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UNITED STATES PROVISIONAL PATENT APPLICATIONS AND PARIS CONVENTION PRIORITY RIGHTS -- "THE SAME EFFECT"

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I. INTRODUCTION

On June 8, 1995, patent practitioners began filing provisional patent applications under newly enacted United States legislation. n1 Prior to this legislation, the United States Congress considered adopting a "first-to-file" system. Such a system would provide a less expensive means for obtaining a filing date than the "first-to-invent" system currently used in the U.S. n2

Those concerned seemed happy with the new type of filing, except perhaps the United States Patent and Trademark Office (USPTO) mail room employees who were seeing a steady increase in the number of provisional applications filed each month. n3 this increase in provisional applications, which continued until late 1995, was due to practitioners becoming more accustomed to the provisional filing. After late 1995,

[*162] however, the number of provisional filings decreased dramatically. n4 So why the decrease in filings?

Simply stated, U.S. patent practitioners began to question whether a U.S. provisional application would be accepted by the world patent community as a valid Paris Convention document for establishing priority. n5 This article: (1) discusses the legislation implementing provisional applications; (2) compares the U.S. priority system to other countries' internal priority document systems; (3) reveals the origin of the uncertainty surrounding the provisional application occurring in late 1995; (4) analyzes the merits of this uncertainty; and (5) outlines the present and future status of provisional applications relative to Paris Convention priority rights.

II. THE UNITED STATES PROVISIONAL APPLICATION

Since every country in the world, except the United States and the Philippines, has a first-to-file patent regime, the *modus operandi* for the majority of the world's inventors is to file soon after the invention is conceived. n6 However, because the United States is based on a first-to-invent regime, domestic inventors have had a tendency to be more relaxed, sometimes filing years after the conception date of their invention. n7 This mentality has adversely affected most domestic applicants to such an extent that U.S. applicants are often forced into world cross-licensing schemes with foreign applicants who have patented the same invention in a country where the first-to-file regime is the norm. n8

In reaction to this mentality, and as a result of the Uruguay Round of the General Agreement on Tariffs and Trade (GATT), Congress

[*163] amended pertinent sections of Title 35 of the United States Code. n9 New section 111(b) implemented the United States' internal priority document system whereby an applicant can file a relatively inexpensive and informal application, a provisional application, to obtain a domestic filing date. n10 Under section 111(b), a provisional application must include: (1) a specification which meets the requirements of section 112, first paragraph; (2) a drawing, if necessary, for understanding the subject matter of the invention which shows every feature of the disclosed invention; and (3) a filing fee, as required by law. n11 Claims, an oath or declaration, and an information disclosure statement are not required. n12

A provisional application may be filed in any language, subject to submission of an English translation. It may also be created after the fact, from a regularly filed application, by filing a new application within twelve months of the previous application filing date and paying the conversion fee. n13 A provisional application is not entitled to the priority of an earlier application under *35 U.S.C. § § 119* or 365(a), nor the benefit of an earlier filing date in the U.S. under sections 120, 121, or 365(c). n14 However, the provisional application may itself be the basis from which an applicant may claim domestic priority under new section 119(e). n15 This is true even though the provisional application is not examined by the USPTO, under section 131, for patentability of the subject matter.

The only time the USPTO will actually analyze the contents of the provisional application is: (1) when a non-provisional application relies on the provisional application's filing date; (2) when a patent issues claiming the benefit of the provisional application; or (3) to make a section 119(e)(1) determination that the invention was properly disclosed in the provisional application according to the requisites of

[*164] section 112, first paragraph. n16 While the provisional application filing date may be used to establish priority under 35 U.S.C. § 119(e)(1), it may not be used to compute the twenty year expiration date of the patent term. n17

Most importantly, 35 U.S.C. § 111(b)(5) provides that a provisional application is always abandoned after one year. However, a provisional application may be subject to revival by submitting a petition, as long as an applicant's failure to timely file a regular application was either unavoidable or unintentional. n18 Under no circumstances is an applicant permitted to revive a provisional application solely to extend the twelve month period. n19

III. OTHER COUNTRIES' INTERNAL PRIORITY DOCUMENT SYSTEMS

In contrast to the provisional application, other countries' internal priority document systems are better denominated "provisional specifications." n20 Many countries had legislation implementing provisional specifications long before the United States enacted its comparable legislation. n21 Ironically, the originator of the provisional specification, the United Kingdom, has repealed its legislation implementing the provisional specification. n22 However, much of Europe, Japan, and most members and former members of the British Commonwealth n23 still

[*165] provide for some type of internal priority document system based on the filing of a provisional specification and/or a related, later filed application based on a provisional specification. n24

Under the United Kingdom's former patent law, an applicant could obtain an effective filing date or priority date by filing a provisional specification which merely described the nature of the invention. n25 Even though such a provisional application could not mature into a patent, an applicant could effectively reserve the filing date. n26 This filing date, however, would be of no legal significance in the United Kingdom if an applicant stopped at this point in the process. n27 Patents would only be granted on the filing of a complete specification. n28 Only by filing a complete specification, which met certain requisites, did the earlier reserved filing date become legally effective in the United Kingdom. n29

A complete specification required an applicant to particularly describe and ascertain the nature of the invention and its manner of use. n30 Where an application for a patent was accompanied by a provisional specification, a complete specification had to be filed within twelve months from the provisional specification filing date, or the application would become abandoned, subject to exception. n31 The exception indicated that the complete specification could be filed at any time after twelve months, but not later than fifteen months, from the provisional specification filing date, provided that a request was made and the requisite fee was paid on or before the date on which the complete specification was filed. n32

