



**Catalogue of the Comparative Study of  
Foreign Priority System  
for Industrial Designs by ID5 Offices**

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# **1 Introduction**

## **1.1 Background**

The five Partner Offices all have foreign priority right systems under the Paris Convention, which enable applicants to apply for a national industrial design application while claiming the benefit of the filing date of an earlier foreign application, so as to facilitate obtaining protection for the same design in different countries.

To better understand the difference of foreign priority right systems and satisfy the demands of applicants, an in-depth comparative study on the foreign priority right systems for industrial designs should be conducted. With the study results, Partners will then distinctly understand the standards in regard to the foreign priority right system.

## **1.2 The Project on Comparative Study of Foreign Priority System for Industrial Designs**

The aim of the project “Comparative Study of Foreign Priority System for Industrial Designs by ID5 Offices” is to give a clear overview by studying current laws and practices of ID5 Partners regards to foreign priority right system. The Study will establish a catalog to summarize the similarities and differences among ID5 Partners.

The desired outcome of the Study is to enlarge and update the knowledge of each Partner about foreign priority right laws and practices in other countries, to enhance communication and mutual trust among ID5 offices, and also to help the users to file applications more easily and effectively

- Establish a catalog of the Study allowing a comparison of the differences of laws and practices on foreign priority right system among ID5 offices
- Compile practice cases according to the Study on foreign priority right system
- According to the study outcome and partners’ demands, a user-friendly version of the Study outcome may be offered.

## **1.3 The Catalogue**

The Comparative Study of Foreign Priority Right System is mainly divided into three parts: Formality Requirements, Procedure Requirements and Judgment of the Same Subject Matter. The list of themes covered by the Catalogue is the following:

- Relevant Legal Provisions



- Formality Requirements
- Procedure Requirements
- Judgment of the Same Subject Matter
- Others

The Study was accomplished step by step. Firstly, we focus on the comparative of current laws and practices among ID5 Partners, providing practical case for analysis. At a later stage, according to the study outcome and partners' demands, a user-friendly version of the Study outcome may be offered.

## **2 Relevant Legal Provisions**

The relevant legal provisions for claiming foreign priority in each office may be different. Some Partner offices provide for the claiming of the benefit of earlier filed domestic applications. Below is a comparative study of foreign priority claims among the Partner offices as well as claims for the benefit of earlier filed domestic applications where appropriate.

### **2.1 EUIPO**

The relevant texts are Article 41 to 43 of Council Regulation (EC) No 6/2002 of 12 December 2001 as amended by Council Regulation No 1891/2006 of 18 December 2006 (CDR), and Article 8 of Commission Regulation (EC) No 2245/2002 of 21 October 2002 (CDIR). The Office's practice is explained in its Guidelines on Examination of Applications for Registered Community Designs

### **2.2 JPO**

[Regularly filed application for design registration (hereinafter referred to as "design application")]

Articles 43(1) to (4), (8) and (9) and 43-3 of the Patent Act as applied mutatis mutandis pursuant to Article 15(1) of the Design Act.

(The term "within the time limit provided by Ordinance of the Ministry of Economy, Trade and Industry" in Article 43(1) is replaced with "at the time of filing of the application for design registration", "within one year and four months from the earliest of the following dates" in Article 43(2) is replaced with "within three months from the date of filing of the application for design registration" and "the preceding two articles" in Article 43-3(3) is replaced with "Article 43".)

[International application for design registration under the Geneva Act of the Hague Agreement(hereinafter referred to as "international design application under the Geneva Act")]

Article 60-10 of the Design Act

### **2.3 KIPO**

Article 51(Priority Claim under Treaty) and Article 188(Special Provision concerning Priority Claim under Treaty) of the Design Protection Act.

### **2.4 SIPO**

PATENT LAW OF THE PEOPLE'S REPUBLIC OF CHINA

Article 29. Article 30.

IMPLEMENTING REGULATIONS OF THE PATENT LAW OF THE PEOPLE'S  
REPUBLIC OF CHINA

Rule 31. Rule 32. Rule 33.

### **2.5 USPTO**

United States Code Title 35 – Patents, Title 37 Code of Federal Regulations – Patents,  
Trademarks, and Copyrights, and Manual of Patent Examining Procedure (MPEP)

## **3 Formality Requirements**

### **3.1 EUIPO**

#### **3.1.1 Time Limit of Claiming Priority**

The right of priority is of six months from the date of filing of the first application (Article 41(1) CDR).

According to the Office's practice, a valid priority claim requires that the date of filing allocated to the Community design (as opposed to the date of receipt of the application for the Community design) is no later than six months from the filing date of the first application (Guidelines, Chapter 6.2.1.1., page 57).

#### **3.1.2 Fee of Claiming Priority**

No fee is required to claim priority.

#### **3.1.3 Declaration of Claiming Priority**

A declaration of claiming priority is compulsory. Where there is no indication of the claim in the application, the submission of priority documents together with the application or within one month of the filing date will be construed as a declaration of priority.

Unless it is expressly indicated in the application that a priority claim will be made subsequently, the application will be examined without delay and, if no deficiency is found, will be registered without waiting one month for any potential declaration of priority. If a declaration of priority is validly filed after registration of the Community design application, a corresponding entry will subsequently be made in the Register (Guidelines, Chapter 6.2.1.1., page 56).

Where the priority of one or more previous applications is claimed in the application, the applicant shall indicate the date on which the previous application was filed, the country in which or for which it was filed and the file number of the previous application. The applicant must file a copy of the previous application within three months of the filing date (Articles 1(1)(f) and 8(1) CDIR).

Where the priority claim is submitted within a period of one month of the filing date, the applicant must indicate the date on which and the country in which the previous application was made. The applicant shall indicate the file number of the previous application and file a copy of

the previous application within three months of receipt of the declaration of priority (Article 8(2) CDIR).

### **3.1.4 A certified copy of Previous Application Documents**

A copy of the previous application must be filed

Where the priority of one or more previous applications is claimed in the application, the applicant must file a copy of the previous application within three months of the filing date (Article 8(1) CDIR).

Where the priority claim is submitted within a period of one month of the filing date, the applicant must file a copy of the previous application within three months of receipt of the declaration of priority (Article 8(2) CDIR).

The President of the Office shall determine the evidence to be provided by the applicant (Article 8(1) CDIR).

According to Decision No EX---03---05 of the President of the Office of 20/01/2003 concerning the formal requirements of a priority or seniority claim, the priority document must consist of a certified copy of the previous application or registration, issued by the authority that received it, and be accompanied by a certificate stating the filing date of that application. The priority document may be filed in the form of an original or as an accurate photocopy. Insofar as the original document contains a representation of the design in colour, the photocopy must also be in colour.

Applicants claiming the priority of a U.S. patent (design) application are allowed to submit the certified copy of this application in CD-ROM format (Communication No 12/04 of the President of the Office of 20/10/2004).

Where the priority of a previous registered Community design is claimed, the applicant must indicate the number of the previous application and its date of filing. No additional information or document is required.

If the language of the previous application is not one of the five Office languages (English, French, German, Italian, Spanish), the Office may invite the applicant to file a translation within two months (Article 42 CDR).

It is not necessary for the whole document to be translated, but only that information allowing the examiner to check the nature of the right (design or utility model), the country of filing, the file number, the filing date and the applicant's name (Guidelines, Chapter 6.2.1.1., page 58).

## **3.2 JPO**

### **3.2.1 Time Limit of Claiming Priority**

The period of priority applied under the Paris Convention to an application for design registration in Japan is six months from the filing date of the first application that serves as the basis of claiming priority. (Article 4C(1) of the Paris Convention)

### **3.2.2 Fee of Claiming Priority**

It is not necessary to pay a fee for claiming priority.

### **3.2.3 Declaration of Claiming Priority**

Declaration of claiming priority is compulsory. (Article 43(1) of the Patent Act as applied mutatis mutandis pursuant to Article 15(1) of the Design Act.)

However, submission of the written declaration can be omitted when the items necessary are stated in the design application.(Article 27-4(3) of the Ordinance for Enforcement of the Patent Act as applied mutatis mutandis pursuant to Article 19(3) of the Ordinance for Enforcement of the Design Act)

For regularly filed design application, the declaration should be submitted at the time of filing of a design application. (Article 43(1) of the Patent Act as applied mutatis mutandis pursuant to Article 15(1) of the Design Act.)

For international design application under the Geneva Act, the declaration should be stated in the application at the time of filing of an international design application under the Geneva Act.

The declaration should contain the name of the country to which the application was first filed and the filing date. (Article 43(1) of the Patent Act as applied mutatis mutandis pursuant to Article 15(1) of the Design Act.)

### **3.2.4 A certified copy of Previous Application Documents**

An original certified copy of previous application documents must be submitted in paper form. (Articles 43(2) of the Patent Act as applied mutatis mutandis pursuant to Article 15(1) and Article 60-10(2) of the Design Act.)

For regularly filed design application, the certified copy must be submitted within 3 months from the filing date of the design application. (Article 43(2) of the Patent Act as applied mutatis mutandis pursuant to Article 15(1) of the Design Act.)

