in this section.*** The time periods set forth in this section are not extendable, but are subject to 35 U.S.C. 21(b) (and § 1.7(a)), PCT Rule 80.5, and Hague Agreement Rule 4(4).

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## About the Author



Prof. Wegner's practice includes expert opinions; he develops strategies on complex claim drafting and prosecution matters at the Examiner level and at the Board; and he has been involved with appeals at the Federal Circuit.

Professor Wegner's professional roots are in chemical patents, and particularly pharmaceuticals. After receiving a degree in chemistry from Northwestern University he spent four years as a Patent Examiner focused on claims to new compounds, and thereafter spent many years in private practice where his principal specialty was in pharmaceuticals.

Prof. Wegner has recently published the treatise:

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<http://legalsolutions.thomsonreuters.com/law-products/Treatises/First-To-File-Patent-Drafting-2017-ed/p/104366885>.

The work is also available electronically on Westlaw.

Prof. Wegner is President Emeritus of The Naples Roundtable, Inc., a 501(c)3 nonprofit corporation dedicated to "finding ways to strengthen and improve the patent system." [thenaplesroundtable.org/](http://thenaplesroundtable.org/)

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