More importantly, if the nature of the invention described and claimed in the complete specification did not differ from the nature of the invention originally described in the provisional specification, the

[*166] patent application was considered to be complete. This permitted the effective filing date of the complete application to become the provisional specification's filing date. n33 However, an inventor would not be bound to implicitly follow every detail given in the provisional specification, or be prevented from adding or subtracting to the invention, as long as there existed a general agreement of the nature of the invention. n34 As such, the "provisional specification [was] not in fact 'provisional' or temporary in character. It formed an essential part of the patent subsequently granted for the complete specification based upon the provisional specification." n35

Most members or former members of the British Commonwealth which have an internal priority document system have implemented legislation n36 which varies from the United Kingdom's original legislation with regard to the time extensions for filing the complete specification beyond the twelve month period. These extensions range from zero to three months. n37 In general, British Commonwealth countries require that the complete specification particularly describe the invention and the method by which it is to be performed, and contain a claim or claims defining the scope of the invention. n38 Regardless of the requisites and applicable extension periods, these countries generally provide that the effective filing date of the complete specification, with a claim based on the matter disclosed in one or more provisional specifications, is the date of lodgment of the provisional specification in which the matter was first disclosed. n39

Internal priority document systems emphasize the need to quickly obtain a priority date. This emphasis is mirrored in other countries' internal priority document systems. In Switzerland, a priority date may be claimed by filing: (1) an application with at least one claim; (2) a

[*167] specification in German, French, or Italian; and (3) any drawings referred to in the specifications or claims. n40 To preserve a priority date in Japan, an application must include a specification, claims, any necessary drawings, any applicable priority claims and, the name and address of the applicant, as well as any grace period claim. n41 Patent applications can be filed in Taiwan with informal drawings and a specification, in a language other than Chinese, to establish an effective filing date. n42 In Portugal, to obtain an effective filing date, an application may be filed giving the name of the applicant, the title of the invention, and the priority date of any earlier filed application. n43 Applications in Finland require the applicant's full name and address, country, and date and serial number of any applicable priority application to obtain an effective filing date. n44

Thus, the requisites for obtaining effective filing dates under other countries' internal priority document systems are generally relaxed. Documents filed within the home country may have to specifically disclose elements of the claimed invention to receive a filing date. The most important theme is the speed in obtaining a priority date. Subsequently, internal filing may be required to complete the home country patent application while external filing may be required in each foreign country in which a grant of patent is sought. Notwithstanding these relaxed standards, no debate has arisen concerning whether these documents have a right to be considered a valid means of establishing Paris Convention priority. n45 Therefore, even if the provisional application itself can never mature into a patent, analogous to a provisional specification, why is its validity as a Paris Convention document questioned?

IV. THE UNITED STATES PROVISIONAL APPLICATION "DEBATE"

In late October 1995, at the annual meeting of the American Intellectual Property Law Association (AIPLA), several commentators expressed concern over the provisional application. n46 Paraphrased

[*168] comments included the following: (1) since a Patent Cooperation Treaty n47 (PCT) article provision requires that a foreign application, or any application for a PCT, must clearly state that the applicant wishes a patent to be granted on the application, combined with the fact that no such requirement exists for the provisional application, there should be no reason to honor the provisional application on which the PCT is based for priority or any other purpose; n48 (2) since a provisional application is not a regular patent filing, it may not be granted Paris Convention priority rights; n49 and (3) because the provisional application does not require claims, the application may not be recognized as fully supporting the invention as later claimed. n50

These comments demonstrate there is confusion as to: (1) whether the provisional application is a valid means of obtaining Paris Convention priority; and (2) whether a benefit-conferring country may refuse to grant priority to a valid Paris Convention document. This distinction is of the utmost importance to a patent practitioner. There is no direct control as to the outcome of the first issue. However, if a provisional application can serve as a valid means of obtaining Paris Convention priority, a patent practitioner can directly influence the answer to the second issue. As such, the theoretical underpinnings will be analyzed in order to aid practitioners in predicting what the outcome should be. Further, suggestions will be proffered to help practitioners ensure that any priority obtained will not likely be refused.

The above confusion stems from the fact that the provisional application is not a regular patent application because it is not examined and is considered abandoned one year after filing. n51 More specifically,

[*169] some believe that since a provisional application always terminates, it may not receive the same rights of priority as a regular patent application or an inventor's certificate. n52 The rationale is that a provisional application can never issue as a patent under 35 U.S.C. § 111(b)(5) and therefore the provisional application will never have "the same effect" as either a regular national filing or an inventor's certificate. To better understand this "rationale," pertinent articles of the Paris Convention and its revisionary history need to be analyzed.

Prior to 1967, an inventor's certificate was not granted the same priority rights as a patent application under Article 4B of the Paris Convention. n53 This was true even though countries throughout the world recognized the inventor's certificate as a valid means of protecting an invention in lieu of obtaining a patent. n54 Available in Communist countries, which did not allow for the exclusion of others from making, using or selling the patented invention, n55 the inventor's certificate had the same effect as a patent within the country wherein the inventor's certificate was enforceable. n56

To obtain a "just result," the Paris Convention was revised. This provided applicants, who had a right to apply either for a patent or for an inventor's certificate under the same conditions and with the same effect as patent applications, equality of treatment with respect to priority. n57 To effect this just result, the Paris Convention was dutifully amended in Stockholm in 1967 to incorporate a new article, Article 4I. n58 Today, the

[*170] irony of the situation is clear. The rationale used to create Article 4I has now been applied against the provisional application as defined by the domestic law of the United States.

