The right of priority part 2
Cross-IP priority claims

In the second part of our mini-series on the right of priority in obtaining a patent, we address the issue of the cross-IP priority claims. Let us recall that priority is one of the fundamental institutions of industrial property law. The priority date refers to the date on which a valid application for the protection of an invention, industrial design, or utility model was filed with the Polish Patent Office (ordinary priority) or in another state-party to the Paris Union or other international agreements (the Convention priority). **The novelty of an invention, being one of the key conditions for patentability, is assessed against the prior art as of the invention's priority date.** Thus, anything that enters the state of the art after this date but before the decision on granting the protection is issued is irrelevant for assessing novelty.

But what happens if, in country X we file an application for an invention, and in country Y we treat the same solution as an industrial design? Or if, when filing an industrial design application in country B, we claim priority derived from a utility model application in country A? It turns out that under current national and international regulations, it is not entirely clear how to treat such **cross-IP priority claims**.

Priority period

To effectively claim the convention priority, one has to meet several conditions:

1) A correct application filed with the Polish Patent Office (PPO) by an entity exercising the convention rights;
2) A valid earlier application;
3) A priority claim in the Polish application referencing the earlier filing;
4) Identity of the subject matter of both applications (see A. Sztoldman in the commentary to the Industrial Property Law Act of June 30, 2000, edited by S. Żelechowski, 2022).

As a starting point, it should be noted that **the period during which we can effectively claim the convention priority varies depending on the type of application in question**. Pursuant to Art. 14 of the Industrial Property Law, priority to obtain a patent, a right of protection, or a right in registration is granted in the Republic of Poland, under the terms specified in international agreements, based on the date of the first valid application for an invention, utility model, or industrial design in the indicated country, if, from that date, the application is filed with the Patent Office within the following period:

1) **12 months** - in the case of applications for inventions and utility models;
2) **6 months** - in the case of industrial design applications.

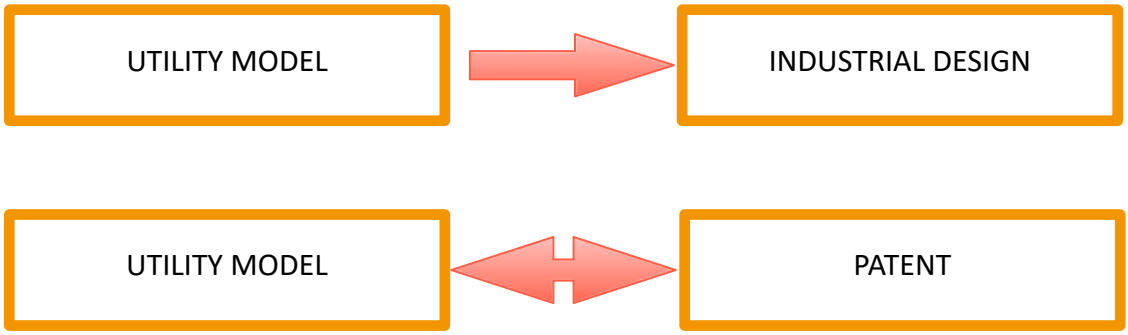
Those deadlines that cannot be reinstated. After their expiry, the exercise of the convention priority is no longer possible.

The cited provision also precisely reflects the solution provided for in Ar. 4e of 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. **It is the Paris Convention that the convention priority primarily derives from, and its provisions, given that Poland is a party to it, are our main point of reference regarding the possibility of claiming priority and its effectiveness in the national legal system.** It should be emphasized, however, that although when speaking of convention priority, we will, unless otherwise stated, refer to priority derived from the Paris Convention, other potential sources of convention priority are also possible: the International Patent Cooperation Treaty of 1970 and the Convention on the Grant of European Patents of 1973.

