

The right of priority part 1

The transfer of the right of priority

Priority is one of the fundamental institutions of industrial property law. We distinguish between the ordinary priority resulting from a proper application for the protection of an invention, industrial design or utility model in the Patent Office of the Republic of Poland (PPO) and the Convention priority — arising from an application filed in another country of the Paris Union or parties to other international agreements. **The novelty of the invention, being one of the conditions for patentability, is assessed for the priority date.** Thus, everything that enters the state of the art in the period following that date, but before the decision granting a patent is issued, will no longer be relevant to the assessment of novelty. **The statement that patent law is therefore governed by the principle of "first come, first served" is certainly justified, but it is by no means enough.** Although much has already been said and written about priority, in everyday practice we often encounter situations in which the issue of who is entitled to priority and what conditions must be met in order to effectively claim it turns out to be fraught with legal complexities. We present to you a series of articles in which we look at the issue of priority from the perspective of these non-obvious, yet significant problems that may arise with respect to this institution.

First of all, we present some reflections on the issue of the transfer of priority rights, and in particular: is it possible to make a retroactive transfer?

The retroactive transfer of the right of priority

Let us imagine a hypothetical situation: entity X correctly filed a patent application for an invention in a state belonging to the Paris Union in December 2022. In November 2023, entity Y files an application for the same invention with the Polish Patent Office, claiming priority based on the application filed earlier by X. Y claims to be a legal successor of X. The admissibility of claiming priority by a successor in title should not come as a surprise: the right of priority itself is transferable and inheritable (see the judgment of the Regional Administrative Court in Warsaw of 30 June 2006, no. VI SA/Wa 2317/05). At the time of filing the application, Y does not submit a document certifying the transfer — it submits it two months later but the document indicates that the assignment took place in January 2024. Could Y therefore effectively claim priority? If so, the relevant moment for the examination of the state of the art would be December 2022; if not — November 2023. It could turn out that in the latter state of the art it will not be possible to prove novelty, and therefore the PPO will refuse to grant a patent. So how should we assess the possibility of such a retroactive transfer? In this article, we will show that it should be firmly rejected. We will start by answering why the recently handed and broadly discussed decision of the Enlarged Board of Appeal of the European Patent Office (EPO) in joint cases [G 1/22 and G 2/22](#), although liberalizing the requirements for the claiming of the right of priority, does not provide arguments in support of the recognition of the admissibility of a retroactive transfer.

The EPO's new approach: the decision in joint cases G 1/22 and G 2/22

We have previously written about patent disputes concerning CRISPR gene editing technology pending before the EPO, which revolved around the problem of the lack of identity of the applicants from the first and subsequent applications. In our [article from March 2020](#), we presented an analysis of the Board of Appeal decision T 844/18 issued on 16 January 2020, which confirmed the invalidation of patent EP 2771468 for CRISPR technology. The patent holder was Broad University. The PCT application claimed priority from 12 previous applications previously filed by this entity before the patent office in the United States. Two of them indicated Prof. L. Maraffini from Rockefeller University in New York among the inventors, but in the subsequent ones — he was omitted. At the same time, Maraffini did not transfer his rights of priority to Broad University but to Rockefeller University, to which he was affiliated. The lack of effective transfer of the right to Broad University resulted in the invalidity of the priority claim and, consequently, the invalidity of the patent.

Cases G 1/22 and G 2/22 concerned patent EP 2784162, also held by Broad University and protecting CRISPR technology, which was related to the previously invalidated patent EP 2771468. The legal problem was essentially the same: if the subsequent application was not filed by all the applicants of the original one, could the priority claim be upheld? The earlier decision established the standard referred to as “the same applicant” or “all applicants” approach – according to which, although additional persons may be named in the subsequent application, the application must necessarily include the names of all those who

filed the original application or their successors in title. Decisions of the EPO Enlarged Board of Appeal G 1/22 and G 2/22, by departing from this restrictive approach, enabled the successful defence of patent EP 2784162, which thus has not shared the fate of its parent.

