

PROTECTING PRIORITY RIGHTS TO AN INVENTION BY FILING AN INFORMAL PATENT APPLICATION

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With the rapid progression of state of the art technology and the fierce competition that companies developing such technologies are subject to, especially in hi-tech fields such as telecommunications, computer science and biotechnology, it becomes increasingly important for an innovative company to protect its rights to all inventions as quickly and effectively as possible, often as early as the conception of the invention itself. This haste to protect the invention is not however necessarily compatible with the time frame and the investment required in the preparation and the filing of a patent application which may ensure a reliable protection of the completed invention.

An interesting compromise can be to proceed with the rapid filing of an “informal” application which allows the establishment of priority rights on the subject matter described in the application whilst gaining a twelve (12) month delay for the preparation of a complete patent application that includes claims of appropriate scope, as well as elaborating a filing strategy adapted to the applicant’s needs. A certain caution must however be exercised in the preparation of an informal application in order to reap all its benefits without risking the loss of the rights to the invention.

1. Informal Patent Applications

With the changes to the Canadian *Patent Act* implemented October 1st, 1996, the conditions to be fulfilled in order to be granted a filing date for a patent application in Canada have become less restrictive. The submission of a description which, at first glance, appears to describe an invention is enough for this description to be received as constituting a patent

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application in Canada, and to be attributed a filing number. It is therefore possible through such a filing to express an intention of protecting the rights to any subject matter described in the informal patent application as filed. In applying this strategy, the informal application is not however destined to become a patent in and of itself; it simply constitutes a priority application on which are based priority rights claimed at the time of the subsequent filing of a patent application in proper and due form. The latter must be filed within a year of the filing of the priority application, and this, in all the countries where a patent for the invention in question is desired.

In the United States, there also exists a type of patent application, called a "provisional" patent application, essentially offering the same advantages as an informal application in Canada. It must be noted that regardless of the country where the priority application is filed, the priority rights that are obtained are international, i.e. valid for all the countries that are members of the Paris Convention where a regular patent application will subsequently be submitted claiming priority from the initial application.

2. International Priority Rights

Priority rights with regard to patents are derived from the *Paris Convention for the Protection of Industrial Property* dated March 20th, 1883 which the vast majority of industrialized countries worldwide have signed. This convention establishes that any person having regularly filed a patent application in one of the countries that is part of the Union will benefit, in order to carry out the filing in the other countries, from a priority right extending over a period of twelve (12) months following the date of the initial filing. The priority right will be valid regardless of the eventual outcome of the priority application; therefore, whether or not the patent issues or is abandoned is immaterial.

Even though the priority application and the subsequent applications must generally describe the "same invention", it is not necessary that the two descriptions have exactly the same content in order to be granted priority rights. In fact, the scope of the claims, or even the presence of claims in the priority application have little importance. Priority rights are based on a comparison between the claimed elements in the subsequent applications and the content of the entire priority application. In addition, in the United States, the expression "for the same invention" is generally interpreted as meaning that the priority application must answer the adequate disclosure criteria of an invention and of its preferred mode of embodiment as applicable to all the patent applications in the United States. As such, for the United States, it is important to describe in the priority application not only all the elements that will subsequently be claimed, but also to describe the

subject matter of the invention in order to allow its realization by a person skilled in the art.

The priority rights conferred by the Paris Convention essentially allow for any application, filed in a Convention country at the latest one year after the filing of a priority application, to have the same effect as if it had been filed on the priority date. Therefore, any document of prior art rendered public after the filing of the priority application will not be opposable to the patentability of the invention, even if this publication occurs prior to the filing of the subsequent application. This allows the applicant to publicly disclose the information contained in the priority application without exposing him/herself to a loss of rights. However, it is important not to disclose information that is not explicitly or implicitly included in the priority application, since this information does not benefit from the protection conceded in this priority application.

Moreover, in countries where patent rights are based on a “first filing” system (in force in most of the countries around the world including Canada), in the event of a conflict between two pending patent applications, the first person to file an application for a given invention is the person who will be granted the patent for this invention. The priority date may thus become crucial to the protection of the invention. As for the United States, they follow a “first inventor” system, i.e. in case of a conflict between two pending patent applications claiming the same object, the applicant who can prove the earliest date of invention will be granted a patent for the invention. The priority date is therefore not as determining as in a “first filing” system, but may nonetheless serve to effectively prove the earliest date of invention.

In conclusion, it appears that an informal description of the invention which constitutes the object of either informal or provisional applications, in order to be granted a priority date, is an effective way to reserve the rights to the invention. However, it is preferable to give as much information as possible in the priority application in such a way as to describe all aspects of the invention that may eventually be included in the claims. Also, particularly in the case where an American patent is eventually desired, it is preferable to include in the priority application enough details on the use of the invention to allow its realization by a person skilled in the art, upon reading the text of the priority application.