V. THE MERITS OF THE STOCKHOLM RATIONALE -- "THE SAME EFFECT"

At first blush, this rationale has merit. It would seem to support why provisional specifications have never been the subject of any type of priority debate. n59 Since the provisional specification can be maintained for prosecution and lead to a patent, it logically could have the same effect as a regular national filing or an inventor's certificate. In contrast, the provisional application can never be maintained for prosecution nor lead to a patent. Therefore, because it does not have the same effect as a regular national filing or an inventor's certificate, it should be treated differently than the provisional specification. Whether Germany, Japan, and other countries will accept United States provisional-based priority rights may be a matter to be decided years from now in their respective court systems. n60 Absent remedial legislation which is retroactive to June 8, 1995, the discrepancy found within *35 U.S.C. § 111(b)(5)* may indeed be a grave one. n61 If Congress fails to act, however, and a patent practitioner is forced to litigate the matter in a foreign court years from now, that practitioner should be successful in defending United States provisional-based priority rights.

Article 4 of the Paris Convention essentially grants an applicant a one year period, dated from the first home country filing, to claim priority based on subject matter commonly disclosed in subsequent applications filed in other member countries. Article 4A(1) indicates in pertinent part that "[a] person who has duly filed an application for a patent . . . shall enjoy, for the purposes of filing in the other countries, a right of priority during the periods hereinafter stated." n62

According to Article 4A(2) of the Paris Convention, "any filing that is equivalent to a regular national filing under the domestic legislation

[*171] of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognized as giving rise to the right of priority." Furthermore, according to Article 4A(3), "a regular national filing [means] any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application." Therefore, in order for the application to give rise to priority, it only has to establish a filing date in the home country. The application does not have to have any possibility that it may issue.

It appears that regardless of "the same effect" rationale, a literal reading of the Paris Convention mandates acceptance by the world patent community of any application as a valid Paris Convention document as long as the application establishes a filing date according to the internal domestic legislation of the country where the application is first filed. This mandate is especially true when considering the rules of international law concerning treaty interpretation. n63 According to these rules, if the text of a treaty is clear and unambiguous on its face, there is no need to look to the intent of the drafters. n64 Since the text of Article 4A(3), "whatever may be the subsequent fate of the application," is indeed clear and unambiguous on its face, there should be no cause to look to the drafters' intent for any other interpretation. As such, no court should have to look to Article 4I, or any other article of the Paris Convention.

The issue thus remains whether the United States provisional application establishes a filing date according to its own internal legislation. It plainly does. According to 35 *U.S.C. § 111(b)(3)*, "the filing date of a provisional application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office." Theoretically speaking, the issue is moot. n65 However, every patent practitioner knows that what may be perfectly

[*172] clear in theory is not always so in reality. The reality is that courts of other countries will decide this issue. n66

VI. THE PRESENT AND FUTURE STATUS OF THE PROVISIONAL APPLICATION

Fortunately, the United States has already taken action to ease the minds of patent practitioners who have been filing United States provisional applications since June 8, 1995. Such action has included correspondence with Arpad Bogsch, director general of the World Intellectual Property Organization (WIPO) and Ingo Kober, president of the European Patent Office (EPO). n67 Bogsch responded in a November 20, 1995, letter to Bruce Lehman, U.S. Commissioner of Patents and Trademarks, stating that WIPO's International Bureau "is not in a position to give an official interpretation of the provisions of the Paris Convention." n68 However, Bogsch indicated that the provisional application fits all the requisites of a valid Paris Convention document under Article 4 of the Paris Convention and, moreover, "applications for patents are recognized as giving rise to a right of priority under the Paris Convention even if it is clear from the outset that no patent can be granted upon such an application, for example, where the invention concerned is excluded from patenting." n69

From this response, the USPTO published its view in the November 28, 1995 issue of the Official Gazette containing Bogsch's letter. n70 The USPTO view established that "the resulting exchange of correspondence should lay to rest any doubt that provisional patent applications are indeed sufficient for [establishing Paris Convention priority]." n71 In his letter, Bogsch indicated that it is the domestic legislation of the United States "which determines whether a 'regular national filing' exists" and that "whether a filing is to be considered as a 'regular national filing' does not appear to depend on whether or not that filing may itself lead to the grant of a patent." n72

Similarly, Kober responded to Commissioner Lehman in a January 30, 1996, letter stating that "the EPO will recognize the United States

[*173] provisional as a proper basis for claiming priority in the European patent granting procedure" because "there are no compelling reasons that militate against accepting [it] as a priority-conferring application in the sense of Article 87 of the European Patent Convention." n73 However, the EPO notice apprising the respective examiners of its position in the EPO's Official Journal appears to contain a reservation that the EPO, "while acknowledging the independent decision making competence of the EPO boards of appeal and the Courts of the contracting states, recognizes the provisional application for patent as giving rise to a right of priority within the meaning of Article 87(1) [of the] European Patent Convention." n74

Notwithstanding the literal terminology of the Paris Convention, the essence of these letters also illustrates the chaos which would undoubtedly arise should the provisional application not be accepted as a valid Paris Convention document. The inability of the United States provisional application to establish a Paris Convention right-of-priority would adversely affect both domestic and international patent practice. For example, throughout much of the world, pertinent portions of applications are published eighteen months after filing. The United States has similar legislation pending which would publish non-provisional *35 U.S.C. § 111(a)* applications eighteen months from the effective filing date. n75 Furthermore, PCT applications, as well as all other applications claiming priority, must be filed within twelve months from the effective filing date. n76 So, when is the earliest effective filing date for publication and/or PCT filing purposes -- the provisional application filing date or some other "regular national filing date?"

