

Options in the Priority Year

Paris Convention

Under the Paris Convention, an inventor can file an initial patent application (a “priority application”) at his own country’s Patent Office and then - within one year - file patent applications in other countries based on that priority application. For example, a UK inventor could file his priority application at the UK Patent Office and then - within the next year - file patent applications in the US, Japan and Canada based on the UK priority application. This “priority year” provides a number of benefits, the most important of which are described below.

Further development time

The priority year allows time for the inventor to develop his invention further. This time can be used to obtain more experimental data to support the patent application or to refine more specifically the aspects of the invention that are likely to be the most commercially important and hence where the claims of the patent application should be directed. If further experimental data is produced, one or more further priority applications can be filed in the priority year, based on the text of the first priority application but including the additional new data.

Potential investors

For lone inventors and small companies, the priority year provides time to seek investment. Up to this time, the patenting expenses will probably have been limited to

the drafting and filing of the priority application. If further patent applications are envisaged, possibly in a number of foreign countries, financial support for this endeavour needs to be secured.

Need to publish

After the priority application has been filed, any public disclosure of the invention that is defined in the priority application will not prejudice the validity of any later patent applications, provided that the later patent applications relate to the same invention that was defined in the priority application.

Early search and examination

In some countries, it is possible to have the priority application searched and examined within the priority year. This can give the inventor (and potential investors) a useful early indication of whether or not patents are likely to be granted in due course in other countries – before the expense of filing numerous foreign patent applications is incurred. For example, the UK Patent Office can usually produce a Search and Examination Report on the merits of the invention within 3-6 months of the filing date of the priority application. Such Reports often highlight prior art of which the inventor was unaware; and the claims of any later applications can be amended to take this prior art into consideration.

The end of the priority year

At the end of the priority year, the final text to be used for any further patent applications has to be resolved. This text can include all available experimental data which supports the invention; and the description and claims can be tailored to take into account all prior art known to the inventor at that time. Once the final text is resolved and further patent applications are filed based on it, no new material can be added to it (although amendments can be made under specified circumstances). Any further patent applications should claim priority from all of the priority applications that were filed in the preceding year.

Further patent applications

The question then arises - where should further patent applications be filed? The inventor has the choice of an International (PCT) application, regional applications (such as a European patent application) and one or more national (that is, single-country) patent applications. The inventor should take into consideration where the main market for the invention is and the location of potential infringers. Costs should also be considered since Patent Attorney fees and Patent Office fees will be payable for each new patent application.

Further advice

If you would like any further advice please contact us at Dehns using the details below.

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