For International design application under the Geneva Act, the certified copy must be submitted within 3 months from the date of the international publication. (Article 60-10(2) of the Design Act. Article 12-2 of the Ordinance for Enforcement of the Design Act.)

The copy has to be submitted together with a “Submission of Priority Certificate” made in conformity with the prescribed form. (Article 27-3-3(1) of the Ordinance for Enforcement of the Patent Act as applied mutatis mutandis pursuant to Article 19(3) of the Ordinance for Enforcement of the Design Act)

A Japanese translation of the name of the country to which the first application was filed and the filing date in the certified copy has to be submitted.

### **3.3 KIPO**

#### **3.3.1 Time Limit of Claiming Priority**

Within 6 months of the filing date of the initial application on which the priority claim shall be based.

#### **3.3.2 Fee of Claiming Priority**

The fee should be paid per design.

- 1) 18,000 won for each priority claim if filed electronically
- 2) 20,000 for each priority claim if filed in paper

Priority claim should be made at the time when filing an application and the fee should be paid within one month of the filing date of the application for design registration.

#### **3.3.3 Declaration of Claiming Priority**

It is compulsory to make the priority claim when filing an application for design registration.

When filing an application for design registration, the declaration should be submitted, which contained:

- 1) The statement of an applicant’s intention of priority claim, 2) the name of the State in which the initial application was filed, 3) the filing date of the previous application filed for design registration, 4) a document stating the filing date of the application for design registration recognized by the government of the State in which he/she filed an application first, and 5) a certified copy of the drawing of the design (Article 51(3) & 51(4) of the Design Protection Act)

### **3.3.4 A certified copy of Previous Application Documents**

A person who claims the right of priority shall submit a document stating the filing date of the application for design registration recognized by the government of the State in which he/she filed an application first, and a certified copy of the drawing of the design.

The copy should be submitted within 3 months of the filing date of an application

A document stating the filing date of the application for design registration recognized by the government of the State in which he/she filed an application first, and a certified copy of the drawing of the design

When necessary, Korean translation will be required (Article 47(2) of the Established Rules of the Design Protection Act)

## **3.4 SIPO**

### **3.4.1 Time Limit of Claiming Priority**

Within six months from the date on which any applicant first filed in a foreign country an application for a patent for design, he or it may enjoy a right of priority.

### **3.4.2 Fee of Claiming Priority**

The fee should be paid according to the number of declarations of claiming Priority. 80RMB for each declaration of claiming Priority is needed.

The applicant shall pay the claiming priority fee within two months from the filing date or fifteen days from the date of receipt of the notification of acceptance of the application from the patent administration department under the State Council.

### **3.4.3 Declaration of Claiming Priority**

Declaration of claiming priority is compulsory in China.

Any applicant who claims the right of priority shall make a declaration in the request when the application is filed. The declaration of claiming priority should contain the date of filing, the application number of the previous application, which is the basis of the right of priority, and the name of the authority with which the previous application was filed.

### **3.4.4 A certified copy of Previous Application Documents**

Any applicant who claims the right of priority shall submit the copy of the previous application document.

The copy of the previous application document shall be submitted within three months from the filing date of the subsequent application.

The copy of the previous application document, which is the basis of the right of priority, shall be provided by the authority with which the previous application was filed. The formality of the copy of the said application document shall be in conformity with the international practice. At least, the name of the authority with which the application was filed, the name of the applicant, the date of filing and the application number shall be indicated. Where multiple priorities are claimed, the copies of all the relevant previous application documents shall be submitted.

When the parties concerned submit the certifying documents and certifying materials (such as documents certifying the right of priority, documents certifying the assignment, etc.) in foreign language, the Chinese translation of the titles thereof shall also be submitted. When necessary, the examiner may invite the parties concerned to submit the Chinese translation of the full text or the abstract thereof within the specified time limit.

Where the copy of the previous application document which has been submitted to the Patent Office is required to be submitted again, the Chinese translation of the extract may be submitted instead, and indicates the application number of the subsequent application in the file of which the certified copy of the previous application document is deposited.

## **3.5 USPTO**

### **3.5.1 Time Limit of Claiming Priority**

In order to be entitled to the benefit of the filing date of a prior application filed in a foreign country, the design application or nonprovisional international design application<sup>1</sup> claiming priority to the foreign application must be filed not later than six months after the date on which the foreign application was filed or the design application or nonprovisional international design application must be entitled to claim the benefit under 35 U.S.C. 120, 121, 365(c), or 386(c) of an application that was filed not later than six months after the date on which the foreign application was filed. See 35 U.S.C. 119(a), 35 U.S.C. 172, 37 CFR 1.55(b) and MPEP § 213.03. However, in certain situations, the right of priority may be restored upon petition under 37 CFR 1.55(c). See section “3.4 Restoration of Claim to Right of Priority” below.

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<sup>1</sup> “Nonprovisional international design application” refers to an application filed pursuant to the Geneva Act of the Hague Agreement designating and entering the United States.



### **3.5.2 Fee of Claiming Priority**

No fee is required to claim priority.

### **3.5.3 Declaration of Claiming Priority**

A claim to priority must be filed in order for an application filed in the United States to be entitled to the benefit of the filing date of a prior application filed in a foreign country. See 35 U.S.C.119, 37 CFR 1.55, and MPEP § 214.

For a design application, the claim for foreign priority must be filed during the pendency of the application, unless filed with a petition under 37 CFR 1.55(e). If the claim for priority is filed after the date the issue fee is paid, the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323. See 37 CFR 1.55(g).

For a nonprovisional international design application, the priority claim, unless made in accordance with the Hague Agreement and the Hague Agreement Regulations, must be filed during the pendency of the application. See 37 CFR 1.55(m).

For a design application, the claim for foreign priority must be presented in an application data sheet (37 CFR 1.76), identifying the foreign application for which priority is claimed by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. See MPEP § 213.02.

In a nonprovisional international design application, the priority claim, unless made in accordance with the Hague Agreement and the Hague Agreement Regulations, must be presented in an application data sheet (37 CFR 1.76), identifying the foreign application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. See MPEP §2920.05(d).

### **3.5.4 A certified copy of Previous Application Documents**

In order for a design application or nonprovisional international design application to be entitled to the benefit of the filing date of a prior application filed in a foreign country, a certified copy of the foreign application must be submitted pursuant to 37 CFR 1.55. See MPEP § 215.

The requirement for a certified copy of the foreign application will be considered satisfied in a design application or a nonprovisional international design application if a prior-filed nonprovisional application for which a benefit is claimed under 35 U.S.C. 120, 121, 365(c), or 386(c) contains a certified copy of the foreign application and such prior-filed nonprovisional application is identified as containing a certified copy of the foreign application. See 37 CFR 1.55(h). See MPEP § 215, subsection III.

For a design application, the certified copy of the foreign application must be submitted during the pendency of the application, unless filed with a petition under 37 CFR 1.55(g) together with

the fee set forth in 37 CFR 1.17(g), that includes a showing of good and sufficient cause for the delay in filing the certified copy of the foreign application. If the certified copy of the foreign application is filed after the date the issue fee is paid, the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C.255 and 37 CFR 1.323. See MPEP § 215.03.

Under certain circumstances, the certified copy may be required at an earlier date. See 37 CFR 1.55(g)(2) and MPEP § 215.03.

For a nonprovisional international design application, the certified copy must be submitted in accordance with the time period and other conditions set forth in 37 CFR 1.55(g). See MPEP § 2920.05(d).

The certified copy which must be filed is a copy of the original foreign application with a certification by the patent office of the foreign country in which it was filed. Certified copies ordinarily consist of a copy of the specification and drawings of the applications as filed with a certificate of the foreign patent office giving certain information. See MPEP § 215, subsection II.

In the following situations, the USPTO may require that an English translation of a non-English language foreign application be filed (see 37 CFR 1.55(g)(3)):

When the application is involved in an interference (see 37 CFR 41.202) or derivation (see 37 CFR part 42) proceeding;

When necessary to overcome the date of a reference relied upon by the examiner; or When specifically required by the examiner.

If an English language translation of a non-English language foreign application is required, it must be filed together with a statement that the translation of the certified copy is accurate.

## **4 Procedure Requirements**

### **4.1 Amendment of Declaration**

#### **4.1.1 EUIPO**

There is no specific provision in the CDR or CDIR dealing with the correction of priority claims. However, according to Article 12 CDIR, ‘only the name and address of the applicant, errors of wording or of copying, or obvious mistakes may be corrected, at the request of the applicant and provided that such correction does not change the representation of the design’. The correction of the filing date of the previous application should therefore be possible if it is considered an ‘error of wording or of copying, or an obvious mistake.

In Article 12 CDIR does not foresee any time limit for the correction. Where the incorrect date of the first filing is earlier than 6 months before the date of filing of the Community design application, this will lead to an objection. The correction can be made in reply to the examiner’s objection once the examiner can verify which is the genuine date of filing of the previous application from the certified copy of the previous application, accompanied by the certificate stating the filing date of that application.