These issues are compounded when considering that most countries are first-to-file regimes with absolute novelty. As such, if the provisional application is not granted Paris Convention status, intervening prior art references, occurring between the provisional application filing date and the regular national filing, would be certain death to the patentability of the claimed subject matter. Assuming that the provisional application is a valid Paris Convention document, then allowing these intervening acts to have such an irreversible effect would be in direct contradiction to the one year grace period established in Article 4 of the Paris Convention. Further, failing to recognize the provisional

[*174] application as a valid Paris Convention document would undoubtedly have a detrimental effect on any future patent harmonization.

VII. WHAT THE PATENT PRACTITIONER SHOULD BE CONCERNED ABOUT

A patent practitioner should not be too concerned about whether the provisional application will be deemed a valid Paris Convention document by the benefit-conferring country. By all indications, it appears that the provisional application should not even be questioned as to its Paris Convention status, and, if it is questioned, an applicant should be successful in litigating the matter. However, it would be in the best interests of everyone involved to completely resolve this issue. To accomplish this, Congress should effect a legislative amendment retroactive to June 8, 1995.

Regardless of Congressional action, a patent practitioner should be concerned with whether a benefit-conferring country will refuse to grant priority to a provisional application as filed. Even though a benefit-conferring country may choose to grant priority based on a provisional application, such a priority may be readily and "properly" refused by the benefit-conferring country. n77

Under Article 4A(2) and (3), the right of priority is determined by the domestic legislation of the home country, according to how it defines a filing date. n78 As soon as the applicant receives a filing date, the one year grace period starts. n79 An application which concerns the identical subject matter as a prior application may be considered to initiate the tolling of the grace period if specific requisites are met. This includes the basic requisite that the prior application must not have served as a basis for claiming a right of priority. n80

According to Article 4F, no country may refuse priority because an application, claiming one or more priorities, contains elements or features not included in the original application, provided that there is "unity of invention" within the meaning of the law of the benefitconferring country. n81 In other words, the benefit-conferring country can refuse priority if any new matter, as defined by the that country, is injected into the filed application. Furthermore, additional elements not having unity of invention receive the latter filing date, under the home

[*175] country's laws. n82 According to Article 4H of the Paris Convention, priority may not be refused if the earlier documents failed to claim certain elements now being claimed, as long as the documents, as a whole, specifically disclose such elements, implied under the standard of what the benefit-conferring country deems to be specific disclosure.

Arguably, the purpose behind Article 4 is to allow applicants the right to file in their home country, obtain a filing date according to the domestic legislation of that home country, and employ this filing date as a priority from which to file in other countries within one year. As such, it seems contradictory to grant to a benefit-conferring country the right to refuse such a priority, especially where the home country priority filing has matured into a patent. However, the Paris Convention may be manipulated and abused to such an extent as to effectively deny the purpose behind Article 4. This abuse is epitomized by the past treatment of British provisional specifications.

To receive a filing date in the United Kingdom, an applicant would traditionally file a provisional specification by merely describing the nature of the invention. This was due to the lack of any required specific disclosure of the elements of the invention. n83 If the applicant filed a complete specification, which had unity of invention according to the United Kingdom's domestic laws, then that complete specification was given an effective filing date of the earlier provisional specification filing. n84 Prior to the applicant filing a complete specification in the United Kingdom, it was common practice for the applicant to file in a foreign benefit-conferring country in order to claim priority based upon the earlier filed provisional specification. n85 When the application documents as a whole failed to specifically disclose the features presently being claimed in the benefit-conferring country, according to its definition of unity of invention, n86 the benefit-conferring country frequently refused to grant priority.

[*176] As such, the benefit-conferring country applied either a liberal or strict interpretation in determining whether to grant priority. n87 The liberal interpretation indicated that the complete specification was the only "proper" date from which to start the one year grace period, even though the provisional application already received a filing date. n88 Conversely, the strict interpretation indicated that because the complete specification constituted new matter, it should receive a new filing date according to the United Kingdom's ordinary conditions. n89 If the benefitconferring

[*177] country would not grant priority, then the only way an applicant could make any priority claim to the provisional specification in the benefit-conferring country would be to completely abandon the provisional specification and make no claim to its priority. This is in direct contradiction to the purpose of Article 4A. It is an unfortunate happenstance that the literal terminology of the Paris Convention allows a benefit-conferring country's substantive laws to effectively deny the procedural intent of the grace period.

Provisional specifications of the United Kingdom are not the only applications denied Paris Convention priority. Regularly filed, national, non-provisional applications in compliance with the home country's substantive patent law, as well as the benefiting-country's substantive patent law, have also suffered unjustly through the retroactive application of unity of invention disclosure standards. n90 The United States established this apparent violation of Article 4H of the Paris Convention in *Yasuko Kawai v. Metlesics*. n91 This erroneous precedent has been firmly entrenched in subsequent decisions n92 to the extent that other countries have found it necessary to retaliate with their own decisions. n93 It now appears that violating Article 4H may be considered to be the international norm. n94

[*178] A patent practitioner may glean from this past treatment of United Kingdom provisional specifications and other regularly filed non-provisional applications that different levels of priority protection exist. To start with, a minimal level of protection begins with a document, such as a petition requesting a filing date, wherein some later filing in the home country is needed to obtain patent protection. More protection is afforded by an application, such as a provisional specification, in conjunction with a supplemental application which fails to have unity of invention according to the home country's laws. Again, some later filing in the home country is needed in order to obtain patent protection. Also at this level is an application, which receives a filing date, has the possibility that it alone may mature into a patent in the home country, though it fails to have unity of inventive disclosure with a subsequent application filed in the benefit-conferring country. This is in accordance with the benefit-conferring country's laws.