The most important aspect of the decision G 1/22 and G 2/22 was the establishment of a strong rebuttable presumption that the entity filing the European application is entitled to claim priority. The burden of proof is therefore shifted from the applicant/patent holder to the persons wishing to challenge the patent/application. This presumption has prevented the invalidation of the patent in the joint cases: the Board of Appeal declared that the evidence submitted by the opponent during the proceedings was not sufficient to rebut the presumption of the applicant's right to priority.

The Board of Appeal also expressly confirmed that this presumption will apply in situations where a European patent application derives from a previous PCT application and/or where the original applicants are not identical to the later applicants. As we can read in the decision: "in a situation where a PCT application is jointly filed by parties A and B, (i) designating party A for one or more designated States and party B for one or more other designated States, and (ii) claiming priority from an earlier patent application designating party A as the applicant, the joint filing implies an agreement between parties A and B allowing party B to rely on the priority, unless there are substantial factual indications to the contrary".

What follows from G 1/22 and G 2/22?

Persons filing an opposition before the EPO will now face a more difficult task: they cannot rely on purely speculative claims of the lack of right of priority. **They must prove the existence of specific facts that raise serious doubts as to the applicant's right to claim the priority.** This will often not be possible without gaining access to internal, confidential documents of the applicant/patent holder. It would not be an exaggeration to say that we are dealing with a major breakthrough here: the EPO's new approach is much more favourable for applicants and patent-holders. However, the question arises: how far-reaching a relaxation of the conditions for claiming the right of priority we are dealing with?

It is worth noting that this change of approach is reflected in the new version of the [EPO Guidelines for Examination](#). In the general remarks on the right of priority (Part A Chapter III 6.1), the previous reference to the time within which the transfer of the right should take place (i.e. before the European filing date) has disappeared. Instead, we read that "[\[The European Patent Convention\]](#) does not set out any formal requirements for the transfer of the priority right" — which is accompanied by a reference to G 1/22 and G 2/22. Still it is underscored that if the earlier application was filed by multiple applicants, all of them or their legal successors must be indicated in the European application. At this point, the rebuttable presumption that applicants are entitled to claim priority is invoked, along with the resulting reversal of the burden of proof. Time will tell how the decision in the joint cases G 1/22 and G 2/22 will affect the resolution of similar cases by national patent offices. However, it should be remembered that, in the first place, when examining the existence of a right of priority, they will base their decisions on the applicable national law.

Moreover, if we carefully examine the content of the decision G 1/22 and G 2/22, we will certainly not find any strong arguments in support of the admissibility of the retroactive transfer. As we can read in the reasons of the decision, in accordance with the case-law of the EPO Boards of Appeal (e.g., T 1201/14 point 3.1.2), it is national law that applies to the assessment of the effectiveness of the succession in title

addressed in Art. 87(1) of the European Patent Convention (para. 62). At the same time, **it is strongly emphasised that on the basis of the EPC we can identify an autonomous requirement that the transfer of the right of priority has to have been concluded before the filing of the subsequent European patent application (para. 68).**

Polish law: the granting of priority will be refused if the applicant is not entitled to priority

As has been clearly indicated above, the relevant national law is the primary reference for assessing whether a given entity could effectively claim priority. In our hypothetical scenario, where there is no European application, the PPO could draw inspiration from the decisions in cases G 1/22 and G 2/22 to a limited extent only. It could not relax the requirements on which the effectiveness of the priority claim depends more than the relevant provisions of applicable national law allow it to do.

