

Navigating Paris Convention Article 4(C)(4): The International Right of Priority in the United States and Abroad

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## I. Introduction

Imagine this: you are a first-year associate working on behalf of an accused infringer in a big patent case, the kind of patent case involving a blockbuster pharmaceutical that could cost your client hundreds of millions of or even a billion dollars. What an opportunity! As a first-year associate, however, you are assigned the menial task of document review. Hours into the task, you stumble upon a piece of killer prior art – a slam-dunk, novelty-destroying piece of prior art. Well, prior art to the application that issued as the patent in suit, but not to the priority application that establishes the critical date for the patent in suit.

Because the discovery requests were skillfully drafted, however, also buried in the discovery is evidence of a (previously secret) application for the same invention filed abroad (say, in Japan, where the patent owner is headquartered) before the priority application was filed. Further investigation reveals that this secret application was not withdrawn, abandoned or refused before the priority application was filed. In other words, when the priority application was filed, there were rights outstanding in the secret application. In other words, the priority application is not “the first application” for the invention as required under the international right of priority. If the priority application is not the first application, then the patent in suit is not entitled to its claimed priority date. Your prior art is back in. All of a sudden, your rather humdrum discovery is relevant! You are a hero! But wait, are you?

The international right of priority is governed, in the United States, by section 119 of title 35 of the United States Code (“Section 119”),<sup>1</sup> which implements Article 4 of the Paris Convention on the Protection of Industrial Property (“Paris Convention”)<sup>2</sup> and establishes the

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<sup>1</sup> 35 U.S.C. § 119 (2012).

<sup>2</sup> Paris Convention on the Protection of Industrial Property art. 4, July 14, 1967, 21 U.S.T. 1583 (as last revised at Stockholm).

requirements for transforming a subsequent application for an invention into a first application, the only application entitled to a right of priority under the statute.

In view of the implications of contravening the rules governing the international right of priority (loss of the priority claim), you may wonder how any competent patent practitioner could have created the situation that has now given you this stupendous opportunity to showcase your lawyering skill. However, many United States practitioners are either unaware of or do not appreciate how the provisions implementing the international right of priority in the United States and abroad operate. (Kudos to you for not being one of them.) Even those practitioners who are aware of these provisions, however, find it difficult to navigate the differences between Article 4 of the Paris Convention and Section 119 and to assign meaning to the provisions that can be used to advise clients. There is very little in the way of judicial guidance to help them, leaving the interpretation of many of the ambiguities in Section 119's language in question.

This paper explores the history and context of Article 4(C)(4) and Section 119 to unravel and, if possible, harmonize their meanings. Specifically, this paper finds that, under the appropriate framework of statutory and treaty interpretation, Section 119(c) and Article 4(C)(4) are not commensurate in scope. Section 119(c) deems a subsequent application properly transformed into a first application if the first-filed foreign application requirement set forth in the statute are met for any prior application(s) as of the filing date of the subsequent application. Article 4(C)(4), on the other hand, does not contemplate more than one prior application at a time. Thus, under Article 4(C)(4), the moment that two potential first applications are pending simultaneously, the right of priority attached to that subject matter has been lost.

This interpretation of Section 119(c) reflects an intermediate reading of the section. Europe's approach to Article 4(C)(4), for example, is stricter than the United States' approach

because it more closely adheres to the literal language of Article 4(C)(4) and does not extend to intermediate applications,<sup>3</sup> as Section 119(c) does. A broader reading of Section 119(c), in which the first-filed foreign application requirements need only be met as of the filing of the regular United States application, is also conceivable, though, as this paper explores, not sound policy from a political, economic or Constitutional perspective.

But let's return to our hypothetical litigation for a moment. Are you the hero who will save the day for your worried client? Does the narrow interpretation of Section 119 cut in your favor? Because rights in the secret application were not terminated before the subsequent application was filed, both Section 119 and Article 4(C)(4) bar the relevant priority claim. In the absence of an applicable grace period, your prior art carries the day!

Litigation is just one context in which Section 119 and Article 4(C)(4) rear their heads. Section 119(c) and Article 4(C)(4) are often implicated by filing strategies optimized to delay the filing of a regular application, and objections to priority claims in contravention of Section 119(c) and Article 4(C)(4) can be raised during prosecution by perspicacious examiners, with ruinous effects on a patent strategy. Given the repercussions of contravening the law governing the international right of priority, patent practitioners and others involved in developing, licensing or litigating patent portfolios should be aware of provisions governing the international right of priority in the United States and abroad, and vigilant in situations implicating the right of priority.

## II. The International Patent Treaty Regime and the International Right of Priority

The contours of the international right of priority are set forth in the Paris Convention<sup>4</sup> and promoted by subsequent international treaties which strengthen international cooperation in

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<sup>3</sup> European Patent Convention, art. 87(4).

<sup>4</sup> Paris Convention, *supra* note 2.

the realm of intellectual property protection.<sup>5</sup> This section describes both the international patent treaty regime and the international right of priority established thereby as well as the international right of priority found in the United States Code.

A. The International Patent Treaty Regime

International patenting is largely governed by two World Intellectual Property Organization (WIPO)-administered treaties, the Paris Convention for the Protection of Industrial Property and the Patent Cooperation Treaty (PCT), and one World Trade Organization (WTO)-administered treaty, the Agreement on Trade-related Aspects of Intellectual Property Rights (“the TRIPS Agreement”).<sup>6</sup> The Paris Convention was concluded in 1883 and has been revised several times, most importantly for this paper, at Lisbon in 1958.<sup>7</sup> It was at Lisbon that Article 4, which established the international right of priority, was amended to include the broadening exception set forth in Article 4(C)(4).<sup>8</sup> The Paris Convention is open to all states.<sup>9</sup>

The PCT was concluded in 1970 and established a mechanism for seeking patent protection in each of a large number of countries by filing an international application with the International Bureau of WIPO.<sup>10</sup> The PCT preserves the right of priority established under Article 4 of the Paris Convention, subject to national laws that treat international applications

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<sup>5</sup> Agreement on Trade-related Aspects of Intellectual Property Rights art. 2, Apr. 15, 1995, 1869 U.N.T.S. 299; Patent Cooperation Treaty art. 8, Jun. 19, 1970, 28 U.S.T. 7645.

<sup>6</sup> See TRIPS Agreement, *supra* note 5; PCT, *supra* note 5; Paris Convention, *supra* note 2.

<sup>7</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, at 9 (United International Bureau for the Protection of Intellectual Property, 1969).

<sup>8</sup> *Id.* at 45.

<sup>9</sup> SUMMARIES OF CONVENTIONS, TREATIES AND AGREEMENTS ADMINISTERED BY WIPO 10 (World Intellectual Property Organization 2013).

<sup>10</sup> *Id.* at 22, 24.

meeting certain criteria as domestic applications.<sup>11</sup> The PCT is open to all Paris Convention states, and is widely used by inventors seeking worldwide patent protection.<sup>12</sup>

The TRIPS Agreement is the most recent of the major international treaties governing patent rights, having come into force in 1995, and is the most comprehensive multilateral agreement on intellectual property.<sup>13</sup> States contracting to the TRIPS Agreement agree to comply with the substantive obligations of the most recent version of the Paris Convention.<sup>14</sup> The TRIPS Agreement is open to all states, and ratification is a requirement of WTO membership.<sup>15</sup>

There are also several regional treaties that establish regional patent offices around the globe. The most well-known of these regional treaties is the European Patent Convention (EPC), which established the European Patent Office (EPO),<sup>16</sup> but other regional treaties have effectuated the creation of other regional patent offices. For example, the Charter of the Co-operation Council for the Arab States of the Gulf effectuated the Gulf Cooperation Council Patent Office,<sup>17</sup> the Harare Protocol on Patents and Industrial Designs Within the Framework of the African Regional Industrial Property Organization (ARIPO) effectuated ARIPO,<sup>18</sup> the Bangui Agreement Relating to the Creation of an African Intellectual Property Organization

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<sup>11</sup> Patent Cooperation Treaty, *supra* note 6.

