

# PARIS CONVENTION PRIORITY PITFALLS 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 42.

**DETAILED TABLE OF CONTENTS**

I. OVERVIEW	3
II. THE STATUTORY SCHEME	8
III. REPLACING A FIRST FILING TO CLEAN UP THE TEXT	10
IV. THE LAW PRIOR TO THE 2011 STATUTORY CHANGE	14
V. CHANGED CIRCUMSTANCES OF THE NEW PATENT LAW	15
VI. STRICT STATUTORY AND TREATY LIMITATIONS	16
VII. DISCLOSED (UNCLAIMED) INVENTION IN FIRST FILING	19
VIII. EARLIER FILING BY A DIFFERENT INVENTIVE ENTITY	23
IX. OLD LAW DEFERRAL OF CONVENTION EXPIRATION	31
X. “GHOST” FIRST FILING MAY DESTROY CONVENTION PRIORITY	37
XI. SECOND APPLICATION DISCLOSING NEW MATTER	39
XII. EMERGENCY EXTENSION FOR PARIS CONVENTION FILINGS	40
XIII. CONCLUSION	41
ABOUT THE AUTHOR	42

## 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).

But, special conditions of the Paris Convention, Art. 4C(4), *Conditions for Priority to Second Application*, 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restarting the priority year unless *as of the date of the second filing* “[a] the [first] application [must have] been withdrawn [or] abandoned \* \* \* [; (b)] without having been laid open to public inspection and [(c)] without leaving any rights outstanding, and [(d) where] it has not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 § X, 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>

DISCUSSION DRAFT

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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>

OCTOBER 12, 2017

DISCUSSION DRAFT

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

#### 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.

## 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>7</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>7</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>8</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>9</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>8</sup> Art. 4C(4), *Conditions for Priority to Second Application*.

<sup>9</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.”

Wegner, *Paris Convention Priority Pitfalls*

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.”

OCTOBER 12, 2017

DISCUSSION DRAFT

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

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 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<sub>2</sub> 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<sub>2</sub> 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<sub>2</sub>OH 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

According to *Olson v. Julia*, 209 USPQ 159, 1979 WL 25148 (PTO Bd.Pat.Inter. 1979), 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.

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>

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

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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 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*.”



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.

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).

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>10</sup>

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<sup>10</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>11</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>12</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>11</sup> Paris Convention Art. 4C(4), *Conditions for Priority to Second Application*.

<sup>12</sup> Art. 4C(4), *Conditions for Priority to Second Application*.



without leaving any rights outstanding.”<sup>13</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>14</sup>

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<sup>13</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>14</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>15</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>16</sup>

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<sup>15</sup> Bodenhausen, *supra*, note b.

<sup>16</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>17</sup>

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<sup>17</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>18</sup>

OCTOBER 12, 2017

DISCUSSION DRAFT

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<sup>18</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>19</sup>

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<sup>19</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 \*\*\*

Wegner, *Paris Convention Priority Pitfalls*

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.

OCTOBER 12, 2017

DISCUSSION DRAFT

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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>20</sup>

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<sup>20</sup> MPEP § 213.03, Time for Filing U.S. Nonprovisional Application [R-07.2015], § II, *First Foreign Application*.

## XII. 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>21</sup>

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<sup>21</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



### XIII. 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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“(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.

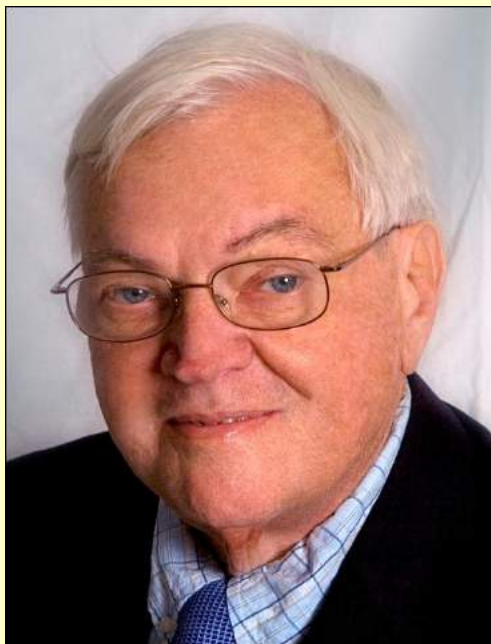
“The Director may require additional information where there is a question whether the delay was unintentional.

“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.”

## *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:

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>.

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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