A higher level is an application, in conjunction with a supplemental application, which does have unity of invention according to the home country's laws, but fails to have unity of inventive disclosure according to the benefit-conferring country's laws. The last and highest level of protection is obtained by filing an application which meets the unity of inventive disclosure requirements within the benefit-conferring country. This includes filing an application in conjunction with a supplemental application, or alternatively an application which can issue into a patent in the home country. With an understanding of these different levels, the patent practitioner is better armed to prevent a benefit-conferring country from denying the grant of priority. n95

VIII. SUGGESTIONS FOR PRACTITIONERS

The United States patent practitioner can only claim internal priority under *35 U.S.C. § 119(e)* by writing the provisional application in compliance with section 112, first paragraph. Therefore, it is unlikely that the patent practitioner will be refused priority in the United States, or elsewhere, assuming the application is properly written. This is

[*179] because section 112, first paragraph, presently appears to require the highest level of unity of inventive disclosure of any existing patent regime. Even though it is improbable that another patent regime may subsequently require a higher level of unity of inventive disclosure, the potential does exist. As such, a patent practitioner is advised to use the utmost care in writing a provisional application fully and specifically disclosing all elements known to the inventor.

In the past, priority has been improperly refused where the earlier application failed to claim the subject matter which is being claimed in the application filed in the benefit-conferring country. n96 It is advisable that a patent practitioner draft claims in the provisional application as would normally be done with any national application filed under section 111(a) or a PCT international application, designating the United States. n97 In addition, if an applicant chooses to file in a country where substantive patent law demands a higher level of unity of inventive disclosure than is presently required in the United States, the patent practitioner is best advised to file an application in the benefit-conferring country which is identical to the provisional application filed in the United States. This is another reason why claims should be drafted in the provisional application.

IX. CONCLUSION

Absent remedial legislation which is retroactive to June 8, 1995, the discrepancy within the United States concerning *35 U.S.C. § 111(b)(5)* may indeed be a grave one. However, if Congress fails to act, the law remains relatively clear to those within the United States. Under Article 4A(2) and (3) of the Paris Convention, in order for an application to give rise to a right of priority, it only has to establish a filing date according to the domestic legislation of the country in which the application was filed, irrespective of the subsequent fate of the application. Additionally, according to *35 U.S.C. § 111(b)(3)*, a provisional application containing a specification and any required drawing establishes a filing date when it is received in the USPTO.

While it is clear to the USPTO that the provisional application can be used to claim priority under the Paris Convention, it is not clear whether Germany, Japan, and other countries will accept U.S. provisional-based priority rights. This matter may be decided years from now

[*180] in each countries' respective judicial system. Regardless of the outcome of this issue, the patent practitioner is advised to exercise care in writing the provisional application to ensure that priority will not be refused by a benefit-conferring country.

n1 *See* Pub. L. No. 103-465, Title V, Subtitle c, § 532(b)(3), 108 Stat. 4986 (amending 35 U.S.C. § 111 on December 8, 1994).

n2 *See* the United States Patent and Trademark Office's Statement of Intent regarding the Administration's Agreement on Trade-Related Aspects of Intellectual Property Rights ("provision of a domestic priority right is important to ensure that applicants who file originally in the United States are not placed at a disadvantage in relation to applicants who file originally in foreign countries").

n3 Telephone interview with Ruth Nyblod, Office of Public Affairs, United States Department of Commerce, Patent and Trademark Office (April 3, 1996). The following data exemplifies this steady increase in 1995: 832 in June; 938 in July; 1,343 in August; 1,531 in September; and 1,705 in October.

n4 *Id.* While the USPTO received 1,705 provisional applications in October 1995, this number dropped to 1,484 in November, 1,411 in December, and 1,230 in January 1996.

n5 Paris Convention for the Protection of Industrial Property, March 20, 1883, 25 Stat. 1372. The latest revision occurred in Stockholm on July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305 (hereinafter "Paris Convention"). *See infra* part IV.

n6 Donald L. Corneglio, *Harmonization*, AM. INTELL. PROP. L. ASS'N BULL., Oct.-Nov.-Dec. 1995, at 134.

n7 *Id.* at 134-35.

n8 Because the American "first inventor" who is second-to-file may eventually gain a United States patent for the same invention which has already been protected throughout the world by a competitor, a global settlement may ensue. A global settlement usually results in cross-licensing of the common global patent rights. HAROLD C. WEGNER, PATENT HARMONIZATION BY TREATY OR DOMESTIC REFORM 71 (1993).

n9 Unless otherwise noted, all references to "sections" refer to Title 35 of the United States Code, otherwise known as the Patent Act.

n10 Public Law No. 103-465 provides a mechanism to enable applicants to quickly and inexpensively file provisional applications. Applicants will be entitled to claim the benefit of priority in a given application based upon a previously filed provisional application in the United States. Notice of May 2, 1995, 1174 Official Gazette 15, 16.

n11 35 U.S.C. § 111 (1996).

n12 *See id.*

n13 *Id.*

n14 *Id.*

n15 It is important to note that a provisional application cannot be relied upon to establish priority for a later filed design application under 35 U.S.C. § 172.

n16 Charles E. Van Horn, *Practicalities and Potential Pitfalls When Using Provisional Patent Applications*, 22 AM. INTELL. PROP. L.Q.J. 259, 292-93 (1994).