<sup>12</sup> SUMMARIES OF CONVENTIONS, TREATIES AND AGREEMENTS ADMINISTERED BY WIPO, *supra* note 10, at 25.

<sup>13</sup> *Overview: The TRIPS Agreement*, WIPO (Jan. 11, 2018, 10:55 AM), [https://www.wto.org/english/tratop\\_e/trips\\_e/intel2\\_e.htm](https://www.wto.org/english/tratop_e/trips_e/intel2_e.htm).

<sup>14</sup> *Id.*

<sup>15</sup> *WTO and the TRIPS Agreement*, WHO (Jan. 11, 2018, 11:06 AM), [http://www.who.int/medicines/areas/policy/wto\\_trips/en/](http://www.who.int/medicines/areas/policy/wto_trips/en/).

<sup>16</sup> Convention on the Grant of European Patents art. 4, Oct. 5, 1973, 1065 U.N.T.S. 199.

<sup>17</sup> *See* Charter of the Co-operation Council for the Arab States of the Gulf art. 6, Nov. 11, 1981, 1288 U.N.T.S. 131; *About GCC Patent Office*, PATENT OFFICE OF COOPERATION COUNCIL FOR THE ARAB STATES OF THE GULF (Jan. 11, 2018, 11:39 AM), <http://www.gccpo.org/AboutUsEn/AboutUs.aspx>.

<sup>18</sup> Harare Protocol on Patents and Industrial Designs Within the Framework of the African Regional Industrial Property Organization (ARIPO) sec. 1, Dec. 10, 1982, WIPO (Jan. 11, 2018, 11:47 AM), [http://www.wipo.int/wipolex/en/other\\_treaties/details.jsp?group\\_id=21&treaty\\_id=204](http://www.wipo.int/wipolex/en/other_treaties/details.jsp?group_id=21&treaty_id=204).

effectuated the African Intellectual Property Organization<sup>19</sup> and the Eurasian Patent Convention effectuated the Eurasian Patent Office.<sup>20</sup> Each of these regional patent offices establishes procedures for obtaining patent protection in its member countries.

### B. The International Right of Priority

In general, a right of priority enables a patent applicant to rely on a prior application to establish an earlier effective filing date for a subsequent application filed within a statutorily-defined period for the same invention. A domestic right of priority, in which a state recognizes a right of priority for a domestic application based on a prior domestic application has long been a feature of many patent regimes. But, it was not until the Paris Convention was ratified in 1883 that an international right of priority was uniformly adopted. The international right of priority, or Convention priority right, establishes a right of priority for a domestic application based on a prior first foreign application for the same invention.<sup>21</sup> The Convention priority right governs international patent filings today.<sup>22</sup>

The international priority period for utility patents extends for twelve months from the filing date of a priority application, the first application filed for a particular invention. Thus, an applicant that intends to rely on a priority filing under the Paris Convention must file a subsequent application for the same invention, claiming the benefit of the priority application, within twelve months from the filing of the priority application.<sup>23</sup>

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<sup>19</sup> Bangui Agreement Relating to the Creation of an African Intellectual Property Organization, Constituting a Revision of the Agreement Relating to the Creation of an African and Malagasy Office of Industrial Property art. 1, Mar. 2, 1977, WIPO (Jan. 11, 2018, 11:55 AM), [http://www.wipo.int/wipolex/en/other\\_treaties/text.jsp?file\\_id=181152](http://www.wipo.int/wipolex/en/other_treaties/text.jsp?file_id=181152).

<sup>20</sup> Eurasian Patent Convention art. 2, Sept. 9, 1994, WIPO (Jan. 11, 2018, 12:03 PM), [http://www.wipo.int/wipolex/en/other\\_treaties/text.jsp?file\\_id=181192](http://www.wipo.int/wipolex/en/other_treaties/text.jsp?file_id=181192).

<sup>21</sup> Paris Convention, *supra* note 2.

<sup>22</sup> See PCT, *supra* note 6.

<sup>23</sup> PCT rule 26bis.3 provides for a fourteen month priority period if the failure to file within the priority period “occurred in spite of due care required by the circumstances having been taken” or “was unintentional.” PCT rule 26bis.3, *supra* note 6.

If the filing of the subsequent application is timely, the subsequent application will be regarded as having been filed on the filing date of the first application for purposes of assessing patentability. The right of priority thus shields the subsequent application from events occurring between the filing of the first application and the subsequent application that could otherwise destroy patentability. Conversely, failure to comply with the conditions precedent to the right of priority render a subsequent application susceptible to those same patentability-destroying events.

The international right of priority was formally established by Article 4 of the Paris Convention and is incorporated by reference by Article 8 of the PCT<sup>24</sup> and Article 2 of the TRIPS Agreement.<sup>25</sup> Thus, Article 4 of the Paris Convention is the international law governing the right of priority for any state member of the Paris Convention, the PCT or the TRIPS Agreement.<sup>26</sup>

Because the right of priority shields an applicant from events that would otherwise compromise the applicant's ability to obtain patent rights, it is very valuable. For example, the right of priority allows an applicant to proceed with commercialization of its invention during the priority period without tolling the patent term clock. It can also be used to ward off competitors' public activities or priority period patent filings.

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<sup>24</sup> Article 8(2) of the PCT states that the conditions for and the effect of any priority claim made in an international application filed under the treaty are as provided in Article 4 of the Paris Convention, with the exception that priority claims made in applications entitled to treatment as national applications under a state's laws are governed by the national law of that state. PCT, *supra* note 6.

<sup>25</sup> Article 2(1) of the TRIPS Agreement requires member states to comply with Articles 1 through 12 and 19 of the Paris Convention, and Article 2(2) makes explicit that the TRIPS Agreement provisions relevant to the standards governing the acquisition, scope and use, acquisition and maintenance and enforcement of intellectual property rights do not deviate from the obligations established by membership to the Paris Convention. The TRIPS Agreement, *supra* note 6.

<sup>26</sup> Because membership to the PCT requires ratification of the Paris Convention, every member state to the PCT is also a member state to the Paris Convention. Although membership to the TRIPS Agreement is not predicated on membership to either the PCT or the Paris Convention, Article 2(1) of the TRIPS Agreement effectively binds its members to at least Article 4 of the Paris Convention. Accordingly, the term "contracting state," used herein, encompasses any state party member to the Paris Convention, the PCT or the TRIPS Agreement.

Paris Convention Article 4(C)(4) establishes a broadening exception to the general right of priority, which previously attached only to the first application filed for a particular subject matter.<sup>27</sup> Specifically, Article 4(C)(4) allows an applicant to reset its priority period and transform a subsequent application filed for the same invention into a first application if the first and subsequent applications meet certain requirements.<sup>28</sup> To fall within the exception established by Article 4(C)(4), the first and subsequent applications must be for the same subject matter. This is the so-called same invention requirement.<sup>29</sup> The first and subsequent applications must also be filed in the same country, and thereby meet the same country requirement. Finally, the first-filed foreign application must meet the first-filed foreign application requirement, a set of conditions related to the status of the first-filed foreign application. To meet the first-filed foreign application requirement, the first-filed foreign application must be withdrawn, abandoned or refused, without having been made public, without leaving any rights outstanding as of the filing of the subsequent application. The first-filed foreign application also cannot have served or thereafter serve as the basis of a priority claim.

Because the filing of a priority application does not start the patent term clock, which is only triggered by the filing of a regular application, the Article 4(C)(4) exception effectively allows an applicant to extend its patent term by the time period between the filing of first and subsequent priority applications. Accordingly, the Article 4(C)(4) exception provides a tempting option for applicants that do not fear imminent competition. It is also an escape hatch for applicants who discover a flaw in their first application and wish to abandon the first application in favor of a corrected subsequent application.