The correction for the names of the countries or in intergovernmental organizations or the application number of the previous application which indicated in priority declaration is same as for correction of the filing date

#### **4.1.2 JPO**

Amendment can be made only when it is not necessary to amend the name of the country (or the name of the intergovernmental organization) and the purpose of the amendment is to amend an obvious error of the filing date stated in the priority declaration to correspond to that stated in the certified copy of the application previously filed.

In addition, it is necessary to submit a written statement of the fact that the written error was not intentional.

It would be appropriate to make the amendment within the allowable time limit for submissions of the certified copy of the application previously filed. (Within 3 months from the filing date of the subsequent design application in Japan)

Amendment can be made only when it is not necessary to amend the filing date of the previous application and the purpose of the amendment is to amend an obvious error of the country name (or the name of the intergovernmental organization) stated in the priority declaration to correspond to that stated in the certified copy of the application previously filed.

In addition, it is necessary to submit a written statement of the fact that the written error was not intentional.

Amendment can be made only when it is for the purpose of correcting an obvious error of the filing number of the previous application to correspond to that stated in the certified copy of the application previously filed.

### **4.1.3 KIPO**

Obvious errors such as typos indicated in priority declaration can be modified.

In case a priority claim date indicated in the application is not correct, it can be fixed to match the date of the priority documents provided.

In case the country name indicated in the application is not correct, it can be fixed to match the country name of the priority documents provided.

In case the application number indicated in the application is not correct, it can be fixed to match the application number of the priority documents provided

The amendment should be submitted within 3 months of the filing date of application. However, amendment can be made in case obvious typos are found in the description of a priority claim. Applicants can amend the application documents before a notification of decision on whether design registration is granted is issued even if the period is expired.

### **4.1.4 SIPO**

The filing date of previous application which indicated in priority declaration can be modified.

The applicant shall, in his declaration, indicate the filing date and the application number of the previous application, which is the basis of the right of priority, and the name of the authority with which the application was first filed. Where one or two items of the date of filing, the filing application number of the earlier application and the name of the authority with which the application was first filed are missing or incorrect in the request, and the applicant has submitted a copy of the previous application document within the prescribed time limit, the

examiner shall issue the Notification to Rectify Formalities. If the applicant fails to make any response within the time limit or the requirements are not met after rectification, the examiner shall issue the Notification that Claim to Priority Deemed Not to Have Been Made.

The names of the countries or intergovernmental organizations or the application number of the previous application indicated in priority declaration can be modified.

#### **4.1.5 USPTO**

An applicant may amend a priority claim in a design application or a nonprovisional international design application by filing a corrected application data sheet in compliance with 37 CFR 1.76(c) that corrects the reference to the foreign application, in conjunction with a request for a corrected filing receipt, during the pendency of the design or nonprovisional international design application.

After such time, a grantable petition under 37 CFR 1.55(e) would be required to accept the unintentionally delayed (amended) claim for priority.

Note that an application data sheet filed after final rejection or allowance is not entered as a matter of right and must be filed in compliance with 37 CFR 1.116 or 1.312, respectively.

If the amended claim for priority is filed after the date the issue fee is paid, the patent will not include the priority claim unless corrected by a certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323. See 37 CFR 1.55(g).

### **4.2 Priority Assignment**

#### **4.2.1 EUIPO**

Priority can be claimed by the applicant of the first application or its successor in title (Article 41(1) CDR).

Where an application for a Community design is filed by a successor in title, the first application must have been transferred prior to the filing date of the Community design application, and documentation to this effect must be provided.

The right of priority as such may be transferred independently of the first application. Priority can therefore be accepted even if the owners of the Community design and the previous application are different, provided that evidence of assignment of the priority right is supplied.

In this case, the execution date of the assignment must be prior to the filing date of the Community design application. (Guidelines, Chapter 6.2.1.1., page 60)

Priority can be claimed by the applicant of the first application or its successor in title. In the latter case, the first application must have been transferred prior to the filing date of the

Community design application, and documentation to this effect must be provided.

The right of priority “is an autonomous right in that it exists independently of the eventual outcome of that initial application” (General Court of the European Union, case T-128/99, “Teleye”, para. 42).

Taken as an “autonomous right”, the right of priority may be transferred independently of the first application.

The proprietor of the first application can decide to transfer the entirety of the rights on the first application to a third party in order that this third party can claim its priority in a Community design application. If the first application is transferred in its entirety to a third party, the name of the proprietor of the first application and of the Community design application claiming priority will be the same. It will be assumed in such a case that the transfer included the right to claim the priority of the first application.

Alternatively, the proprietor of the first application can decide to transfer only the right of priority attached to this first application. In such a case, the name of the proprietor of the first application and of the Community design application claiming priority will remain different. In order to explain this discrepancy, the Community design applicant which claims priority must submit a document of transfer establishing that he is the successor in title of the proprietor of the first application as far as the right of priority (and only this right) is concerned.

The execution date of the assignment (of the first application in its entirety or only in respect of the right of priority) must be prior to the filing date of the Community design application.

Subsidiary or associated companies of the applicant are not considered to be the same legal entity as the Community design applicant itself.

When, in reply to an objection by the examiner on a discrepancy between the identity of the applicant and that of the previous application holder, the applicant explains that this is due to a corporate name change, a document establishing this change of corporate name must be submitted within two months. (Guidelines, Chapter 6.2.1.1., page 60)

#### **4.2.2 JPO**

The applicant of the subsequent application has to be the applicant of the previous application or his/her successor in title. In the case where the applicant of the subsequent application is different from the previous applicant, the applicant of the subsequent application shall be deemed to be the person entitled to claim priority as a result of legal transfer of the rights between the parties. But it is not required to submit a document certifying the assignment of the priority rights.

The applicant(s) of the subsequent application and the previous applicant(s) have to be nationals of the member country of the Paris Convention or the WTO.(Article 43-3 of the Patent Act as applied mutatis mutandis pursuant to Article 15(1) of the Design Act.)

#### **4.2.3 KIPO**

A person who claims the right of priority shall be the same as the applicant of the previous application on which the priority claim is based.

When applicants differ, a document certifying the assignment of the right to obtain design registration is required

#### **4.2.4 SIPO**

The applicant(s) of the subsequent application shall be the same as the previous applicant(s).

Where the applicants of the two applications are entirely different, and the right of priority of the previous application has been assigned to the applicant of the subsequent application, a document certifying the assignment of the right of priority, signed or sealed by all of the applicants of the previous application, shall be submitted within three months from the filing date of the subsequent application. Where the previous application has several applicants and the subsequent application has several different applicants, a document certifying the assignment of the right of priority, signed or sealed by all of the applicants of the previous application, to all of the applicants of the subsequent application may be submitted; or a document certifying the assignment of the right of priority, signed or sealed respectively by all of the applicants of the previous application, to the applicants of the subsequent application may be submitted.

#### **4.2.5 USPTO**

The foreign application must have been filed by the same applicant as the applicant in the United States, or by his or her legal representatives or assigns. Consistent with longstanding USPTO policy, this is interpreted to mean that the U.S. and foreign applications must name the same inventor or have at least one joint inventor in common. See MPEP § 213.02.

A document certifying the assignment of the right of priority is not required, but the foreign application must have been filed by the same applicant as the applicant in the United States, or by his or her legal representatives or assigns.

For example, a right of priority does not exist in the case of an application of sole inventor A in the foreign country and sole inventor B in the United States, even though the two applications

may be owned by the same party. See MPEP § 213.02.

## **4.3 Notifications Involved in the Priority Examination**

### **4.3.1 EUIPO**

The examiner will not invite the applicant to make amendments, however, an objection will be issued where applicant has not complied with one or more of the following conditions

The Office limits itself to verifying whether the formalities relating to a priority claim have been complied with (Article 45(2)(d) CDR), that is,

1. whether priority was claimed within six months of filing the first application;
2. whether priority was claimed when filing the application or within one month of the filing date;
3. whether the details and the copy of the previous application were submitted in due time (within three months of either the filing date or, as the case may be, receipt of the declaration of priority);
4. whether it is specified that the previous application concerns a design or a utility model;
5. whether the previous application was filed in a country that is a member of the Paris Convention or the World Trade Organization (WTO), or in another state with which there is a reciprocity agreement;
6. whether the previous application was a first filing (meaning that a priority claim should be rejected if the priority application in turn claimed priority);
7. whether the proprietor is the same or whether a transfer document establishes the Community design applicant's right to claim the priority of a previous application originally filed by another applicant.

The deficiencies are not remedied in due time or cannot be remedied, the Office will inform the applicant of the loss of the priority right and of the possibility of requesting a formal (i.e. appealable) decision on that loss (Article 46(1) and (4) CDR; Article 40(2) CDIR).

If the deficiencies that are not remedied concern only some of the designs contained in a multiple application, the right of priority will be lost in respect only of the individual designs concerned (Article 10(8) CDIR).