Who can benefit from priority under the provisions of Polish law? The answer is simple: either the applicant (the person filing the first application) **or their successor in title.** The provisions of the Act of 30 June 2000 - Industrial Property Law (hereinafter: IPL) refer in that respect to the relevant international agreements. Convention priority is derived from [the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967, and as amended on September 28, 1979 \(hereinafter: the Paris Convention\).](#)

Pursuant to Art. 4A of the Paris Convention, **any person who has duly filed an application** for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, **or his successor in title**, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

In our hypothetical scenario (although inspired by a real case), Y at the time they claimed priority was neither the applicant nor their legal successor. In our opinion, this circumstance should unequivocally resolve the matter. Y did not fall within the subjective scope of application of Article 4A of the Paris Convention. **The logical conclusion is that if we become a successor LATER, after the period of priority has elapsed and after filing another application, then we are not one of the entities that can benefit from priority during that period.** This is confirmed by [G.H.C. Bodenhausen's commentary](#) on Article 4A of the Paris Convention, in which we read: "the conditions as to the competence of persons to claim the right of priority under the Convention must be fulfilled both at the time of the application on which the right of priority is based and at the time when the right is invoked, but not necessarily during the whole period of priority".

Furthermore, it is necessary to point out Art. 48 point 1 of the IPL: **The Patent Office shall issue a decision refusing to grant prior priority in whole or in part if it finds that the applicant is not entitled to claim the priority.** As indicated by P. Kostański and G. Jyż in their commentary to the IPL edited by J. Sieńczyło-Chlabicz, "refusal to grant the right of priority occurs when the applicant is not entitled to the priority; therefore, the exhibition or convention priority has not been created for his benefit or acquired by him".

"Has not been acquired by him" should of course not be identified with "will not be acquired by him in the future". **The PPO will therefore refuse to grant us priority if we are not successors on the date of application.**

It should be noted that the claiming of priority is subject to certain formal requirements. Under Art. 35 para. 6, **an applicant who has acquired the right to claim priority derived from an application or exhibition of an invention made by another person should, within three months from the date of filing the invention, submit a declaration of the basis for claiming the priority.** If the PPO finds a deficiency in this respect, then, under penalty of refusing to grant priority, it shall order to supplement the application within a specified period (para. 5). This solution is a reflection of Art. 4E of the Paris Convention, which specifies a standard for the formal requirements that countries may put in place with respect to the declaration of priority. The 3 months from the date of filing indicated by the lawmaker, within which a declaration of the basis for claiming the priority may be submitted (extended by the period specified by the PPO) should in no way be treated as an additional time window in which the right of priority may still be acquired. It is rather a purely technical solution for the convenience of applicants, compatible with the Paris Convention. It is worth noting that the same period is provided for the submission of a translation of a proof of priority.

In the commentary by Bodenhausen, we can come across a criticism of the original text of the Paris Convention of 1883, which did not address the issue of when or how priority could be claimed: the author describes this as unsatisfactory since national legislators could then allow priority to be claimed at a late stage, e.g., during invalidity proceedings before a court. Bodenhausen condemns situations in which the right of priority could be invoked all of a sudden during the dispute, thus surprising third parties who could not have known of its existence. The Convention therefore specifies now the required formalities for the declaration of priority in order to minimize this risk.

Poland, as a party to the Paris Convention, is obliged to comply with international law that is binding on it (Article 9 of the Constitution of the Republic of Poland). Therefore, the relevant national regulations concerning the right of priority should be interpreted in accordance with the Convention, in particular in light of the purposes that the institution of priority is supposed to serve. It should be noted that **the admissibility of the retroactive transfer of the right of priority could not be reconciled with such values as legal certainty and stability of legal transactions**, to which the cited commentary refers.

Conclusion

The EPO decision in joint cases G 1/22 and G 2/22 should not be treated as an all-out liberalization of the requirements for claiming priority when the persons indicated in the original application differ from those in the subsequent application. The requirement that the transfer must be made before the successor claims priority remains valid. Above all, however, national regulations are the basic point of reference for assessing the effectiveness of the claiming of priority. Polish law unequivocally obliges the PPO to refuse to grant prior priority if it finds that the applicant is not entitled to it. The persons entitled are indicated by the Paris Convention, to which the IPL refers: it will be either the applicant or their successor in title. According to the maxim *Clara non sunt interpretanda*, clear is not subject to interpretation. However, even if it were to be assumed that there is any shadow of a doubt here, leaving room for legal interpretation, the values of legal certainty and stability of legal transactions categorically oppose allowing the retroactive transfer.