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<sup>27</sup> Bodenhausen, *supra* note 8, at 45.

<sup>28</sup> *Id.*

<sup>29</sup> As will be discussed *infra*, “same subject” means “same invention.” See *infra* note 46.

Failure to comply with the priority right provisions of Article 4(C)(4) results in a loss of the right of priority. Thus, an applicant found to have breached Article 4 of the Paris Convention loses the benefit of its priority claim and is limited to the filing date of its regular application to establish patentability. As our hypothetical litigation demonstrates, if an applicant must rely on a right of priority to prove novelty of an invention, the consequences of contravening Article 4(C)(4) and its national counterpart, Section 119 in the United States, are devastating.

C. The International Right of Priority in the United States Code

Section 119 sets forth the domestic corollary of the Convention priority right. In relevant part, Section 119 states:

(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...

...

(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.<sup>30</sup>

Thus, Section 119, like Article 4(C)(4), describes a same invention requirement, a same country requirement and a first-filed foreign application requirement.

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<sup>30</sup> Section 119, *supra* note 1.

### III. Interpretive Framework

The United States ratified the Paris Convention, as amended at Lisbon, on October 26, 1961.<sup>31</sup> The United States is also a member of both the PCT and the TRIPS Agreement,<sup>32</sup> both of which were negotiated after Lisbon. Neither the PCT nor the TRIPS Agreement disturbs the right of priority established by the Paris Convention.<sup>33</sup> Accordingly, the United States is bound by the provisions of the Paris Convention, including Article 4(C)(4), which provides a narrow but broadening exception to the original international right of priority.

Stating that the United States is bound to certain standards as a matter of international law does not settle the matter, however, because, under domestic law, Congress can ignore or even abrogate the United States' international obligations. To define, as a matter of United States law, the contours of the international right of priority, it is therefore necessary to define the relationship between the Paris Convention and domestic United States law. In other words, it is necessary to identify the controlling provision. Once the controlling provision is identified, the provision must be construed in accordance with the relevant principles of interpretation. Interpretation of treaties is governed by the rules of interpretation established by the Vienna Convention on the Law of Treaties (VCLT).<sup>34</sup> Interpretation of domestic legislation, even domestic legislation implementing a treaty, requires navigating the domestic rules of statutory construction.

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<sup>31</sup> WIPO-administered Treaties: Contracting Parties>Paris Convention>United States of America, WIPO (Jan. 11, 2018, 12:40 PM), [http://www.wipo.int/treaties/en/remarks.jsp?cnty\\_id=334C](http://www.wipo.int/treaties/en/remarks.jsp?cnty_id=334C).

<sup>32</sup> Other IP Treaties: IP-related Multilateral Treaties>Contracting Parties/Signatories>Agreement on Trade-related Aspects of Intellectual Property Rights, WIPO (Jan. 11, 2018, 12:45 PM), [http://www.wipo.int/wipolex/en/other\\_treaties/parties.jsp?treaty\\_id=231&group\\_id=22](http://www.wipo.int/wipolex/en/other_treaties/parties.jsp?treaty_id=231&group_id=22); WIPO-administered Treaties: Contracting Parties>Patent Cooperation Treaty, WIPO (Jan. 11, 2018, 12:43 PM), [http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty\\_id=6](http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=6).

<sup>33</sup> TRIPS Agreement, *supra* note 6; PCT, *supra* note 6.

<sup>34</sup> Vienna Convention on the Law of Treaties arts. 31, 32, May 23, 1969, 1155 U.N.T.S. 331.

A. Identifying the controlling provision

Section 119, as opposed to Article 4(C)(4) of the Paris Convention, is the controlling provision under United States law because Article 4(C)(4) of the Paris Convention is non-self-executing and, regardless, would be preempted to the extent of any conflict by the subsequent enactment of Section 119.

1. The Convention is non-self-executing and Section 119 implements the Paris Convention

Under United States law, international treaties can become the law of the land by the mere act of ratification and entry into force. Such treaties, which require no legislative action in order to be enforceable in United States courts, are deemed “self-executing.” Non-self-executing treaties, on the other hand, are not judicially applicable unless and until implementing legislation is enacted by Congress.

Section 119 was enacted to implement Article 4 of the Paris Convention.<sup>35</sup> Accordingly, whether Section 119 controls turns on whether or not the Paris Convention is self-executing and which of Section 119 and Article 4(C)(4) is last in time.

The Federal Circuit has ruled that the Paris Convention is not self-executing.<sup>36,37</sup> Hence, Congress is not only free to, but must, act to imbue the Paris Convention with the force of law. Thus, the Paris Convention is only given effect to the extent of its implementing legislation, Section 119.

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<sup>35</sup> *Scimed Life Sys. v. Medtronic Vascular, Inc.*, 468 F.Supp.2d 60, 67, n. 6 (D. D.C. 2006), *citing Vogel v. Jones*, 486 F.2d 1068, 1072 (C.C.P.A. 1973).

<sup>36</sup> *In re Rath*, 402 F.3d 1207, 1209-10 (Fed. Cir. 2005).

<sup>37</sup> Although the understanding of the Paris Convention as non-self-executing is not without dissenters, both at home and abroad, the Federal Circuit seems to have settled on this construction of the Convention. *Id. Compare Bodenhausen, supra* note 8, at 14.

## 2. Section 119 is last in time

Even if the Paris Convention were to be deemed self-executing, however, Section 119 would be effective under the last-in-time rule. Congressional action can render a treaty null to the extent that the Congressional act is inconsistent with the treaty.<sup>38</sup> This principle is an embodiment of the last-in-time rule, which states that if two legislative acts conflict, the more recent act, or the last in time, is given effect.

The Paris Convention, as amended at Lisbon, was ratified on October 26, 1961.<sup>39</sup> Section 119 was first enacted on October 3, 1961, and has been reenacted several times since then, most recently in 2012, as part of the AIA.<sup>40</sup> Accordingly, Section 119 is subsequent and prevails as the law to the extent of any conflict with Article 4(C)(4) under the last-in-time rule.

### B. Construing the controlling provision

As an act of Congress, Section 119 should be interpreted in accordance with the relevant domestic principles of statutory construction. One such principle provides that ambiguities in the text of Section 119 should be resolved so as not to abrogate international obligations absent evidence of clear Congressional intent to do so.<sup>41</sup> In the context of resolving ambiguities arising under domestic legislation implementing an international treaty, it is therefore appropriate to rely on international rules of treaty interpretation, which are set forth in Articles 31 and 32 of the VCLT.<sup>42</sup>

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<sup>38</sup> *Reid v. Covert*, 354 U.S. 1, 18 (1957). See also *Cherokee Tobacco*, 78 U.S. 616, 621 (1870).

<sup>39</sup> WIPO-administered Treaties: Contracting Parties>Paris Convention>United States of America, *supra* note 32.

<sup>40</sup> 35 U.S.C. § 119 (2012) (originally enacted as Pub.L. 87-333, § 1, Oct. 3, 1961, 75 Stat. 748 and re-enacted as Pub.L. 92-358, § 1, July 28, 1972, 86 Stat. 501; Pub.L. 93-596, § 1, Jan. 2, 1975, 88 Stat. 1949; Pub.L. 103-465, Title V, § 532(b)(1), Dec. 8, 1994, 108 Stat. 4985; Pub.L. 106-113, Div. B, § 1000(a)(9) [Title IV, §§ 4503(a), (b)(2), 4801(b), (c), 4802], Nov. 29, 1999, 113 Stat. 1536, 1501A-563, 1501A-564, 1501A-588, 1501A-589; Pub.L. 107-273, Div. C, Title III, § 13206(b)(2), Nov. 2, 2002, 116 Stat. 1906; Pub.L. 112-29, §§ 3(g)(6), 15(b), 20(j)(1), Sept. 16, 2011, 125 Stat. 288, 328, 335; and Pub.L. 112-211, Title II, §§ 201(c)(1), 202(b)(2), Dec. 18, 2012, 126 Stat. 1534, 1536.