Where remediable deficiencies are found, the examiner will request the applicant to remedy them within two months. (Guidelines, Chapter 6.2.1.1., page 57)

### **4.3.2 JPO**

There are cases where we invite the applicant to make an amendment of the “declaration” when



the country name or the filing date stated in the “declaration” is inconsistent with that in the “certified copy”. This procedure is undertaken in the name of the Commissioner of the Patent Office and not of examiners.

In the cases where the certified copy of the application previously filed is not submitted within 3 months from the filing date of the design application, the priority claim for the application loses its effect. However, no notice would be issued to inform the fact.

#### **4.3.3 KIPO**

If one out of the applicant, application date, country name and product indication in the design application is different from that of the previous application, an advance notification of denial on the priority claim shall be provided and the applicant can remedy it by correcting the application.

If the applicant does not correct the application in due time or does not appropriately correct it after receiving an advance notification of denial on the priority claim due to discrepancy between the previous and subsequent applications, the notification of denial shall be provided. Within two months of the notification date, applicant should give response.

#### **4.3.4 SIPO**

Where such one or two items as the date of filing, the filing number of the earlier application or the title of the authority with which the earlier application was filed are missing or incorrect in the request when claiming for right of priority, the patent administration department under the State Council shall notify the applicant to make rectification within the specified time limit. Where the applicant fails to make the rectification within the time limit, the right of priority shall be deemed not to have been claimed.

Where the name or title of the applicant who claims the right of priority is not the same as the one recorded in the copy of the earlier application, the applicant shall submit document certifying the assignment of right of priority. If no such document is submitted, the right of priority shall be deemed not to have been claimed.

#### **4.3.5 USPTO**

The examiner will not invite the applicant to make amendments, however, notification may be issued where applicant has not complied with one or more of the conditions specified in 35 U.S.C. 119 and 37 CFR 1.55. For example, if applicant filed a certified copy that does not correspond to the foreign application identified in the foreign priority claim by its application

number, country (or intellectual property authority), day, month, and year of its filing, or where applicant has filed a certified copy of a foreign application but has not made a claim for foreign priority, the applicant should be notified. See MPEP § 215, subsection IV.

If the claim to priority is not presented in the manner and within the time period provided by 37 CFR 1.55 the claim is considered to have been waived. See 35 U.S.C. 119(b)(2) and 37 CFR 1.55(e). Applicants are advised that only the foreign priority claims that are listed on the filing receipt have been recognized by the USPTO.

Unless filed with a petition under 37 CFR 1.55(e), the foreign priority claim must be submitted during the pendency of the design or nonprovisional international design application. See 37 CFR 1.55(g).

## **4.4 Restoration of Claim to Right of Priority**

### **4.4.1 EUIPO**

If an applicant does not comply with the time limit for (i) submitting his priority claim or (ii) the documents in support of this claim, the claim of priority will be refused which implies a loss of right for this applicant.

Only in those cases he can apply for the reinstatement (same thing as resoration) of his right to claim priority of the first application. He must show that the below conditions are met.

The applicant who, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit vis-à-vis the Office shall, upon application, have his rights re-established if the non-observance in question has the direct consequence, by virtue of the provisions of this Regulation, of causing the loss of any rights or means of redress (Article 67(1) CDR).

However reinstatement/restoration of the right is not available in respect of time limits referred to in Article 41(1) CDR that is, the 6-month time limit from the date of filing of the first application to file a subsequent application.

However, reinstatement/restoration of the right may be applied in respect of the three-month time limit for providing the file number of the previous application and filing a copy of it, as specified in Article 8(1) CDIR (Guidelines for Examination in the Office, Part A, General Rules, page 6).

The priority period, which is the six-month time limit for filing an application claiming the priority of a previous design or utility model application pursuant to Article 41(1) CDR, can never be restored.

According to Article 67(5) CDR, the re-establishment of rights cannot be applied for in respect of the time limits referred to in Article 41(1) that is, the 6-month time limit after the filing of the first application to file a Community design application.

In turn, provided the Community design application was filed within this 6-month period, the time limits for submitting the priority claim or for submitting the documents in support of this claim can be the subject of a request for re-establishment of the rights.

Regarding the three-month time limit for providing the file number of the previous application and filing a copy of it, as specified in Article 8(1) CDIR, the application for reinstatement/restoration must be filed in writing within two months of the removal of the cause of non-compliance with the time limit. The omitted act must be completed within this period. The application shall only be admissible within the year immediately following the expiry of the unobserved time limit.

The priority claim cannot be re-established if the foregoing time limits are not respected.

#### **4.4.2 JPO**

It is not allowed to request restoration of the right to claim priority for design applications. On the other hand, there is a remedy for a delayed submission of a certified copy. That is, where, due to reasons beyond the control of the applicant, the applicant is unable to submit the certified copy within the prescribed time limit (3 months from the filing date of the design application), the applicant may submit the certified copy within the time limit as provided in Ordinance of the Ministry of Economy, Trade and Industry (e.g. in case of a delay of the IP office in issuing the certified copy, one month (for residents in Japan) or two months (for overseas residents) from the receipt of the certified copy by the applicant.) (Article 43(8) of the Patent Act as applied mutatis mutandis pursuant to Article 15(1) of the Design Act, Article 27-3-3(6) of the Ordinance for Enforcement of the Patent Act as applied mutatis mutandis pursuant to Article 19(3) of the Ordinance for Enforcement of the Design Act).

#### **4.4.3 KIPO**

It is not allowed to request restoration of the right to claim priority for design right(Article 51(4) of the Design Protection Act).

#### **4.4.4 SIPO**

In situations the applicant may request to restore the right of claiming priority

(1)where the claim to the right of priority is deemed not to have been made because the

applicant has failed to make any response to the Notification to Rectify Formalities within the specified time limit;

(2) where at least one item is filled correctly in the declaration claiming the priority, but the copy of the previous application document or the document certifying the assignment of the right of priority has not been submitted within the prescribed time limit;

(3) where at least one item is filled correctly in the declaration claiming the priority, but the fee for claiming the right of priority has not been paid or not paid in full within the prescribed time limit; or

(4) where the initial application of the divisional application has claimed the right of priority.

In situations the right of claiming priority may not be restored

Except for the above circumstances, the right of priority that is deemed not to have been made due to other reasons shall not be restored. For example, where the claim to the right of priority is deemed not to have been made by reason that the applicant fails to make a declaration in the request when the patent application is filed, the right of claiming priority shall not be restored.

#### **4.4.5 USPTO**

In the case of a design application, if the subsequent application has a filing date which is after the expiration of the six-month period, but within two months from the expiration of the period, the right of priority in the subsequent application may be restored upon petition under 37 CFR 1.55(c), if the delay in filing the subsequent application within the period was unintentional. See MPEP §213.03, subsection III.

If the subsequent application has a filing date which is more than two-months after the expiration of the six-month period in the case of a design application or if the delay in filing the subsequent application within the six-month period was not unintentional, the right of priority in the subsequent application cannot be restored.. See MPEP § 213.03, subsection III.

### **4.5 Withdrawal of Claim to the Right of Priority**

#### **4.5.1 EUIPO**

The applicant may at any time withdraw a Community design application or, in the case of a multiple application, withdraw some of the designs contained in the application (Article 12 CDIR). By analogy, a priority claim can be withdrawn at any time.

#### **4.5.2 JPO**

The declaration may not be withdrawn as there is no provision in the national laws.

### **4.5.3 KIPO**

It is possible to withdraw the declaration of claiming priority. (Enforcement Rule of Design Protection Act 33)

### **4.5.4 SIPO**

The applicant may withdraw his claim to the right of priority after claiming the priority. Where multiple priorities are claimed, the applicant may withdraw his claim to one or some or all of the rights of priority.

### **4.5.5 USPTO**

Where a foreign priority claim is being deleted, applicant must provide a corrected application data sheet (37 CFR 1.76) identifying the deletion of the priority claim with strike-through or brackets.

Note that an application data sheet filed after final rejection or allowance is not entered as a matter of right and must be filed in compliance with 37 CFR 1.116 or 1.312, respectively.

## **5 Judgment of the Same Subject Matter**

### **5.1 Principle of Judgment**

#### **5.1.1 EUIPO**

There is no case-law on this issue so far.

The EUIPO practice is to consider that the subject- matter of the previous application must be identical to that of the corresponding Community design, without the addition or suppression of any features.

#### **5.1.2 JPO**

It is necessary that the design in the design application filed in Japan is identical with the design in the previous application that serves as the basis for the right of priority.(Articles 4A(1) and 4B of the Paris Convention)

Basic concept of "identicalness of design" in approval of a priority claim under the Paris Convention (101.3 of the Examination Guidelines for Design)

(1) Regardless of the style of expression of the design, it is sufficient that the design that is substantially identical with the design in the design application filed in Japan is described in the certified priority document (priority certificate).

(2) Whether or not the design in the design application filed in Japan is described in the priority

certificate should be determined on the basis of the ordinary knowledge in the art of the design by making comprehensive determination based on the contents of the entire priority certificate.