Cross-IP priority claims under the Paris Convention

The cross-IP priority claims are addressed by Art. 4e of the Paris Convention — however, only partially. Namely, the Convention provides that where an industrial design is filed in a country by virtue of a right of priority based on the filing of a utility model, the period of priority shall be the same as that fixed for industrial designs. (Section 1). Furthermore, it is permissible to file a utility model in a country by virtue of a right of priority based on the filing of a patent application, and vice versa (Section 2).

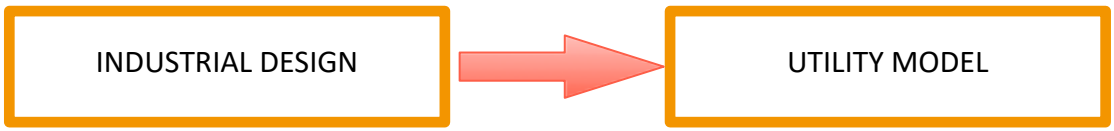
The Paris Convention therefore explicitly provides for the following scenarios:



The solution used in the Convention, which allows for the claiming of priority based on utility model application when filing an application for an invention or industrial design, is fully justified, taking into account that not all countries of the Paris Union provide for separate protection for utility models.

The scenarios of cross-IP priority claims not regulated by the Paris Convention

However, the question arises: what about scenarios not explicitly mentioned in the Convention? First, **can a utility model application benefit from the priority based on the earlier filing of an industrial design?** The literature suggests that such a solution is permissible, of course, taking into account the specific nature of these applications and the obvious differences between them. **The condition is that the application concerns visible parts that have a functional purpose** (see A. Sztoldman in "Commentary to the Polish Industrial Property Law," edited by S. Żelechowski, 2022).



Of particular interest from the point of view of our practice, however, is another case: is it possible to claim the priority based on an earlier industrial design application when filing a patent application? The literature indicates the possibility of such cross-IP priority claims: as noted in the commentary to the Polish Industrial Property Law edited by J. Sieńczyło-Chlabicz, "the identity of applications may (...) sometimes also occur in the case of solutions that were filed as an invention and then as an industrial design, or first as an industrial design and then as an invention, and those that were filed as an industrial design and then as a utility model." To support this thesis, the authors of the commentary rightly point out that Art. 4a of the Paris Convention focuses on the identity of the subject matter of a given application, not the identity of the applications.

The priority period in the situation of cross-IP priority claims

How will we determine the period for exercising priority in the case of cross-IP priority claims? In the first scenario (first application: utility model, second application: industrial design), we come across a reference to the priority period for industrial designs, meaning it will be 6 months. The expert literature advances an argument that **this issue should be resolved by analogy, treating the priority period for the type of application in which the applicant is claiming priority as decisive.** Thus, for example, if a patent or utility model application is filed and the priority claim is based on an industrial design application, the priority period will be 12 months. If we are filing an industrial design application and the claim of priority is based on another type of application, the priority period will be 6 months.

What if an application is not filed on the basis of the Polish law?

This solution, as described above, is conditioned by the fact that under Polish law, the Paris Convention is treated as the primary source of convention priority. **However, if we are filing a different application, such as a PCT or European patent application, we must carefully examine how relevant instruments define their relationship to the Paris Convention.** This is a topic that cannot be exhaustively covered here—our goal is primarily to draw attention to the need for a separate examination of the applicable provisions and their relationship to the Paris Convention.

In the case of a PCT application filed under the PCT Treaty, we have a clear reference to the Paris Convention. Pursuant to Art. 8(1), the international application may contain a declaration, as prescribed in the Regulations, claiming the priority of one or more earlier applications filed in or for any country party to the Paris Convention. In principle, the conditions for, and the effect of, any such a priority claim shall be as provided in Art. 4 of the Stockholm Act of the Paris Convention (Art. 8(2)(a)).