<sup>41</sup> *Murray v. The Schooner Charming Betsey* at 118.

<sup>42</sup> Vienna Convention on the Law of Treaties, *supra* note 35.

## 1. Interpreting Section 119

Section 119(a) sets forth the same invention criterion and Section 119(c) establishes a sanctioned method of transforming a subsequent regularly filed foreign application into a first filed foreign application. Section 119(c) thus implements Article 4(C)(4) of the Paris Convention. Because Section 119(a) introduces the same invention criterion of Article 4(C)(4), it will also be discussed here.

### a. The Same Invention Requirement

For purposes of Section 119, a previous application and a subsequent application are for the same invention if the previous application discloses the subject matter of the invention claimed in the subsequent application in a manner that meets the requirements of 35 U.S.C. §§ 101 and 112 (Section 101 and 112, respectively). Courts have required that an “application for a patent for the same invention” disclose the claimed invention in order to obtain priority under Section 119.<sup>43</sup> In addition, the previous application must comply with the first paragraph of Section 112<sup>44</sup> and Section 101<sup>45</sup> for priority to attach.

Accordingly, an applicant meets the same invention requirement of Section 119 if the priority document discloses the claimed subject matter in accordance with Section 101 and Section 112(a).<sup>46</sup>

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<sup>43</sup> *In re Gosteli*, 872 F.2d 1008, 1011 (Fed. Cir. 1989); *Ex parte Yamaguchi*, 6 U.S.P.Q.2d 1805, 1987 WL 124031 at \*2 (B.P.A.I. 1987).

<sup>44</sup> *In re Gosteli*, 872 F.2d at 1011; *Ex parte Yamaguchi*, 1987 WL at \*3. *See also Olson v. Julia*, 209 U.S.P.Q. 159 (B.P.A.I. 1979).

<sup>45</sup> *Kawai v. Metlesics*, 480 F.2d 880, 886, 889 (C.C.P.A. 1973).

<sup>46</sup> The significance between “same invention” in Section 119 and “same subject” in Article 4(C)(4) is not immediately self-evident. On its face, the term “same subject” used in Article 4(C)(4) would seem to capture a greater swath of disclosures in first applications than the term “same invention” used in Section 119. However, both national practice and contemporaneous commentary suggest that such a broad interpretation of “same subject” is unwarranted. Rather, “same subject” means “same invention.”

In his Guide to Interpreting the Paris Convention, published after the Convention was revised at Stockholm in 1967, Bodenhausen explains that “same subject” refers, in the case of patents, to the same invention or innovation. Bodenhausen, *supra* note 8, at 38. While there is no reason that Bodenhausen’s Guide should be given interpretive

## b. The Same Country Requirement

To take advantage of Section 119(c), both the first application and the subsequent application must be filed in the same foreign country. Accordingly, the question of how to interpret the term “same country,” which appears in both Section 119 and Article 4(C)(4), arises. The question is interesting when viewed in the context of regional intellectual property offices having occasionally shifting memberships. The question then becomes whether a regional intellectual property office is the “same country” before and after a change to its membership. While the question may persist for foreigners, it is of little concern to United States patent practitioners because Title 35 of the United States Code does not treat any regional organizations as countries for the purposes of Section 119.

The term “foreign country” is not defined in Title 35 of the United States Code.

However, “WTO member country” was defined in pre-AIA 35 U.S.C. § 104 (Section 104).<sup>47</sup>

Pre-AIA Section 104(b)(2) defined “WTO member country” by reference to section 2(10) of the

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weight, as a member of the Dutch delegation at Lisbon, Bodenhausen participated in the negotiations leading to Article 4(C)(4). His commentary is thus at least indirect evidence of the context of the negotiations.

Bodenhausen’s view has also been adopted by the Enlarged Board of Appeal of the EPC. In its Decision/Opinion G 2/98, the Enlarged Board of Appeal equated the concepts of “same invention” and “same subject,” finding that such an interpretation was “perfectly consistent” with Article 4(C)(4) of the Convention. Enlarged Bd. App., G 0002/98, May 31, 2001, at 14, 25 (Eur. Pat. Off.). The Enlarged Board of Appeal went on to say that “same invention” means any subject matter that a skilled person can derive “directly and unambiguously” from a prior application. *Id.* at 25.

As in the United States, relevant litigation on the subject is scarce. However, the patent statute of at least one other member of the IP5, a forum of the five largest intellectual property offices in the world, the United States Patent & Trademark Office (USPTO), the European Patent Office (EPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO) and the State Intellectual Property Office (SIPO) of China, is consistent with this interpretation of “same subject.” Article 54 of the Korean Patent Act regulates priority claims under a treaty. An English-language translation of Article 54 uses the “same invention” language found in Section 119. Korean Patent Act, Act. No. 14112, Mar. 29, 2016, art. 54 (S. Kor.), *translated in* Korea Legislation Research Institute online database, [http://elaw.klri.re.kr/eng\\_service/lawView.do?hseq=38488&lang=ENG](http://elaw.klri.re.kr/eng_service/lawView.do?hseq=38488&lang=ENG). Further, a publication issued by KIPO explains that “the invention stated in the patent claim” of the application with a priority claim must be an invention “understood from the whole patent documentation filed in the first country,” such as the description and drawings. *See* UNDERSTANDING THE PATENT ACT OF THE REPUBLIC OF KOREA 107 (WIPO Lex. 2010).

The interpretation of the Enlarged Board of Appeal of the EPC is identical to the actual wording of Section 119 of Title 35 of the United States Code and Article 54 of the Korean Patent Act. Thus, despite Section 119’s departure from the language of Article 4(C)(4), the linguistic difference does not amount to a true distinction between the two texts.

<sup>47</sup> 35 U.S.C. § 104 (2002) (repealed 2011).

Uruguay Rounds Agreement Act, which defines “WTO member country” as a state or separate customs territory as defined by Article XII of the Agreement Establishing the World Trade Organization (“WTO Agreement”).<sup>48</sup> Article XII of the WTO Agreement states, in turn, that customs territories must possess full autonomy in the conduct of their external relations and other matters relevant to the WTO Agreement.<sup>49</sup> It is a stretch to classify a regional patent organization as a separate customs territory on par with a state. Hence, the EPC (as opposed to the European Union, which is a customs territory within the meaning of Article XII of the WTO Agreement) is not a WTO member, nor is WIPO, the Co-operation Council for the Arab States of the Gulf, the Eurasian Patent Convention or any other regional patent organization.<sup>50</sup>

Applying the principle of *noscitur a sociis*, it is reasonable to further conclude that “foreign country,” which is associated with “WTO member country” in a two-member list in Section 119(a), is limited to states or customs territories and does not include regional patent organizations. Although the AIA does not define either “foreign country” or “WTO member country,” the wholesale adoption of Section 119 under the AIA suggests a Congressional intent to leave the interpretation of these terms undisturbed. Accordingly, it is unlikely under Section 119 (AIA or pre-AIA) that a right of priority may be based on an application filed in a regional patent office.

Thus, for all practical purposes, determining whether the same country requirement is met boils down to asking whether the first and subsequent applications were filed in the same state.

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<sup>48</sup> 19 U.S.C.A. § 3501 (1994).

<sup>49</sup> Agreement Establishing the World Trade Organization art. XII, Apr. 15, 1994, 1867 U.N.T.S. 154.