(3) The finding of the design described in the priority certificate (the article to the design, the shape, pattern and color of the article, the position, size and scope of the part for which design registration is requested in the entire design, etc.) should be made by taking into consideration the laws and regulations of the country in which the first (previous) application was filed.

### **5.1.3 KIPO**

[ General principles of determining the identity between a design on which the priority claim shall be based and a design claimed in an application filed in the Republic of Korea]

(1) If a design that is substantively identical with a design claimed in an application filed in the Republic of Korea is included in designs stated in documents verifying priority rights, the identity between a design on which the priority claim shall be based, and a design claimed in an application filed in the Republic of Korea shall be determined, irrespective of the form of an application or the method to represent the design.

(2) The decision on whether a design claimed in an application filed in the Republic of Korea is represented in documents verifying priority rights shall be made based on the ordinary skill in the art to which the design pertains in light of the description as a whole of documents verifying priority rights, the system of the State in which the initial application was filed, etc.

[ Method to determine the identity of designs]

(1) If the form of design to be registered in the first filed country is substantively identical with the form of design to be registered in the Republic of Korea, the identity of designs is recognized.

(2) If an application for the registration of design that can be prepared in light of the description of documents verifying priority rights, features of article, etc., is filed in the Republic of Korea, the identity of designs is recognized.

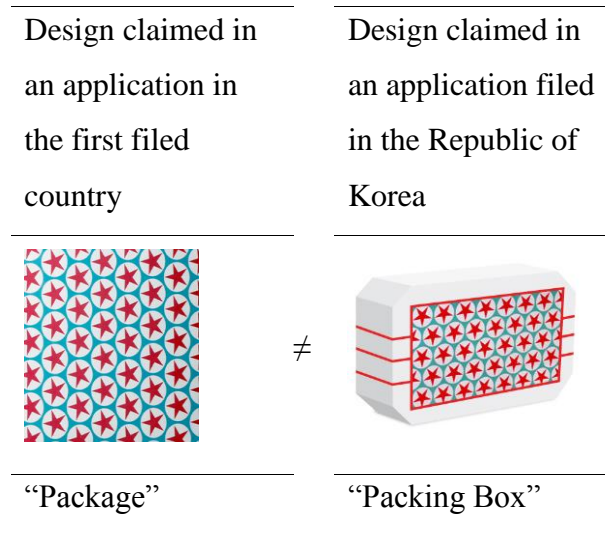
(Example) The application filed in the first filed country is a design of “CARDAN DE MONTER (hour plate for clock),” close to a flat article, and only a perspective view is shown. The application filed in the Republic of Korea shows drawings for remaining parts that represent a design of “hour plate for watch,” and the design drawn from such drawings is substantively identical with a design drawn from the perspective view represented in the documents verifying priority rights.

(3) If the position, size, and scope of a part to have the design registered cannot be limited even in light of the description of documents verifying priority rights, etc., the identity of designs is

not recognized.

(Example) The product indication is stated as “Package” in an application filed in the first filed country, and a drawing thereof shows a flat pattern only.

An application for partial design registration filed in the Republic of Korea states the product indication as “Packing box,” and its pattern is shown in a part of the design for a whole article of a packing box.



(4) Where the documents verifying priority rights represent designs for various articles and an application for design registration is filed for all or part of such composing articles as a design for a set of articles prescribed by Table 5 (Classification of a Set of Articles) of the Rule or a design that is recognized as a set of articles, the identity of designs is recognized.

(5) Where an application for design registration filed in the Republic of Korea represents a design formed by combining designs based on a number of priority claims, such designs are not recognized as identical.

(Example) An application filed in the first filed country is for a design of the “body of a watch,” and an application filed in the second country is for a design of the “watch strap.” An application filed in the Republic of Korea represents the “watch” that is the design of a finished product.

(6) Where a design represented in documents verifying priority rights is the design of a finished product, and an application filed in the Republic of Korea represents a design of one part that composes such finished product, the identity of designs is not recognized.

(7) Where the design represented in documents verifying priority rights is an application for registration of design for a whole article, and an application filed in the Republic of Korea is for a partial design, the identity of designs is not recognized.

(8) Where an application for registration of a design represented in a reference drawing among drawings included in documents verifying priority rights is filed in the Republic of Korea, the

identity of designs is not recognized.

#### **5.1.4 SIPO**

The determination of same subject matter for designs shall be based on the design application subsequently filed in China and the content indicated in the first foreign design application.

Designs of same subject matter shall meet both of the following two conditions:

- (1) both of the designs are for same products ; and
- (2) the claimed design in the subsequent application in China is clearly shown in the first foreign application.

#### **5.1.5 USPTO**

The foreign application must be for the same invention as the application in the United States.

See 35 U.S.C. 119(a) and MPEP § 213.

### **5.2 Various Cases**

#### **5.2.1 EUIPO**

##### ① Patent Type

The priority of a previous design or utility model application may be claimed, including that of a previous Community design or an international design registration.

A priority claim based on a previous patent application will in principle be refused. However, the priority of an international application filed under the Patent Cooperation Treaty (PCT) can be claimed, since Article 2 of the PCT defines the term ‘patent’ in a broad sense that covers utility models.

A priority claim can be based on a previous application filed with the United States Patent and Trademark Office (USPTO) only if the subject- matter of the previous application relates to a ‘design patent’, not a ‘patent’. (Guidelines, Chapter 6.2.1.1., page 59)

##### ② Indication of the product

The Office does not verify whether the priority claim relates to ‘the same design or utility model’, including in respect of the identification of the product. The priority claim will be accepted even if the indication of product is different in the first application and the subsequent application for a Community design.

The examination of a priority claim will, however, be carried out by the Office if, in the context of requests for invalidity, the applicant for invalidity challenges the validity of the priority claim of the contested Community design, or if the holder of the contested Community design



challenges the effects of the disclosure of a design, for the purpose of Articles 5, 6 and 7 CDR, where this disclosure occurred within the priority period.

Where the validity of the priority claim is determinative of the outcome of the application, the Office may either take position on the validity of this claim in the decision on the merits of the case, or stay the proceedings on its own motion to allow the holder to remedy possible deficiencies within a given time limit (Article 45(2)(d) CDR; Articles 1(1)(f) and 10(3)(c), and Article 10(7) and (8) CDIR).

Whether the requirement that the Community design is for the ‘same design or utility model’ as the first application, extends to the identification of the product has not yet been decided by the Office.

However, given that the identification of the products in which the design is intended to be incorporated or to which it is intended to be applied does affect the scope of protection of the design as such (Article 36(6) CDR), there are arguments in support of the view that an identity of the product identified in the first and subsequent application is not required.

### ③ The entire and Partial Design

When examining an application for a Community design, the Office does not verify whether this application concerns the ‘same design or utility model’ whose priority is claimed. However, this can be examined in the context of requests for invalidity against Community designs (see above).

However, if the subsequent application is an entire design which has additional features compared to the first application (namely the features which were disclaimed in the first application), EUIPO considers that the subsequent application is not for the ‘same design’ as the first application.

Thus, if a cancellation action is filed against such a Community design, on the basis of a previous design which has been disclosed during the period covered by the priority claim, EUIPO would have to examine the validity of the priority claim and would come to the conclusion that it is not valid.

In this context, the Office considers that a priority claim relating to the ‘same design or utility model’ requires identity with the corresponding Community design without addition or suppression of features. A priority claim is however valid if the Community design and the previous application for a design right or a utility model differ only in immaterial details (Guidelines on Examination of Design Invalidity Applications, page 31).

The previous application is a partial design (solid line shows the claimed part and dotted line shows the part which is not claimed to be protected), the subsequent application is an entire

design which have amended the dotted line into solid line. In such a case,, the subsequent application is an entire design which has additional features compared to the first application, namely the features which were disclaimed in the first application. The Office would consider that the subsequent application is not for the ‘same design’ as the first application.

If the previous application is a partial design, the subsequent application is a design of spare part, which has been showed by solid line in the previous application, it is same as the case above.

But it is difficult to answer such a example that The previous application is a partial design, while the subsequent application is also a partial design, but the location, size and proportion of the partial design is not the same as in the previous application. Since the disclaimed elements represented in dotted lines are the part of the subject-matter of the protection, there are arguments to support the view that the two designs are the same for the purpose of claiming priority.

#### ④ The Color

If the color between the previous application and the subsequent application is different, the determination of whether the subsequent application can claim priority on the basis of the previous application will depend on whether the colour can be considered an ‘immaterial detail’ of the two designs. This will depend on the nature of the product, the importance given to the colour in the designs and the how unusual this colour is in respect of the product at issue.

#### ⑤ The Number of View

If the previous application only has a stereoscopic drawing, the subsequent application has six-side views and a stereoscopic drawing, or If the previous application has six-side views and a stereoscopic drawing, the subsequent application only has a stereoscopic drawing, the determination of whether the subsequent application can claim priority on the basis of the previous application, will depend on whether the 6 views disclose additional features which were not visible in the stereoscopic drawing. If so (which is very likely), it will be examined whether such features are ‘immaterial details’ (which is rather unlikely).

