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Role of Priority Right in Intellectual Property.

Introduction

Intellectual Property (IP) rights grants creators exclusive rights over their inventions, designs, creative works, etc.,. However, these rights are territorial, which means protection is limited to the country where registration occurs. To navigate this limitation and Secure global protection inventors and creators rely on the concept of priority right.

The Latin maxim “*Qui prior est tempore potior est jure*” which means he who is earlier in time is stronger in law. In the context of Intellectual Property Rights, this principle applies to the concept of priority. Generally, the first person to establish a valid IP right gets priority over others who may try to claim the same right later. This applies to various forms of IP. For instance: patents- The first inventor to file a patent application for a qualifying invention gets priority, not necessarily the one who first came up with the idea.

Priority right or right of priority is the concept of IP is a time bound advantage granted to the first applicant who files for a patent, trademark or industrial design. Priority right allows the applicant to subsequently file applications in other countries for the same IP claiming the original filing date as the effective date.

Example:

‘A’ an inventor files a patent application for a new device in their home country ‘Q’ on March 1st, 2024 (priority date). Within 12- month priority period, ‘A’ files another application for the same invention in countries ‘R’ and ‘F’. Even though the applications in ‘R’ and ‘F’ are filed later (e.g. 5th and 6th April 2024) their effective filing date is considered to be March 1st, 2024 due to the claimed priority.

Article 4 of the Paris Convention for the protection Of industrial property¹ establishes the right of priority, a cornerstone for international Intellectual Property (IP) protection. The right of priority allows an applicant who files an initial application for an IP right (patent, Trademark, design) in one member country of the Paris Convention to subsequently file applications in other member countries with in a specified period. This subsequent application are treated as if they were filed on the same date as the initial application. The following are the summary of the key points under Article 4 of Paris Convention:

- Who can claim right of priority?

Applicants who have duly filed for a patent, utility model, industrial design or trademark in a member country, or their successor in title can claim priority.

In *Edwards Lifesciences AG v. Cook Biotech INC*², it was observed that :

The right to claim patent priority under Article 4A(1) of the Paris Convention requires original applicant or their successor in title. If he is not the original applicant or his successor in title, then he is denied the privilege, even though if acquires the title of the invention later does not change that. It remains the case that he was not entitled to the privilege when he filed the later application and made this claim. Any other interpretation would introduce uncertainty and the risk of unfairness to third parties.

- Any filing equivalent to a regular national filing, set by domestic legislation, or bilateral/multilateral treaties between member countries will be recognised for establishing priority rights (Article 4A(2) of the Paris Convention). This means it establishes a valid filing date in that country regardless of the applications fate (Article 4A(3) of the Paris Convention).
- Duration of the Priority period:
Under Article 4C of the Paris Convention provides 12-month priority period for patents and utility models. Six months for trademarks and industrial designs.
The period starts from the filing date of the first application excluding the filing day itself.
- The subsequent applications filed in other member countries with in the priority period are treated as if filed on the same date as the first application.

¹ World Intellectual Property Organization (WIPO)

<https://www.wipo.int/wipolex/text>

Paris Convention for the Protection of Industrial Property(last accessed- April 8th ,2024)

² *Edwards Lifesciences AG v. Cook Biotech INC*, (2009) EWHC 1034 (pat).

There is a specific situation where a later application can benefit from the filing date of an earlier application in the same country. This applies if the earlier application was withdrawn, abandoned or rejected, but never publicly disclosed and didn't establish any ongoing rights. In such cases, the later application can be treated as the first filing, gaining the benefit of the earlier date for claiming priority in other countries. However, the earlier application can no longer be used for claiming its own priority rights.

- Protection during protection:
Acts such as third-party filings, Publications or public use of the Invention during this priority period won't affect the rights of the later application.
- Formalities for claiming priority:
 - Declaration of priority: To claim priority, applicants must make a declaration indicating the date and country of the first application. Each member determines the deadline for this declaration.
 - Publication of Information: The declaration details are included in an official publication.
 - Failure to comply with formalities may result in the loss of priority rights.
- Other key provisions of the Paris Convention:
 - Countries cannot refuse priority claims based on multiple filings or additional elements not present in the original application as long as there is unity of invention.
 - Priority cannot be refused based on elements not appearing in the claims of the original application as long as they are disclosed in the application documents.
 - Priority rights can be extended between different types of IP filings such as from utility models to industrial designs.

Article 8 of the Patent Cooperation Treaty³ provides for the claiming priority for inventions in international patent applications. This helps the inventors and the Patent professionals navigate the complexities of claiming priority in International patent application.

³ Article 8 Claiming Priority - Patent Cooperation Treaty (PCT) -WIPO
[https://www.google.com/url?sa=t&source=web&rct=j&opi=89978449&url=https://www.wipo.int/pct/en/txts/articles/a8.html%23%20text%3D\(1\)%2520The%2520international%2520application%2520may%2520Protection%2520of%2520Industrial%2520Property.&ved=2ahUKewjTlMa29rKFaxU3oGMGHfEaCMsQFnoECBAQBQ&usg=AOvVaw1KWW28vF-Y0_nWDh40HkDR](https://www.google.com/url?sa=t&source=web&rct=j&opi=89978449&url=https://www.wipo.int/pct/en/txts/articles/a8.html%23%20text%3D(1)%2520The%2520international%2520application%2520may%2520Protection%2520of%2520Industrial%2520Property.&ved=2ahUKewjTlMa29rKFaxU3oGMGHfEaCMsQFnoECBAQBQ&usg=AOvVaw1KWW28vF-Y0_nWDh40HkDR) (last accessed- April 8th, 2024).

Generally, the International application follows the Paris Convention rules for claiming priority. But, if you designate a specific country and claim priority from an application filed in that same country, that country's National laws govern the priority claim.

In *Carlos Alberto Perez Lafuente v. Union of India & others*⁴, the Delhi High Court overturned decision rejecting a PCT application which is entering into the national phase in India due to the request for examination was made too late. The issue stemmed from the conflicting timelines in Indian Patent Rules and PCT guidelines. One set a deadline based on the priority dates while the other considered the filing date. The court acknowledged the confusion this caused and ordered the Patent office to re-evaluate the application.

Benefits of the right of priority:

- Time advantage: Right of priority offers valuable time for inventors and creators to assess potential markets, research competitors activity and formulate a strategy filing approach. This flexibility allows for informed decision making regarding International Protection.
- Enhanced protection: The earlier effective filing date established through priority strengthens the applicant's position in case of dispute over novelty or infringement.
- Cost effectiveness: Claiming priority avoids the need for simultaneous filings in all desired countries, reducing initial legal and administrative expenses.

Conclusion

The right of priority is an essential tool for maximizing the protection and value of intellectual property in the globalised marketplace. It is not merely a procedural formality. As the world becomes increasingly interconnected, a sophisticated understanding and strategic application of right of priority will remain Paramount for fostering Innovation and economic growth in the Global Marketplace.

⁴ Carlos Alberto Perez Lafuente v. Union of India and others, W.P.(c) 6975/2011& CM No. 16014/2011.