<sup>50</sup> 35 U.S.C. § 365 explicitly provides a right of priority for international applications that designate at least one country. International applications are applications filed under the PCT, an international (as opposed to regional) patent organization. The necessity for a provision providing a right of priority for an application deposited with a patent organization, as opposed to a state intellectual property office, lends further support to the conclusion that United States law does not contemplate a right of priority based on a regional patent application. 35 U.S.C. § 365 (2012).

c. The First-filed Foreign Application Requirement

Under Section 119(a), a right of priority is always available to an applicant who makes a priority claim within twelve months of when “the application for patent for the same invention was first filed” in a foreign country.<sup>51</sup> Under section 119(c), however, a priority application that is not the first application for patent filed for the same invention will be treated as the first application if four criteria are met.<sup>52</sup> Specifically, the first-filed foreign application (1) must be withdrawn, abandoned or otherwise disposed of (2) without having been made public (3) without leaving any rights outstanding and (4) cannot, at any time, serve as the basis for a priority claim.<sup>53</sup>

Although detailed, Section 119(c) is inherently ambiguous because it does not specify when the four conditions of the first-filed foreign application requirement are to be met. In contrast, Article 4(C)(4) permits a subsequent application to become a previous application, and to thereby meet the first-filed foreign application requirement, if, *at the time of filing the subsequent application*, the previous application has been withdrawn, abandoned, or refused, without having been made public and without leaving any rights outstanding, and if it has not yet served, nor thereafter shall serve, as a priority application.<sup>54</sup> A comparison of Article 4(C)(4) and Section 119(c) thus makes evident the ambiguity created by Section 119’s silence as to the relevant time for meeting the first-filed foreign application requirements.

There are two plausible ways to interpret the first-filed foreign application requirement set forth in Section 119(c): either the first-filed foreign application requirement should be fulfilled as of the filing date of the application for patent filed in the United States or it should be

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<sup>51</sup> 35 U.S.C. § 119, *supra* note 1.

<sup>52</sup> *Id.*

<sup>53</sup> *Id.*

<sup>54</sup> Paris Convention, *supra* note 2.

fulfilled as of the filing date of the subsequent foreign application, typically well before the application for patent in the United States is filed. The first interpretation, in which the first-filed foreign application requirement may be fulfilled as of the filing date of the application for patent filed in the United States, provides a broader exception to the general prohibition against discarding early priority documents by expanding the time during which an applicant may bring its first application into conformity with the requirements of Section 119(c). The exception implied by the second interpretation is much narrower because it requires an applicant to fulfill the first-filed foreign application requirement prior to filing a subsequent priority application. The narrow interpretation of Section 119(c) thus requires an applicant to irrevocably terminate any rights associated with a prior application before filing a subsequent foreign application to the same invention.

United States courts have not considered the timing issue as it relates to the first-filed foreign application requirements. However, the legislative history is replete with averments that both the language and substance of the amendment ultimately enacted as Section 119(c) matched the language and substance of the treaty.<sup>55</sup> Though not dispositive, the legislative history favors an interpretation of the first-filed foreign application requirement of Section 119(c) that comports with the language and substance of Article 4(C)(4), which formed the basis of Section 119(c).

The legislative history of Section 119(c) thus provides evidence, albeit indirect, that Congress sought to bring United States law into alignment with the plain language of Article 4(C)(4). Instead of evidence of a clear Congressional intent to abrogate the treaty, which would prohibit resort to the meaning of Article 4(C)(4) under *Charming Betsey*, the legislative history

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<sup>55</sup> International Convention Patents and Trademarks: Hearings Before Subcomm. No. 3 of the Comm. on the Judiciary H.R. 87th Cong. First Sess. on H.R. 5754 and H.R. 7347, 87th Cong., 16 (1961) (“we must put our own law into shape, to match the terms of the treaty”); S. REP. NO. 87-1019, at 2, 4 (1961) (“amendments...closely follow the substance of subparagraph 4 of article 4(C) of the Convention of Paris revised at Lisbon”; “language paralleling the language of the treaty”).

of Section 119(c) suggests an intent to faithfully implement Article 4(C)(4). Thus, it is appropriate to interpret Article 4(C)(4) in order to resolve the ambiguities in the first-filed foreign application requirement set forth in Section 119(c).

## 2. Interpreting Article 4(C)(4)

Article 4(C)(4) of the Paris Convention must be interpreted in light of VCLT Articles 31 and 32, which set forth the rules of treaty interpretation. VCLT Article 31 states that a treaty should be interpreted in good faith, and that the terms of a treaty should be given their ordinary meaning in their context in view of the object and purpose of the treaty.<sup>56</sup> VCLT Article 32 states that the *travaux preparatoires* may be used to confirm the meaning resulting from the application of Article 31 or to determine the meaning when interpretation under Article 31 does not resolve the meaning or leads to an absurd or unreasonable interpretation.<sup>57</sup>

Article 4(C)(4) was concluded at Lisbon in 1958 and thereafter bound states party to the Paris Convention. The Paris Convention itself was negotiated for the object and purpose of protecting industrial property amongst its member states.<sup>58</sup> Article 4(C)(4) is consistent with the object and purpose of the treaty because it extends the right of priority established in Article 4 of the original Paris Convention. Article 4(C)(4) provides:

(4) A subsequent application concerning the same subject 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>59</sup>

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<sup>56</sup> Vienna Convention on the Law of Treaties, art. 31, *supra* note 35.

<sup>57</sup> Vienna Convention on the Law of Treaties, art. 32, *supra* note 35.

<sup>58</sup> See Paris Convention art. 1, *supra* note 2.

<sup>59</sup> Paris Convention, art. 4, *supra* note 2.

Article 4(C)(4) thus establishes a mechanism for transforming a subsequent application concerning the same subject as a previous first application into a proper priority application, thereby re-setting the priority period established by the previous first application.

Interpreted broadly, Section 119 broadens the language of Article 4(C)(4) by omitting the explicit timing requirement in Article 4(C)(4). Typically, this would not warrant further consideration because many provisions of the Paris Convention, including Article 4(A)(1), which establishes the basic right of priority, are considered to represent a baseline.<sup>60</sup> This means that countries may adopt more lenient systems without contravening the Paris Convention.<sup>61</sup> The history of Article 4(C)(4) suggests, however, that member states that negotiated the revision to Article 4 did not intend to establish a baseline, but the boundaries of an exception to the general right of priority. When applying Article 4(C)(4), then, countries should not treat the exception as a baseline, but should construe it narrowly and strictly.

Article 4(C)(4) lays out four criteria which must be fulfilled at the time of filing the subsequent application. Specifically, the previous first application must (1) have been withdrawn, abandoned or refused (2) without having been made public (3) without leaving any rights outstanding and (4) may not be the subject of a priority claim.

This rather exacting standard was the result of a detailed negotiation stemming from a proposal to amend Article 4 made by the International Association for the Protection of Intellectual Property (AIPPI) prior to the Lisbon meeting.<sup>62</sup> The proposed reform was intended to provide a sanctioned pathway whereby an applicant could correct an erred priority application by re-filing a corrected application. Under the version of Article 4(C)(2) then existing, filers were

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<sup>60</sup> Bodenhausen, *supra* note 8, at 35, 37.

<sup>61</sup> *Id.*

<sup>62</sup> ACTES DE LA CONFÉRENCE RÉUNIE A LISBONNE DU 6 OCTOBRE 1958, at 328 (United International Bureau for the Protection of Intellectual Property, 1963).

already withdrawing priority applications and subsequently refile in the same country, but were doing so in secret to avoid attracting attention to the fact that the filing ultimately being relied upon as the basis of priority was not the “first application.” Under the existing Article 4, only the “first application” entitled an applicant to a right of priority.<sup>63</sup>

The AIPPI proposed amending Article 4(C)(2) as follows:

(C)(2) These periods shall start from the date of filing of the first application. **However, an application subsequently deposited in a country of the Union shall also be considered as a first application, the date of deposit of which shall be the starting point of periods of priority, if at any time a right of priority is claimed on the basis of this subsequent application, the original application, as well as any intermediate applications, has been withdrawn, abandoned or refused and if none of these applications has already served as the basis for a claim to a right of priority.** The day of filing shall not be included in the period.<sup>64</sup>

This text differs substantially from the text that ultimately became Article 4(C)(4), providing a much broader mechanism for correcting a “false-start” application. Specifically, the AIPPI proposal did not require that the original and subsequent application be deposited in the same country. The original application need only have been withdrawn, abandoned or refused as of the date of claiming priority to the subsequent application. Thus, applicants could have deferred deciding the fate of the original application later under the AIPPI proposal and, in the case of a United States provisional application, could have transformed the subsequent application into the first application without having to act at all, by virtue of the fact that United States provisional applications expire a year after they are filed.