#### ⑥ The Type of View

There can be an identity of designs even if their representation uses different means such as drawing versus photograph. According to the Office, the determinative factor is whether all the features visible in the first application are also visible in the subsequent application.

For the difference of view type between the subsequent application and the previous application, The risk of using pictures in the subsequent application while the first application uses drawings, or vice versa, is that additional colour elements could be disclosed on the photographs, unless

there are in black and white.

#### ⑦ Multiple Priorities

According to the Office's practice, If the previous applications are designs of spare parts, the subsequent application is a design of a whole product containing those spare parts, the subsequent application must be compared with each of the previous applications. The designs would therefore be different.

### **5.2.2 JPO**

#### ① Patent Type

It is possible to claim priority in a design application filed in Japan on the basis of a patent or utility model application filed with the Office of first filing. This is because in Japan, a patent application or a utility model application can be converted into a design application.

#### ② Indication of the product

In principle, in order for the design described in the priority certificate to be found identical with the design in the design application filed in Japan, the indication of product (article to the design) must be identical.

However, since the requirements for the indication of the product or the name of the article to be stated in the application differs among countries, even where the indication of the product stated in the priority certificate differs from the "Article to the Design" stated in the design application filed in Japan, if the difference is considered to be inevitable due to differences in the laws and regulations, etc. of the respective countries, the indication of the product stated in the priority certificate and the article to the design in the design application filed in Japan are found to be identical for the purposes of determining the approvability of the right of priority. (101.3.1 of the Examination Guidelines for Design)

#### ③ The entire and Partial Design

If the previous application is a partial design (solid line shows the claimed part and dotted line shows the part which is not claimed to be protected), the subsequent application is an entire design which have amended the dotted line into solid line, the effects of priority claim is not approved since the designs represented cannot be acknowledged as being identical.

(71.13(4) of the Examination Guidelines for Design)

If the previous application is a partial design, the subsequent application is a design of spare part, which has been showed by solid line in the previous application, the effects of priority claim is not approved since the designs represented cannot be acknowledged as being identical. If the previous application is a partial design, while the subsequent application is also a partial

design, but the location, size and proportion of the partial design is not the same as in the previous application, or If the previous application is a design of an entire product, the subsequent application is a partial design of the product, in both of the case, the effects of priority claim is not approved since the designs represented cannot be acknowledged as being identical.(71.13(1) and (2) of the Examination Guidelines for Design)

Refer to the Examples 1 and 2 for the item of “The indication of the product” above. If only the graphic image of the GUI is shown in the drawing of the previous application, the design will not be acknowledged as being identical and therefore, the effects of priority claim will not be approved.

#### ④ The Color

Color is one of the elements that would constitute a design. Therefore, when elements of the designs are different, the effects of priority claim will not be approved. However, even when the methods of representation are different, if it is possible to reach a conclusion that the designs are identical by making a comprehensive judgment of the contents of the priority certificate, the above will not apply.

#### ⑤ The Number of View

Where a specific form of the part not shown in the stereoscopic drawing of the previous application but appears in the subsequent application cannot be derived, by making comprehensive determination, from the contents of the entire priority certificate, the designs are not found to be identical.

However, there may be exceptional cases where the specific form of the part not shown in a stereoscopic drawing can be derived by such reasons as the form of the part in question is more or less fixed (or should be the mirror image, etc.) taking the general characteristics of the article into consideration. (101.3.3.1 of the Examination Guidelines for Design)

In Japan, an application that only has a stereoscopic drawing attached is not assumed in general. However, it should be noted that the effects of priority claim will not be denied due only to differences in the method of drawing (method of projection). (101.3.5 of the Examination Guidelines for Design)

#### ⑥ The Type of View

Even when the methods of representation are different, if it is possible to reach a conclusion that the designs are identical by making a comprehensive judgment from the contents of the priority certificate, the effects of priority claim will be approved. (101.3.5 of the Examination Guidelines for Design)

#### ⑦ Multiple Priorities

Articles and the shapes are different for the designs of individual parts (e.g., Tires) and the design of the whole product (e.g., Bicycle). Therefore, they are not acknowledged as being identical and accordingly the effects of priority claim will not be approved. Multiple priorities are not allowed.(101.3.4.1 of the Examination Guidelines for Design)

### **5.2.3 KIPO**

#### ① Patent Type

It is possible to claim priority based on either a patent or utility model of the previous application, provided that if design features are fully described in the drawings submitted for the patent claim.

#### ② Indication of the product

When the purpose and function of an article in a design between the previous application and the subsequent application are substantively identical, they shall be considered the same despite different indications.

#### ③ The entire and Partial Design

If the previous application is a partial design (solid line shows the claimed part and dotted line shows the part which is not claimed to be protected), the subsequent application is an entire design which have amended the dotted line into solid line, when the subsequent application claims the right of priority of the previous application, an advance notification of denial on the priority claim will be provided while requesting the applicant to correct it.

If the previous application is a partial design, the subsequent application is a design of spare part, which has been showed by solid line in the previous application, when the subsequent application claims the right of priority of the previous application, an advance notification of denial on the priority claim will be provided while requesting the applicant to correct it.

The previous application is a partial design, while the subsequent application is also a partial design, but the location, size and proportion of the partial design is not the same as in the previous application. When the subsequent application claims the right of priority of the previous application, an advance notification of denial on the priority claim will be provided while requesting the applicant to correct it. If the location, size and proportion of the partial design cannot be limited even after considering all the descriptions in the priority document, the previous and subsequent applications shall not be considered the same.

If the previous application is a design of an entire product, the subsequent application is a partial design of the product, when the subsequent application claims the right of priority of the previous application, an advance notification of denial on the priority claim will be provided while requesting the applicant to correct it.

#### ④ The Color

If the color between the previous application and the subsequent application is different, when the subsequent application claims the right of priority of the previous application, an advance notification of denial on the priority claim will be provided while requesting the applicant to correct it.

#### ⑤ The Number of View

If the previous application only has a stereoscopic drawing, the subsequent application has six-side views and a stereoscopic drawing, or if the previous application has six-side views and a stereoscopic drawing, the subsequent application only has a stereoscopic drawing, when the two designs are deemed to be substantively identical, it shall be considered the same, and the subsequent application may claim the right of priority of the previous application.

Meanwhile, KIPO requires drawings to show the overall shape of the design.

#### ⑥ The Type of View

If the previous application uses photograph, the subsequent application uses drawing, or if the previous application uses drawing, the subsequent application uses photograph, when the two designs are deemed to be substantively identical, it shall be considered the same, and the subsequent application may claim the right of priority of the previous application.

#### ⑦ Multiple Priorities

Multiple priorities are not allowed.

### **5.2.4 SIPO**

#### ① Patent Type

The determination of same subject matter for designs shall meet the condition that the claimed design in the subsequent application in China is clearly shown in the first foreign application.

#### ② Indication of the product

The name of the product incorporating the design may explain the category of the product as shown in the drawings or photographs. The subsequent application and the foreign design application should be both of the designs are for same products

#### ③ The entire and Partial Design

In China, we only protect entire design now. If the previous application is a design with dotted line, and the subsequent application which have amended the dotted line into solid line, then the subsequent application may claim the right of priority of the previous application

When we judge that whether the subsequent application may enjoy the right of priority of the

first foreign application, the two factors which are designs are for same products and the claimed design in the subsequent application in China is clearly shown in the first foreign application would be taken into consideration.

#### ④ The Color

For the case one, the difference between the previous application and the subsequent application is only color, the subsequent application could claim the right of priority of the previous application

#### ⑤ The Number of View

If the previous application only has a stereoscopic drawing, the subsequent application has six-side views and a stereoscopic drawing, or if the previous application has six-side views and a stereoscopic drawing, the subsequent application only has a stereoscopic drawing, the determination of whether the subsequent application can claim priority on the basis of the previous application, is based on the condition that the claimed design in the subsequent application in China is clearly shown in the first foreign application.

#### ⑥ The Type of View

If the previous application uses photograph, the subsequent application uses drawing, or if the previous application uses drawing, the subsequent application uses photograph, The determination of whether the subsequent application can claim priority on the basis of the previous application, is based on the condition that the claimed design in the subsequent application in China is clearly shown in the first foreign application.

#### ⑦ Multiple Priorities

For case 2, the subsequent application may claim the right of priority of the previous application

### **5.2.5 USPTO**

#### ① Patent Type

The determination of whether the subsequent application can claim priority on the basis of the previous application, is based on whether the corresponding foreign application supports the claim of the subsequent application in the manner required by 35 U.S.C. 112(a). See MPEP § 2163.03, subsection III.

#### ② Indication of the product

The determination of whether the subsequent application can claim priority on the basis of the previous application, is based on whether the corresponding foreign application supports the

claim of the subsequent application in the manner required by 35 U.S.C. 112(a). See MPEP § 2163.03, subsection III.

③ The entire and Partial Design

The determination of whether the subsequent application can claim priority on the basis of the previous application, is based on whether the corresponding foreign application supports the claim of the subsequent application in the manner required by 35 U.S.C. 112(a). See MPEP § 2163.03, subsection III.