n17 35 U.S.C. § 154(a)(3) (1996) precludes consideration of claims for priority under 35 U.S.C. §§ 119, 365(a) and 365(b).

n18 37 C.F.R. § 1.139 (1996).

n19 *Id.*

n20 Provisional specifications should not be confused with the informal filing of a regularly filed application, sometimes loosely referred to as "provisional" applications. For example, Brazil, Chile, the Czech Republic, Denmark, Hungary, Norway, Netherlands, Sweden, Taiwan, and the United States allow for an applicant to file a foreign text provisionally and a domestic text later, but such an application is not a provisional specification. 2 Baxter, *World Pat. L. & Prac.* (MB) § 2.05 (1995).

n21 *See generally* George Von Gehr, *The British Provisional Specification*, 18 J. PAT. OFF. SOC'Y 770 (1936) (describing the nature and function of the United Kingdom provisional specification according to its implementing legislation under the Patent Act of 1852).

n22 Patent Act of 1977 of the United Kingdom, §§ 14 (4) & (8).

n23 The following is a list of former British Commonwealth countries which still permit the filing of applications accompanied by provisional specifications: Antigua, Australia, Bangladesh, Belize, Bermuda, British Virgin Islands, Canada, Dominica, Grenada, Guyana, India, Ireland, Malawi, Malta, Montserrat, Namibia, Nevis & Anguilla, New Zealand, Pakistan, St. Christopher, St. Lucia, St. Vincent, Seychelles, Republic of South Africa, Trinidad & Tobago, Zambia, and Zimbabwe. 2 Baxter, *World Pat. L. & Prac.* (MB) § 2.05 (1995).

n24 Patent Act of 1977 of the United Kingdom, §§ 14 (4) & (8).

n25 Patent Act of 1852 of the United Kingdom, at vi. (15 & 16 Vict. c. 83, superseded by Patent Act of 1949 of the United Kingdom).

n26 Patent Act of 1852 of the United Kingdom at viii.

n27 *Id.* Such a filing date may be a valid means of claiming priority outside of the United Kingdom, according to the Paris Convention, *supra* note 5, Art. 4. *See infra* part V.

n28 Patent Act of 1852 of the United Kingdom, at ix, xv.

n29 *Id.* at xii.

n30 *Id.* at ix.

n31 Patent Act of 1949 of the United Kingdom, § 3(2).

n32 *Id.*

n33 *Id.* at § 5(2) (if a complete specification made a claim that was fairly based on the matter disclosed in the provisional specification, the effective filing date of that claim was considered the date of filing of the provisional specification filing date).

n34 *See* George Von Gehr, *The British Provisional Specification*, 18 *J. PAT. OFF. SOC'Y* 770, 772-73.

n35 *Id.* at 773.

n36 2 Baxter, *World Pat. L. & Prac.* (MB) § 2.05 (1995).

n37 *Id.*

n38 *Id.* However, in South Africa, in order to secure the effective filing date of the earlier filed provisional specification, the complete specification need only include the name of the applicant, the application title, and reference to any earlier filed home country applications by serial number. The specification and drawings must be lodged within fourteen days of the filing date. *Id.*

n39 *Id.*

n40 *Id.*

n41 *Id.*

n42 *Id.*

n43 *Id.*

n44 *Id.*

n45 Whether these documents have a right to be considered valid Paris Convention priority documents and whether they may be refused priority by the benefit-conferring country are distinct issues. *See infra* parts IV & VI.

n46 *GATT, GOTT, GETT: The Practical Aspects and Implications of Recent Patent Legislation*, AM. INTELL. PROPERTY L. ASS'N BULL., Oct.-Nov.-Dec. 1995, at 70-71 [hereinafter *Practical Aspects*]; *WIPO Chief: U.S. Provisional Application Can Set Priority Under Paris Convention*, 51 *Pat. Trademark & Copyright J.* 105 (Nov. 23, 1995) [hereinafter *WIPO Chief*] ("Dieter Hoinkes, senior counsel for the PTO's Office of Legislative and International Affairs, told PTCJ that uncertainty about claiming priority through U.S. provisional applications arose at the recent Washington meeting of the American Intellectual Property Law Association, and has been 'taken as gospel.'"); *PTO, Provisional Applications*, 51 *Pat. Trademark & Copyright J.* 493 (Feb. 15, 1996) [hereinafter *PTO, Provisional Applications*]; *International Intellectual Property Group News*, INTELL. PROP. L. NEWSLETTER (ABA Section of Intellectual Property Law, Chicago, IL.), Vol. 14, Number 2, at 25, 26 [hereinafter *IIP Group News*].

n47 Patent Cooperation Treaty, June 19, 1970, 28 *U.S.T.* 7645, 1160 *U.N.T.S.* 231.

n48 *Practical Aspects*, *supra* note 46, at 70. The provision referred to is Article 4 of the PCT, *supra* note 47.

n49 *IIP Group News*, *supra* note 46, at 25.

n50 *Practical Aspects*, *supra* note 46, at 70-71.

n51 *IIP Group News*, *supra* note 46, at 25.

n52 *Id.*

n53 2 *Baxter*, *World Pat. L. & Prac.* (MB) § 10.05 (1995).

n54 *Id.* at § 1.04.

n55 Today, exclusionary rights would also include the right to exclude others from offering for sale or importing the patented invention in the United States. 35 *U.S.C.* § 271(a) (1996).

n56 2 *Baxter*, *World Pat. L. & Prac.* § 10.05 (1995). It should be noted that inventor's certificates have not been issued in over six years. *Id.*

n57 *Id.*

n58 Article 4I states:

(1) Applications for inventor's certificates filed in a country in which applicants have the right to apply at their own option either for a patent or for an inventor's certificate shall give rise to the right of priority provided for by this Article, under the same conditions and with the same effects as applications for patents.