The AIPPI proposal also contemplated intermediate applications filed between the first and subsequent application and did not require that the first application be withdrawn, abandoned

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<sup>63</sup> *Id.* at 237.

<sup>64</sup> *Id.* at 328 (emphasis indicates the proposed changes).

or refused without having been laid open to public inspection with no rights left outstanding. Finally, the AIPPI proposal would have made it possible for a first application to serve as the basis for a claim to a right of priority after a priority claim is made from the subsequent application.<sup>65</sup>

The delegations of France and Italy recognized that the AIPPI proposal left open the possibility for an applicant to accumulate multiple rights of priority with respect to a single invention, and opposed the AIPPI proposal on the basis that the right of priority established by the Paris Convention was singular and indivisible. This opposition led to a revised proposal.

The revised proposal was presented by the British delegation and contained many of the features of the accepted text.<sup>66</sup> The British proposal required that the first and subsequent applications be deposited in the same country, it no longer contemplated intermediate applications, and it specified that the first application could not serve as the basis for a claim to a right of priority after a priority claim was made from the subsequent application.

However, there was still no requirement that the first application not have been laid open to public inspection and the possibility of the accumulation of multiple priority rights remained because there was no requirement that the original application be withdrawn, abandoned or refused. This latter omission met with continued resistance from the French delegation, leading to the adoption of the requirement that the first application be withdrawn, abandoned or refused without leaving rights outstanding as of the filing of the subsequent application.<sup>67</sup> The Dutch and Austrian delegations suggested language requiring that the first application not be published,

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<sup>65</sup> It is acknowledged that this distinction may be insubstantial, given the likely timing of the relevant filings. For example, it is more likely than not that the priority period established by the first application (*i.e.*, twelve months for patents, six months for designs) would have expired by the time priority was claimed to the subsequent application. Nonetheless, the distinction represents yet another strategic option for an applicant.

<sup>66</sup> ACTES DE LA CONFÉRENCE RÉUNIE A LISBONNE DU 6 OCTOBRE 1958, *supra* note 62, at 334.

<sup>67</sup> *Id.* at 335.

and language to such effect was introduced into the proposed text, which the delegations agreed to incorporate into the Paris Convention in a new paragraph, Article 4(C)(4).<sup>68</sup>

Thus, two conditions were required to render the British proposal acceptable: (1) the article should only apply in the case that an inventor who was mistaken about the scope or definition of his invention replaced the first application with a subsequent application; and (2) means to prevent any possibility of a plurality of rights of priority must be in place.<sup>69</sup> Hence, the language of Article 4(C)(4) contemplates only two applications filed in the same country, no intermediate applications and fulfillment of the first-filed foreign application requirement as of the filing of the subsequent application.<sup>70</sup>

### 3. Interpreting Section 119(c) in view of Article 4(C)(4)

The text of Article 4(C)(4) is clear: the first-filed foreign application requirements must be met *before* the subsequent application is filed. Under VCLT Article 31, such a finding ends the interpretive inquiry because the interpretation is not absurd or manifestly unreasonable.

However, this interpretation is supported by the patent statutes governing the right of priority in the IP5. Of the five member countries of the IP5, all but the United States understands that the first-filed foreign application requirements must be met before the subsequent application is filed. The condition that the first-filed application requirement be met before the subsequent application is filed is written into the patent law of the EPC,<sup>71</sup> while the relevant provisions of the patent statutes of Korea and China refer back to the Paris Convention,<sup>72</sup> which,

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<sup>68</sup> *Id.*

<sup>69</sup> *Id.* at 337.

<sup>70</sup> Although the drafters likely did not mean to include serially transforming a subsequent application into an original or first application, the accepted text of Article 4(C)(4) does not preclude such a practice because the subsequent application takes on the characteristics of the first application if all the requirements of Article 4(C)(4) are met.

<sup>71</sup> See European Patent Convention, *supra* note 3.

<sup>72</sup> See Korean Patent Act, Act. No. 14112, Mar. 29, 2016, art. 54 (S. Kor.), *translated in* Korea Legislation Research Institute online database, [http://elaw.klri.re.kr/eng\\_service/lawView.do?hseq=38488&lang=ENG](http://elaw.klri.re.kr/eng_service/lawView.do?hseq=38488&lang=ENG); Patent Law of the

as discussed *supra*,<sup>73</sup> contains explicit language to that effect. The patent examination guidelines issued by the JPO adopt the language of Article 4(C)(4) in defining “first application.”<sup>74</sup>

This interpretation is also supported, under VCLT Article 32, by the *travaux preparatoires*, which make clear that the Article 4(C)(4) exception was meant to be limited to “worthy cases.” Because of a lack of clear Congressional intent that Section 119 create a broader exception to the right of priority than that established by the Paris Convention, the results of this analysis lead to the conclusion that, in order to be consistent with international obligations, Section 119 should be interpreted to require that the first-filed foreign application requirement be met *at the time of filing the subsequent application*.

One nuance, which arises with the inclusion in Section 119 of the words “any foreign application filed prior to such subsequent application,” militates in favor of an intermediate exception to a strict reading of Article 4(C)(4). Specifically, the reference to “any” in Section 119(c) suggests a fact pattern involving two or more earlier applications. In this scenario, the filing of the second application, if directed to the same invention as the first application, implicates the narrow interpretation of Section 119 because the filing of the second application while the first application is still pending invalidates any eventual priority claim to the second application under the narrow interpretation. The reference in Section 119(c) to “any” prior application suggests that this miscue could, under Section 119(c), be rectified under United States law by fulfilling the first-filed foreign application requirement with respect to both the first and second applications prior to filing the subsequent application that will ultimately serve as the priority application.

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People’s Republic of China (promulgated by the Standing Comm. Nat’l People’s Cong., Dec. 27, 2008), art. 29, [http://english.sipo.gov.cn/laws/lawsregulations/201101/t20110119\\_566244.html](http://english.sipo.gov.cn/laws/lawsregulations/201101/t20110119_566244.html).

<sup>73</sup> *Supra* page 28.

<sup>74</sup> EXAMINATION GUIDELINES FOR PATENT AND UTILITY MODEL IN JAPAN, PART V: PRIORITY 2 (Japan Patent Office 2015).

Thus, in keeping with international law, Section 119(c) should be construed to require that a subsequent application is properly transformed into a first application if the conditions of the first-filed foreign application requirement are met as of the filing date of the subsequent application, with the caveat, necessitated by the language of Section 119(c), that a subsequent application is so transformed despite there being more than one prior application, the filing of which would otherwise nullify a priority claim based on the subsequent application.

In view of this interpretation, there remain the questions of whether such an outcome is desirable from a policy perspective and how to assess whether the first-filed foreign application requirement has been timely met. The paper takes up these questions in the following sections.

#### IV. Policy Considerations

A policy analysis of Section 119(c) is best discussed with reference to the two most plausible interpretations of the section: the broad interpretation and the narrow interpretation. When the first-filed foreign application requirement must be met as of the filing date of the application claiming priority to the subsequent application, Section 119(c) is being construed according to the broad interpretation. Conversely, when the first-filed foreign application requirement must be met as of the filing date of the subsequent application, Section 119(c) is being construed according to the narrow interpretation. The first view represents a broader exception to the international right of priority, while the second view represents a narrower exception to the international right of priority.