④ The Color

If the color between the previous application and the subsequent application is different, the determination of whether the subsequent application can claim priority on the basis of the previous application, is based on whether the corresponding foreign application supports the claim of the subsequent application in the manner required by 35 U.S.C. 112(a). See MPEP § 2163.03, subsection III.

⑤ The Number of View

If the previous application only has a stereoscopic drawing, the subsequent application has six-side views and a stereoscopic drawing, or if the previous application has six-side views and a stereoscopic drawing, the subsequent application only has a stereoscopic drawing, The determination of whether the subsequent application can claim priority on the basis of the previous application, is based on whether the corresponding foreign application supports the claim of the subsequent application in the manner required by 35 U.S.C. 112(a). See MPEP § 2163.03, subsection III.

⑥ The Type of View

If the previous application uses photograph, the subsequent application uses drawing, or if the previous application uses drawing, the subsequent application uses photograph, the determination of whether the subsequent application can claim priority on the basis of the previous application, is based on whether the corresponding foreign application supports the claim of the subsequent application in the manner required by 35 U.S.C. 112(a). See MPEP § 2163.03, subsection III.

⑦ Multiple Priorities

The determination of whether the subsequent application can claim priority on the basis of the previous application, is based on whether the corresponding foreign application supports the claim of the subsequent application in the manner required by 35 U.S.C. 112(a). See MPEP § 2163.03, subsection III.



## 6 Others

### 6.1 Examples

#### JPO

[Example of a case where the article to the design (the indication of the product) is found to be identical]

(Example 1)

Previous application: The indication of the product is "Graphical user interfaces" and the drawing contains a front view of a mobile phone in a state where a graphic image is displayed on the screen (the graphic image is depicted in solid lines and the rest in broken lines).

Subsequent application in Japan: It is an application of a partial design. The article to the design is "Mobile phone" and the part for which the design registration is requested is the display part of the mobile phone on which a graphic image is displayed. Meanwhile, the form of the other parts than the display part is depicted in broken lines and consistent with that of the mobile phone described in broken lines in the priority certificate.

(Explanation)

In certain countries, there are cases where design registration can be obtained for a graphic image alone without specifying the article to which the graphic image is to be used. Therefore, even where the indication of the product stated in the priority certificate does not specify a certain "article", if the (specific) article to the design stated in the design application filed in Japan can be derived, by making comprehensive determination, from the entire contents of the priority certificate (e.g. the priority certificate contains a view in which the graphic image is displayed on a specific article), the indication of the product stated in the priority certificate and the article to the design in the design application filed in Japan are found to be identical for the purposes of determining the approvability of the right of priority.

[Example of a case where the article to the design (the indication of the product) is NOT found to be identical]

(Example 2)

Previous application: The indication of the product is "Logos" and only a graphic image (pattern) is shown in the drawing.

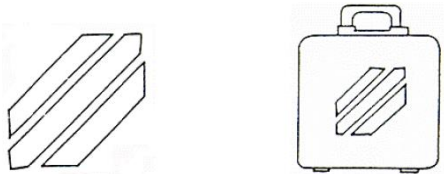
Subsequent application filed in Japan: The article to the design is a "Briefcase" and the form of a briefcase with the pattern is shown in the drawing.

(Explanation)

In the above example, a shape of the briefcase is added to the original design which consists

only of a pattern. The effects of priority claim will not be approved when the design in a design application filed in Japan includes elements that are not indicated or described in the priority certificate.

Previous application    Subsequent application filed in Japan



[Example of a case where the article to the design (the indication of the product) is found to be identical]

(Example 3)

Previous application: The indication of the product is “furniture” and the drawing contains the form of a chair.

Subsequent application in Japan: The article to the design is stated as "Chair"

(Explanation)

While the indication of the product in the priority certificate is stated as a generic name, the article to the design in the design application filed in Japan is stated as a specific name of article that falls under the said generic name.

[Example of a case where the design is found to be identical]

Example 4

Previous application: A design of a nail. It is represented by uncolored drawings, but the application contains a description stating that it is made of iron.

Subsequent application in Japan: A design of a nail. It is represented by photographs, and it has the metallic luster and metallic color that would appear on an ordinary nail made of iron. (101.3.5 of the Examination Guidelines for Design)



## **KIPO**

[ Method to determine the identity of articles }

(1) If the purpose and function of an article in a design claimed in the initial application is substantively identical with the purpose and function of an article in a design claimed in an application filed in the Republic of Korea in light of the description of documents verifying priority rights, the identity of articles shall, even if the product indication in a design claimed in the initial application is different from the product indication in a design claimed in an

application filed in the Republic of Korea, be recognized.

(Example) Documents verifying priority rights state the product indication as “Icon for medical apparatus,” and drawings represent the overall form of medical apparatuses, which include, as a partial design, an operation part composed of a number of icons. In a partial design claimed in an application filed in the Republic of Korea, the product indication is stated as “Blood glucose monitor device in which GUI is indicated,” the overall form of the article is shown, and an icon part to have the design registered is identified and represented as a part to have the partial design registered.

Design claimed in an application in the first filed country	Design claimed in an application filed in the Republic of Korea
	
“Icon for medical apparatus”	“Blood glucose monitor device in which GUI is indicated”

(2) Even if the product indication stated in documents verifying priority rights covers a number of articles, the identity of articles shall be recognized in cases where the name of one article among such articles is stated in an application filed in the Republic of Korea.

(Example) Documents verifying priority rights state the product indication as “Bottle,” and the drawings represent a design of PET bottle for beverages.

An application filed in the Republic of Korea is stated the product indication as “Packing bottle.”

Design claimed in an application in the first filed country	Design claimed in an application filed in the Republic of Korea
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“Bottle”

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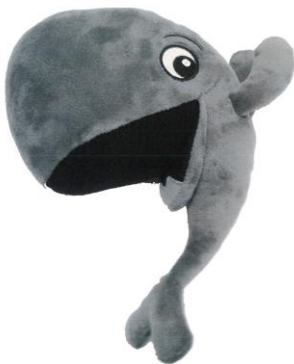


“Packing bottle”

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## SIPO

Example 1:



the previous application



the subsequent application

Example 2:



the previous application 1



the previous application 2



the previous application 3



Design 1

Design 2

Design 3

the subsequent application

## 6.2 Related Provisions

### JPO

#### 1) Extracts from the Design Act

Article 60-10 (1) Articles 43(1) to (4), (8) and (9) (including its mutatis mutandis application in Article 43-3(3) of Patent Act to be applied mutatis mutandis in Article 15(1)) and 43-3(2) of Patent Act to be applied mutatis mutandis in Article 15(1) shall not apply to international applications for design registration.

(2) Article 43(2) to (4), (8) and (9) of Patent Act shall apply mutatis mutandis to a person who has made a declaration of priority under Article 6(1)(a) of Geneva Act. In this case "within one year and four months from the earliest of the following dates" in Article 43(2) of the said Act shall be deemed to be replaced with "within the time limit provided by Ordinance of the Ministry of Economy, Trade and Industry," and "a person who has received notice under paragraph (6)" and "the preceding paragraph" in Article 43(8) shall be deemed to be replaced with "a person who submits documents under paragraph (2)" and "the said paragraph," respectively.

#### 2) Extracts from the Patent Act

(Procedures for a priority claim under the Paris Convention)

Article 43 (1) A person desiring to take advantage of the priority under Article 4.D(1) of the Paris Convention regarding a patent application shall, within the time limit provided in

Ordinance of the Ministry of Economy, Trade and Industry, submit to the Commissioner of the Patent Office a document stating thereof, and specify the country of the Union of the Paris Convention in which the application was first filed, deemed to have been first filed under C(4) of the said Article, or recognized to have been first filed under A(2) of the said Article, and the date of filing of the said application.

(2) A person who has made a declaration of priority under the preceding paragraph shall submit to the Commissioner of the Patent Office a certificate showing the date of filing from the country of the Union of the Paris Convention in which the application was first made, or deemed to have been first made under Article 4.C(4) of the Paris Convention, or recognized to have been first made under A(2) of the said Article, as well as certified copies of those equivalent to the description, scope of claims for patent or utility model registration and drawings submitted at the time of the filing of the application, or any bulletin or certificate equivalent thereto issued by the government of the said country, within one year and four months from the earliest of the following dates:

(i) the date of filing which was first made, deemed to have been first made under Article 4.C(4) of the Paris Convention, or recognized to have been first made under A(2) of the said Article;

(ii) where such patent application contains a priority claim under Article 41(1), the date of filing of the application on which the said priority claim is based; or (iii) where such patent application contains other priority claims under 43(2), paragraph (1) of the next Article (including its mutatis mutandis application under Article 43-3(3)), or 43-3(1) or 43-3(2), the date of filing of the application on which the said priority claim is based.