(2) In a country in which applicants have the right to apply at their own option either for a patent or for an inventor's certificate, an applicant for an inventor's certificate shall, in accordance with the provisions of this Article relating to patent applications, enjoy a right of priority based on an application for a patent, a utility model, or an inventor's certificate.

Paris Convention, *supra* note 5, Article 4I.

n59 *Practical Aspects*, *supra* note 46, at 70. It must be stressed that the phrase "priority debate" refers to the right to be considered a valid Paris Convention priority document, rather than whether this right may be refused priority by the benefit-conferring country.

n60 *IIP Group News*, *supra* note 46, at 26 ("Despite [the World Intellectual Property Law's] reply, each country must decide whether to grant priority of the application. Thus, the issue may still be independently addressed by each of the national/regional patent offices around the world.").

n61 *Practical Aspects*, *supra* note 46, at 70.

n62 *Paris Convention*, *supra* note 5, Article 4A(1).

n63 *Vienna Convention on the Law of Treaties*, March 20, 1986, Art. 31 & 32, 25 *I.L.M.* 543.

n64 *Id.*

n65 Theoretically, the requirements of Articles 4A(2) & (3) are so liberal that an applicant could very well proceed to forum-shopping, effectively abusing Article 2 of the Paris Convention which mandates national treatment. The basic premise behind Article 2 is to prohibit discrimination against foreigners -- not to provide a domestic applicant a means for procedurally bypassing more stringent requirements demanded by their respective home country. Allowing a domestic applicant the right to file in whatever

foreign country happens to offer the most relaxed internal legislation merely to obtain a filing date for Paris Convention priority purposes, and demanding that the date be recognized in the home country, effectively abuses the national treatment provision. Of course, the respective home country may be able to "rightfully" refuse this priority date. *See infra* part VII.

n66 *IIP Group News*, *supra* note 46, at 26.

n67 *WIPO Chief*, *supra* note 46; *PTO, Provisional Applications*, *supra* note 46, at 70.

n68 *WIPO Chief*, *supra* note 46.

n69 Notice of November 28, 1995, 1180 Official Gazette 131, 134.

n70 *Id.*

n71 *Id.*

n72 *Id.*

n73 *PTO, Provisional Applications*, *supra* note 46.

n74 Notice from the President of the European Patent Office concerning the priority-conferring effect of the United States "provisional application for patent" (Jan. 26, 1996) (available on-line at <http://www.epo.co.at/epo/notices.htm>).

n75 *60 Fed. Reg. 42,352, 42,383 (1995)* (to be codified at 37 C.F.R. § 1.306).

n76 *35 U.S.C. § 119 (1996)*.

n77 Paris Convention, *supra* note 5, Article 4.

n78 *Id.*

n79 *Id.* at Article 4C(2).

n80 *Id.* at Article 4C(4).

n81 *Id.* at Article 4F.

n82 *Id.*

n83 *See generally* George Von Gehr, *The British Provisional Specification*, 18 *J. PAT. OFF. SOC'Y* 770 (1936).

n84 *Id.*

n85 *Id.*

n86 *See, e.g., American Stainless Steel Co. v. Rustless Iron Corp. of Am.*, 2 *F. Supp.* 742, 17 *U.S.P.Q. (BNA)* 17 (*D. Md.* 1933), *aff'd*, 71 *F.2d* 404, 22 *U.S.P.Q. (BNA)* 114 (*4th Cir.* 1934), where the court stated "an English preliminary or provisional specification might well be so vague and incomplete that its filing date could in no way amount to what we, *under the American law*, understand to be an "application." An English final or complete specification might well be so different from the preliminary specification as to be considered under our law a new "application," and still be, under the English procedure, merely a completing of the record. *Id.* at 754 (emphasis added); *Normann v. Schmidt*, 125 *F.2d* 162, 168, 17 *U.S.P.Q. (BNA)* 342 (*C.C.P.A.* 1942) ("It

would be most extraordinary if a party should be considered to have filed an application for a specific invention in a foreign country on the date of filing an application which did not disclose that invention, and *it is inconceivable that Congress so intended.*") (emphasis added); *In re Crouch*, 129 F.2d 690, 54 U.S.P.Q. (BNA) 316 (C.C.P.A. 1942) (filing provisional specification in Britain that did not disclose claims is not "filed" as to such claims); *In re Smyth*, 189 F.2d 982, 90 U.S.P.Q. (BNA) 106 (C.C.P.A. 1951) (a British provisional application that does not sufficiently disclose the specific invention set forth in a subsequent complete specification cannot be used to establish a priority date against a U.S. application, even though the British provisional was filed prior to the U.S. application); *Yasuko Kawai v. Metlesics*, 480 F.2d 880, 885-89, 178 U.S.P.Q. (BNA) 158, 162-65 (C.C.P.A. 1973).

n87 4 DONALD S. CHISUM, PATENTS § 14.03[2][c] (1995).