##### A. A Broad Exception

A broad exception to the international right of priority represents a more permissive attitude to patenting because it gives applicants more leeway in how to develop their patent estates. For example, it lets applicants decide when their invention is ready for patenting by

removing obstacles to filing serial priority applications spanning a period of greater than twelve months. This may allow applicants to realize some additional value from their patent applications. Harhoff finds that the value of having a pending patent application (as opposed to a granted patent) is substantial and suggests that deferring patent examination increases the private value of pending and granted applications.<sup>75</sup> It is reasonable to hypothesize that the value of a pending priority application would be even greater than a regular application because of an applicant's ability to update or otherwise amend a priority application before filing a non-provisional application. Harhoff's observations are also consistent with the business practice of many firms that re-file a priority application on or after the one-year anniversary of its filing. Thus, allowing a broad interpretation of Section 119(c) may allow firms to realize additional value from their patent portfolio.

Because a broad exception to Section 119 is more permissive, such an interpretation is unlikely to rankle other treaty members whose nationals enjoy the more lenient standard. However, this does not erase the fact that a broad interpretation of Section 119(c) is not in line with the United States' international obligations. Down the road, such deviations can become fodder for an adversary in a negotiation seeking an advantageous bargaining position and create or contribute to a perception of the United States as an untrustworthy partner.

In the past, courts have attempted to provide symmetry between Section 119 and Section 120.<sup>76</sup> Although a broad exception to Section 119 by no means harmonizes Section 119 with Section 120, it does bring Section 119 closer to Section 120, which does not have similar requirements. While there is always pressure to preserve the internal consistency of a statute, the inescapable fact remains that Sections 119 and 120 are distinct provisions. The current text of

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<sup>75</sup> Dietmar Harhoff, *et al.*, *Deferred Patent Examination 3* (March 18-19, 2016) (unpublished manuscript) (on file with CESifo).

<sup>76</sup> *In re Gosteli*, 872 F.2d at 1011; *Kawai*, 480 F.2d at 887,889.

each section precludes the possibility of making the sections entirely commensurate with one another.

Thus, a broad exception to Section 119 comports with the practice of firms today and economic indicators that suggest a substantial gain can be realized by delaying prosecution of a filed patent application. It is also consistent with judicial precedent which seeks to bring the meanings of Sections 119 and 120 closer together.

#### B. A Narrow Exception

United States patent law, unlike trade secret law, does not typically reward inventors who delay patenting once their inventions are ready for filing.<sup>77</sup> This confines inventors to the statutory patent term and encourages early disclosure of inventions, which is a crucial part of the bargain the patent system strikes with patent applicants on behalf of the public.

The law's preference for patenting is also consistent with the mandate expressed in the Intellectual Property Clause of the United States Constitution. Specifically, it is difficult to see how serial filing of priority applications for the same invention "promote[s] the progress of science and the useful arts."<sup>78</sup> As a business tactic, such a strategy may yield private benefits, but it is not clear whether or even how the public would benefit from allowing the creation of several concurrent rights of priority for the same invention. After all, the public does not realize its end of the patent bargain until an invention becomes public, typically eighteen months from

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<sup>77</sup> See, for example, 35 U.S.C. §102 (2002)(current version at 35 U.S.C. § 102 (2012)(awarding patent in an interference to inventor who did not abandon, suppress or conceal the invention); *Pennock v. Dialogue*, 27 U.S. 1, 23-24 (1829)(invalidating inventor's patent under public use exception when the inventor allowed the patented invention to go into public use or to be publically sold prior to applying for a patent); *Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc.*, 855 F.3d 1356, 1367, 1371 (Fed. Cir. 2017)(holding patent invalid under the on-sale bar of pre-AIA 35 U.S.C. § 102(b) and AIA 35 U.S.C. § 102(a)(1) when patentee sold the claimed invention in a public sale prior to applying for a patent); *Peeler v. Miller*, 535 F.2d 647, 655 (C.C.P.A. 1976)(awarding patent in an interference to second party to invent on the grounds that the first to invent suppressed the invention).

<sup>78</sup> U.S. Const. art. 1, § 8, cl. 8.

the earliest *claimed* priority date. Many priority applications that are unclaimed, therefore, are also undisclosed.

Prohibiting multiple priority rights, as under a narrow interpretation of Section 119(c), also reduces the cache of “hidden claims” – claims which have the potential to mature into a patent right, but are not available to the public. Hidden claims contribute to uncertainty in the patent system, reduce effective notice and increase clearance costs.<sup>79</sup> They are, therefore, a drag on the vibrancy of the patent system.

Allowing inventors to make use of rolling priority applications undermines the boundaries traditionally drawn between the trade secret and patent regimes, is inconsistent with the Intellectual Property Clause of the Constitution and increases the transaction costs associated with the patent system. A narrow reading of Section 119(c) therefore provides coherency and unity between Section 119(c) and decisions affecting the public use and on-sale bars of 35 U.S.C. § 102, the Constitution and economic policy.

Because a narrow reading of the exception in Section 119(c) comports with Congressional and judicial policy, our international obligations and economic principles, Section 119(c) should be read narrowly. That is to say, Section 119(c) should be read to require that the first filed foreign application (and any intermediate foreign applications) be withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding *as of the filing of the subsequent application*.

## V. Strategic Considerations

From a practitioner’s standpoint, it is important to understand the metes and bounds of Article 4(C)(4) and its implementing legislation around the globe in order to advise clients

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<sup>79</sup> JAMES BESSEN & MICHAEL J. MEURER, PATENT FAILURE: HOW JUDGES, BUREAUCRATS, AND LAWYERS PUT INNOVATORS AT RISK 62-63 (Princeton University Press 2008).

interested in global protection how best to preserve their rights under international law. A conservative strategist would advise a client to align its behavior with the strictest jurisdiction. It seems likely that the EPO would be a suitable candidate for the strictest jurisdiction. Not only does its implementing legislation track closely the text of Article 4(C)(4), but the EPO's mandate comes from a special agreement governed by Article 19 of the Paris Convention, binding the EPO not to contravene the Paris Convention.<sup>80</sup> Therefore, a conservative counselor would advise a client to meet the first-filed foreign application requirement as of the filing of the subsequent application.

It is equally important to understand just how permissive Section 119(c) is in relation to a strict interpretation of Article 4(C)(4) in order to identify whether a particular filing strategy implicates Section 119(c). For example, Section 119(c) affects not only applications claiming foreign priority, but also international applications entering the United States under section 365(a), which refers back to Section 119.<sup>81</sup>

Another potential Section 119(c)/Article 4(C)(4) landmine arises in assessing when an application no longer has rights outstanding, an issue brought into relief by PCT Rule 26bis.3, which permits member states to provide a two-month period during which a lapsed priority claim can be restored if the delay in presenting the claim occurred despite due care having been taken, was unintentional or both.<sup>82</sup> Although this rule has not been universally adopted,<sup>83</sup> there are

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<sup>80</sup> Paris Convention art. 19, *supra* note 2.

<sup>81</sup> It bears mentioning that the constraints of Section 119 can be bypassed altogether in the United States if the intended priority application is a national application: an applicant seeking a right of priority based on a first application filed domestically can file a direct national application under Section 120 or enter the United States national stage under 35 U.S.C. § 365(c), and thereby avoid the first-filed foreign application requirements of Section 119(c) altogether.

<sup>82</sup> Patent Cooperation Treaty Rule 26bis.3, *supra* note 6.