Next, with regard to European patent applications, the situation is different. Art. 87 of the Convention on the Grant of European Patents provides that anyone who has duly filed, in or for (a) any state party to the Paris Convention or (b) any member of the World Trade Organization, an application for a patent, a utility model or a utility certificate, or his successor in title, shall enjoy, for the purpose of filing a European patent application in respect of the same invention, a right of priority during a period of twelve months from the date of filing of the first application. This solution is modeled on the Paris Convention, although we cannot equate them. The European Patent Organization (EPO) is not a party to the Paris Convention, so we will not be able to apply its provisions directly to European applications. This is a comprehensive and autonomous legal framework, although decisions of the EPO Board of Appeal indicate the need to interpret Eu-

ropean priority in accordance with Art. 4 of the Paris Convention (see, e.g., decision of the Enlarged Board of Appeal G 2/98 of 31 May 2001).

The cross-IP priority claims from the perspective of the Court of Justice of the European Union

The matter of the cross-IP priority claims has been raised in the case-law of the Court of Justice of the EU (CJEU) which, in the case of *Kaikai Company*, had to assess whether priority based on a PCT application could be validly claimed for a Community design application filed before the EUIPO.

In that case the relevant legal basis was Art. 41 of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs that constitutes a separate legal framework governing priority for Community designs. Under para. 1, a person who has duly filed an application for a design right or for a utility model in or for any State party to the Paris Convention for the Protection of Industrial Property, or to the Agreement establishing the World Trade Organisation, or his successors in title, shall enjoy, for the purpose of filing an application for a registered Community design in respect of the same design or utility model, a right of priority of six months from the date of filing of the first application. The following paragraph of that provision specifies that every filing that is equivalent to a regular national filing under the national law of the state where it was made or under bilateral or multilateral agreements shall be recognised as giving rise to a right of priority.

The provision sets a six-month time limit for claiming priority. However, the applicant argued that this contains a loophole that could be filled by applying Art. 4 of the Paris Convention, which would give them 12 months to claim priority (the first application was a patent application). Although the EU General Court agreed with this at first instance, the Court of Justice, hearing the EUIPO's appeal, reached a different conclusion (judgment of the Grand Chamber of 27 February 2024, C 2024/172). It found that although the legal framework governing the right of priority under the EU regulation is entirely autonomous, the fact that the EU is a member of the WTO imposes an obligation to interpret it in accordance with the Paris Convention. However, it found that "Article 4 of the Paris Convention does not allow priority to be claimed in respect of an earlier patent application when filing a subsequent design application, and therefore, a fortiori, does not lay down any rules on the time period prescribed to the applicant to that end. Thus, only an international application filed under the PCT relating to a utility model can give rise to a right of priority for a design application by virtue of that Article 4, within the period of six months ."

Interestingly, **the CJEU thus clearly ruled against an expansive interpretation of Art. 4e of the Convention itself:** “while Article 4(E) of the Paris Convention accepts that a given subject can sometimes enjoy more than one form of protection, with the result that a right of priority can be relied upon for a form of protection other than that sought earlier, that provision exhaustively sets out, however, the situations in which that may occur”. The persuasive authority of the CJEU should not, of course, be ignored – it is highly likely that such a categorical opposition against the admissibility of cross-IP priority claims in scenarios other than those explicitly mentioned in Art. 4e will significantly impact the relevant practice in other countries. In Poland, the previously accepted method of filling gaps in the wording of Article 4e may also be questioned.

Summary

- The issue of cross-IP priority claims regarding the convention priority under the Paris Convention is only partially regulated by Art. 4e thereof.
- The Convention explicitly provides for the admissibility of (a) an industrial design application claiming priority based on a utility model application and (b) a patent application claiming priority based on a utility model application, and vice versa.
- Polish academic literature suggests that, by analogy, (a) a utility model application claiming priority based on an industrial design application and (b) a patent application claiming priority based on an industrial design application, and vice versa, should be accepted. It is not the identity of the applications that counts, but the identity of the subject matter of the applications. However, the recent CJEU judgment in the *Kaikai Company* case takes a different view, implying the exhaustive nature of Art. 4e.
- The period for priority in cases of cross-IP priority claims be determined based on the priority period envisioned for the type of application in which the applicant is claiming priority.