n88 *See, e.g., Gibbs v. Wohl*, 67 F.2d 908, 20 U.S.P.Q. (BNA) 32 (C.C.P.A. 1933); *Woburn Degreasing Co. v. Spencer Kellogg & Sons, Inc.*, 40 F. Supp. 357, 51 U.S.P.Q. (BNA) 172 (W.D.N.Y. 1941); *Normann v. Schmidt*, 125 F.2d 162, 52 U.S.P.Q. (BNA) 342 (C.C.P.A. 1942); *In re Crouch*, 129 F.2d 690, 54 U.S.P.Q. (BNA) 316 (C.C.P.A. 1942). It should be noted, however, that these holdings are in apparent violation of Article 4C(4) of the Paris Convention (and the corresponding third paragraph of 35 U.S.C. § 119). *See also* United States Patent & Trademark Office, Manual of Patent Examining Procedure § 201.15 (6th ed. rev. 1995). The manual states that "according to United Kingdom law the provisional specification need not contain a complete disclosure of the invention in the sense of 35 U.S.C. § 112, but need only describe the general nature of the invention, and neither claims nor drawings are required. Consequently, in considering such provisional specifications, the question of completeness of disclosure is important In some instances the specification and drawing of the foreign application may have been filed at a date subsequent to the filing of the petition in the foreign country. Even though the petition is called the application and the filing date of this petition is the filing date of the application in a particular country, the date accorded here is the date on which the specification and drawing were filed." *Id.*

n89 *See, e.g., American Stainless Steel Co. v. Rustless Iron Corp. of Am.*, 2 F. Supp. 742, 17 U.S.P.Q. (BNA) 17 (D. Md. 1933), *aff'd*, 71 F.2d 404, 22 U.S.P.Q. (BNA) 114 (4th Cir. 1934); *Handley Page, Ltd. v. Leech Aircraft*, 35 F. Supp. 856, 47 U.S.P.Q. (BNA) 250 (S.D.N.Y. 1940). *See also* United States Patent & Trademark Office, Manual of Patent Examining Procedure § 201.15 (3d ed. rev. 1976) ("If it is found that the British provisional specification is insufficient for lack of disclosure, reliance may then be had on the complete specification and its date, if one has been presented, the complete specification then being treated as a different application.").

n90 G.R. Gansser, *Violations of the Paris Convention for the Protection of Industrial Property*, 11 INT'L REV. INDUS. PROP. AND COPYRIGHT L. 1, 16-17 (1980).

n91 480 F.2d 880, 885-89, 178 U.S.P.Q. (BNA) 158, 162-65 (C.C.P.A. 1973).

n92 *See, e.g., Anderson v. Natta*, 480 F.2d 1392, 1399, 178 U.S.P.Q. (BNA) 458, 462 (C.C.P.A. 1973); *Standard Oil Co. v. Montedison, S.p.A.*, 494 F. Supp. 370, 206 U.S.P.Q. (BNA) 676 (D. Del. 1980), *aff'd*, 664 F.2d 356, 212 U.S.P.Q. (BNA) 327 (3d Cir. 1981);

In re Gosteli, 872 F.2d 1008, 10 U.S.P.Q.2d (BNA) 1614 (Fed. Cir. 1989); *In re Ziegler*, 992 F.2d 1197, 26 U.S.P.Q.2d (BNA) 1600 (Fed. Cir. 1993).

n93 See *In re "Allopurinol,"* 1975 GRUR 131 (German Federal Supreme Court), noted 7 INT'L REV. INDUS. PROP. AND COPYRIGHT L. 105 (1976); *In re Hoechst*, Tokyo High Court (1977); cf. *Alpha-interferons/Biogen*, T 301/87, 1990 O.J. EPO 335, noted 21 INT'L REV. INDUS. PROP. AND COPYRIGHT L. 838 (1990) (creating a legal fiction that broad claims are entitled to priority based upon narrow disclosure); *Snackfood/Howard*, T 73/88, 1990 OJ EPO No. 5, noted 22 INT'L REV. INDUS. PROP. AND COPYRIGHT L. 248 (1991) (elements that are not connected to function and effect of invention are not necessarily essential features for determining priority). See generally T. Aoyama, *The Hoechst Case - A New Kawai*, 59 J. PAT. OFF. SOC'Y 263 (1977) (discussing parallels between the *Hoechst* and *Kawai* cases); L. Walter, *Comment to the Hoechst Case*, 8 INT'L REV. INDUS. PROP. AND COPYRIGHT L. 566, 570 (1977) (Japanese government retaliated by establishing its own unity of invention disclosure standard).

n94 HAROLD C. WEGNER, PATENT HARMONIZATION BY TREATY OR DOMESTIC REFORM 245 (1993). See generally Harold C. Wegner, *Filing Patents for Evolutionary Inventions Abroad*, 23 INT'L REV. INDUS. PROP. AND COPYRIGHT L. 184 (1992); F.K. Beier & R. Moufang, *Convention Priority for Improvement Inventions and Patents of Addition*, 21 INT'L REV. INDUS. PROP. AND COPYRIGHT L. 593 (1990).

n95 In the U.S., establishing priority based on a foreign application has been referred to as having basic requirements, including: a) the foreign filing must have been for a "patent" filed in an eligible foreign country; and b) the United States application must have been for the same invention that was adequately disclosed in the foreign application, as well as filed by the same applicant as in the United States or by a legal representative or assigns of that applicant within twelve months of the first foreign application. 4 DONALD S. CHISUM, PATENTS § 14.03 (1995).

n96 See, e.g., *In re Ziegler*, 992 F.2d 1197, 26 U.S.P.Q.2d (BNA) 1600 (Fed. Cir. 1993).

n97 Richard A. Kaba & Kathleen A. Ranney, *Pitfalls Abound in Provisional Application Process: Applicants Who Fail to Understand the Limitations of the Procedure May Lose Valuable Patent Rights*, NAT'L L.J., Oct. 23, 1995, at C35.