<sup>83</sup> *See*, for example, Korean Patent Act, *supra* note 47.

corollary national rules in at least some key jurisdictions.<sup>84</sup> Further complicating the issue is that the status (*e.g.*, as withdrawn, abandoned or refused) of a priority application is governed by the domestic law of the state in which the priority application was filed, but the ability to revive a delayed priority claim is governed by the domestic law of the state in which the regular application is to be filed, which can be, and often is, different from the priority state. In the United States, for example, a non-provisional United States application can be revived after it is abandoned, making its status under Article 4(C)(4) a matter of national law.<sup>85</sup> In comparison, the right of priority associated with a foreign priority application can be restored for up to two months under United States law after the priority period expires regardless of the status of the priority application in its state of filing.<sup>86</sup>

In the United States, whether priority rights can attach in these situations, leaving rights in the application outstanding, turns on whether or not the delay in filing a subsequent application or responding to the Office was unintentional. The Manual of Patent Examining Procedure (MPEP) states, “A delay resulting from a deliberately chosen course of action on the part of the applicant is not an ‘unintentional’ delay.”<sup>87</sup> Under this standard, the decision to allow an application to expire or to go abandoned without asserting a priority claim based on the application should be sufficient to extinguish any outstanding rights in the application because an intentional decision is not unintentional.

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<sup>84</sup> 37 C.F.R. § 1.55 (2015); GUIDE FOR APPLICANTS: PCT PROCEDURE BEFORE THE EPO (EURO-PCT GUIDE) points 135, 644-45 (European Patent Office 2018).

<sup>85</sup> See 37 C.F.R. § 1.137 (2015) (providing for revival on the basis of unintentional delay).

<sup>86</sup> See 35 U.S.C. § 119, *supra* note 1, and 37 C.F.R. § 1.55 (2015) (providing for restoration of the right of priority under 35 U.S.C. §§ 119(a)-(d) and (f) and 365(a)-(b) on the basis of unintentional delay).

<sup>87</sup> MANUAL OF PATENT EXAMINING PROCEDURE § 711.01 (9th ed., United States Patent & Trademark Office, rev. 2015).

The intention to extinguish all outstanding rights in a prior application can be made explicit by requesting express abandonment of an application under 37 C.F.R. § 1.138.<sup>88</sup> Under the intent standard, the mere act of requesting abandonment is sufficient to extinguish outstanding rights because the intentional decision is memorialized in the request for abandonment. Official notice of abandonment is, therefore, needless.

The EPO, on the other hand, has adopted a due care standard for reviving a delayed priority claim.<sup>89</sup> Under the due care standard, a patentee, applicant or representative must exercise the reasonable care of the notional reasonably competent patentee, applicant or representative. Typically, a petitioner asserting an error under the due care standard must show “exceptional circumstances” or “an isolated mistake within a normally satisfactory monitoring system.”<sup>90</sup> Because intent is not a direct element of a due care inquiry, a United States provisional application, for example, might be deemed to have rights outstanding for up to two months after it has expired under United States law, even if the decision to allow it to expire was intentional. This is so because the United States provisional application is capable, in theory, of being revived and maturing into a valid patent right in a PCT member jurisdiction, such as Europe, that has implemented the due care standard of PCT Rule 26*bis*.3. Thus, some have counselled expressly abandoning all priority applications prior to refiling, and even including language such as that found in the Manual of Patent Practice for the United Kingdom, which suggests an applicant make an explicit statement in a request for withdrawal to the effect that the withdrawal leaves no rights outstanding.<sup>91,92</sup>

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<sup>88</sup> 37 C.F.R. § 1.138 (2015).

<sup>89</sup> EURO-PCT GUIDE points 135, 644-45, *supra* note 79.

<sup>90</sup> GUIDELINES FOR EXAMINATION Part E, Ch. VIII § 3.2 (European Patent Office 2017).

<sup>91</sup> Terri Shieh-Newton and Matthew Show, Pitfalls When Refiling a Priority Application under Article 4 of the Paris Convention, MINTZ LEVIN, Jun. 30, 2016, <https://www.globalipmatters.com/2016/06/30/pitfalls-when-refiling-a-priority-application-under-article-4-of-the-paris-convention>.

<sup>92</sup> MANUAL OF PATENT PRACTICE § 5.28.3 (UK Intellectual Property Office 2014).

It would be expected that an applicant's use of due care in allowing a provisional application to expire before refiling in order to pursue a filing strategy consistent with Article 4(C)(4) would preclude an eventual finding that the lapse occurred in spite of due care, as would be required for there to be rights outstanding in the provisional application. Nonetheless, express abandonment removes any ambiguity and makes the decision explicit. Unlike under an intent standard, however, official recognition of abandonment is of paramount importance under a due care standard because it is the status of the application as withdrawn, abandoned or refused with no rights outstanding that extinguishes any outstanding rights, including the right to subsequently request erroneous withdrawal.

The United States petitioner seeking abandonment is left in an uncomfortable limbo in a due care standard jurisdiction because a petition for express abandonment under 37 C.F.R. § 1.138 becomes effective only when an appropriate official of the USPTO formally recognizes the petition.<sup>93</sup> The date of abandonment is the date the USPTO recognizes the petition or a later date, if specified in the petition.<sup>94</sup> Accordingly, a United States petitioner must wait a variable and unpredictable amount of time for validation of abandonment. The lack of a mechanism whereby a United States petitioner can definitively and with immediate effect disclaim its priority right creates a fair amount of uncertainty for practitioners pursuing a filing strategy that implicates Article 4(C)(4), particularly when the strategy is time sensitive.

Despite the disparate treatment of delayed priority claims condoned by the PCT rules and followed internationally, as regards United States priority applications, it is unlikely that the condition that there be no rights outstanding would create a hidden obstacle to applicants because an applicant's intent or reasonable efforts to irrevocably abandon its rights should suffice to

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<sup>93</sup> See MANUAL OF PATENT EXAMINING PROCEDURE, *supra* note 82, § 711.01.

<sup>94</sup> *Id.*

extinguish any outstanding rights under Article 4(C)(4). Nonetheless, a practice of expressly abandoning United States applications is likely to eradicate what small risks do exist in this regard.

From a patent practitioner's standpoint, it is important to consider the Article 4(C)(4) landscape from a global perspective, keeping in mind that the right of priority can be lost altogether in foreign jurisdictions by running afoul of Article 4(C)(4). At the same time, many details of Article 4(C)(4) are governed by domestic law. It is thus necessary to consider whether expansive domestic interpretations of Article 4(C)(4) provide a remedy for an Article 4(C)(4) problem and how domestic laws affect the legal status of an application.

## VI. Conclusion

The delegates drafted Article 4(C)(4) to provide a sanctioned pathway for a practice of refiling priority applications that was already occurring in secret. The amendment to Article 4 was a reaction to reality, but still chafed against the long-held view that applicants should not be able to manipulate the patent system to extend their priority year. During debate leading to Article 4(C)(4), the French delegation stated that if an inventor has made a false start with a first application, he will know the moment he files his subsequent application. It followed, for the French delegation, that such an inventor could, under these circumstances, trade in the old, erred application for a new, corrected application. Unfortunately, many inventors (or their representatives) do not appreciate the technicalities of Article 4(C)(4) and inadvertently run afoul of the provision even when they represent the "meritorious" case envisioned by the French delegation.

Now, we recognize that that there are rational business reasons for applicants to extend the priority periods attached to certain inventions, and that not every decision to file serial

priority applications is nefarious, as the French delegation argued. For United States practitioners, the necessity to abandon or withdraw an application before filing a subsequent application related to the same subject matter is simply bizarre, as United States law typically requires copendency between a first and subsequent application in order for priority to attach, and maintains a domestic right of priority devoid of similar requirements. Today, the whole debate seems a bit antiquated.

Nonetheless, viewed through a policy lens, a narrow interpretation of Section 119 is not only warranted but consistent with the doctrines and philosophy underlying our patent system. Accordingly, courts should take care to rigorously apply Section 119(c) and thereby harmonize national law with the international priority rules.