(3) A person who has made a declaration of priority under paragraph (1) shall, in addition to the documents as provided in the preceding paragraph, submit to the Commissioner of the Patent Office a document specifying the filing number of the application which was first filed, deemed to have been first filed under Article 4.C(4) of the Paris Convention, or recognized to have been first filed under A(2) of the said Article; provided, however, that where such filing number is not available to the person prior to the submission of the documents as provided in the said paragraph, in lieu of the said document, a document specifying the reason thereof shall be submitted and the document specifying such filing number shall be submitted without delay when such number becomes available to the said person.

(4) Where a person who has made a declaration of priority under paragraph (1) fails to submit the documents specified in paragraph (2) within the time limit provided therein, the said priority claim shall lose its effect.

*<Paragraphs (5) to (7) omitted>*

(8) Notwithstanding the preceding paragraph, where, due to reasons beyond the control of a person who has received a notice provided under paragraph (6), the person is unable to submit the documents as provided in paragraph (2) or the document as provided in paragraph (5) within the time limit provided under the preceding paragraph, the person may submit to the Commissioner of the Patent Office the documents or the document within the time limit as provided in Ordinance of the Ministry of Economy, Trade and Industry.

(9) Where the documents specified in paragraph (2) or the document specified in paragraph (5) are submitted under paragraph (7) or the preceding paragraph, paragraph (4) shall not apply.

Article 43-3 (1) A priority claim may be declared in a patent application under Article 4 of the Paris Convention, where the priority claim is based on an application filed by a person specified in the left-hand column of the following table in a country specified in the corresponding right-hand column.

<p>Japanese nationals or nationals of a country of the Union of the Paris Convention (including nationals deemed to be the nationals of the country of the Union in accordance with Article 3 of the Paris Convention - hereinafter the same shall apply in paragraph (2)).</p>	<p>Member of the World Trade Organization</p>
<p>Nationals of a Member of the World Trade Organization (meaning the nationals of Members provided for in paragraph (3) of Article 1 of the Annex 1C to the Marrakesh</p>	<p>Country of the Union of the Paris Convention or Member of the World Trade Organization</p>

(2) The preceding two articles shall apply mutatis mutandis to the case where a priority claim is declared under the preceding two paragraphs.

## **KIPO**

Article 51 (Priority Claim under Treaty) and Article 188 (Special Provision concerning Priority Claim under Treaty) of the Design Protection Act

Article 51 (Priority Claim under Treaty)

(1) For the purpose of applying Article 33 or 46 to cases where a national of a member State to a treaty that recognizes the right of priority of a national of the Republic of Korea in filing an application for design registration files an application for the registration of a design in the Republic of Korea after filing an application for the registration of an identical design in the

member State or another member State and claims the right of priority, the date on which an application for design registration is filed in the member State or another member State shall be deemed the date on which another application for design registration is filed in the Republic of Korea. The foregoing shall also apply to cases where a national of the Republic of Korea files an application for the registration of a design in the Republic of Korea after filing an application for the registration of an identical design in a member State to a treaty that recognizes the right of priority of a national of the Republic of Korea in filing an application for design registration.

(2) A person who intends to claim the right of priority under paragraph (1) shall not claim the right of priority, unless he/she files an application for design registration within six months from the filing date of the initial application on which the priority claim shall be based.

(3) A person who intends to claim the right of priority under paragraph (1) shall state the intention, the name of the State in which the initial application was filed, the filing date of the initial application filed for design registration.

(4) A person who claims the right of priority under paragraph (3) shall submit a document stating the filing date of the application for design registration, recognized by the government of the State in which he/she filed an application first, and a certified copy of the drawing of the design to the Commissioner of the Korean Intellectual Property Office within three months.

(5) If a person who claims the right of priority under paragraph (3) does not submit the documents specified in the aforesaid paragraph within the period specified in paragraph (4), the priority claim shall become invalid.

#### Article 118 (Submission of Documents)

In a lawsuit for infringement of a design right or an exclusive license, the court may, at the request of either party, order the other party to submit documents necessary for the assessment of damages caused by infringement: Provided, That the foregoing shall not apply where the person possessing the documents has a reasonable ground to refuse to submit them.

## **SIPO**

### **PATENT LAW:**

Article 29. Where, within twelve months from the date on which any applicant first filed in a foreign country an application for a patent for invention or utility model, or within six months from the date on which any applicant first filed in a foreign country an application for a patent for design, he or it files in China an application for a patent for the same subject matter, he or it may, in accordance with any agreement concluded between the said foreign country and



China, or in accordance with any international treaty to which both countries are party, or on the basis of the principle of mutual recognition of the right of priority, enjoy a right of priority. Where, within twelve months from the date on which any applicant first filed in China an application for a patent for invention or utility model, he or it files with the patent administration department under the State Council an application for a patent for the same subject matter, he or it may enjoy a right of priority.

Article 30. Any applicant who claims the right of priority shall make a written declaration when the application is filed, and submit, within three months, a copy of the patent application document which was first filed; if the applicant fails to make the written declaration or to meet the time limit for submitting the copy of the patent application document, the claim to the right of priority shall be deemed not to have been made.

#### IMPLEMENTING REGULATIONS OF THE PATENT LAW OF THE PEOPLE'S REPUBLIC OF CHINA

Rule 31. Where an applicant claims the right of foreign priority in accordance with the provisions of Article 30 of the Patent Law, the copy of the earlier application documents submitted by the applicant shall be certified by the authority with which the earlier application was filed. Where, in accordance with the agreement between the patent administration department under the State Council and the said authority, the patent administration department under the State Council obtains a copy of the earlier application documents through electronic transmission or in any other manner, the copy of the earlier application documents certified by the authority shall be deemed to have been submitted by the applicant. Where the right of domestic priority is claimed, if the date of filing and the filing number of the earlier application are indicated in the request by the applicant, the copy of the earlier application documents shall be deemed to have been submitted.

Where such one or two items as the date of filing, the filing number of the earlier application or the title of the authority with which the earlier application was filed are missing or incorrect in the request when claiming for right of priority, the patent administration department under the State Council shall notify the applicant to make rectification within the specified time limit. Where the applicant fails to make the rectification within the time limit, the right of priority shall be deemed not to have been claimed.

Where the name or title of the applicant who claims the right of priority is not the same as the one recorded in the copy of the earlier application, the applicant shall submit document certifying the assignment of right of priority. If no such document is submitted, the right of priority shall be deemed not to have been claimed. Where any applicant claims a right of

foreign priority for patent application for design, and no brief explanation of the design was contained in the earlier application, he or it will not be adversely affected as for enjoying the right of priority if the brief explanation submitted by the applicant in accordance with the provisions of Rule 28 of these Regulations does not go beyond the scope as shown in the drawings or photographs of the earlier application.

Rule 32. An applicant may claim one or more priorities for an application for a patent; where multiple priorities are claimed, the priority period for the application shall be calculated from the earliest priority date.

Where an applicant claims the right of domestic priority, if the earlier application is one for a patent for invention, he or it may file an application for a patent for invention or utility model for the same subject matter; if the earlier application is one for a patent for utility model, he or it may file an application for a patent for utility model or invention for the same subject matter. However, when the later application is filed, if the subject matter of the earlier application falls under any of the following, it may not be taken as the basis for claiming domestic priority:

- (1) where the applicant has claimed foreign or domestic priority;
- (2) where it has been granted a patent right;
- (3) where it is the subject matter of a divisional application filed as prescribed.

Where the domestic priority is claimed, the earlier application shall be deemed to be withdrawn from the date on which the later application is filed.

Rule 33. Where an application for a patent is filed or the right of foreign priority is claimed by an applicant having no habitual residence or business office in China, the patent administration department under the State Council may, when it deems necessary, require the applicant to submit the following documents:

- (1) if the applicant is an individual, a certificate concerning his nationality;
- (2) if the applicant is an enterprise or other organization, a document certifying the country or region in which it is registered;
- (3) a document certifying that the country, to which the foreigner, foreign enterprise or other foreign organization belongs, recognizes that Chinese entities and individuals are, under the same conditions as those applied to its nationals, entitled to the patent right, the right of priority and other related rights in that country.

## **USPTO**

35 U.S.C. 120 Benefit of earlier filing date in the United States.

[Editor Note: Applicable to a patent application subject to the first inventor to file provisions of

the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 120 (pre-AIA) for the law otherwise applicable.]

An application for patent for an invention disclosed in the manner provided by section 112(a) (other than the requirement to disclose the best mode) in an application previously filed in the United States, or as provided by section 363 which names an inventor or joint inventor in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.

(Amended Nov. 14, 1975, Public Law 94-131, sec. 9, 89 Stat. 691; Nov. 8, 1984, Public Law 98-622, sec. 104(b), 98 Stat. 3385; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-563 (S. 1948 sec. 4503(b)(1)); amended Sept. 16, 2011, Public Law 112-29, secs. 15(b) (effective Sept. 16, 2012), 20(j) (effective Sept. 16, 2012) and 3(f) (effective March 16, 2013), 125 Stat. 284.)

35 U.S.C. 121 Divisional applications.

[Editor Note: Applicable to any patent application filed on or after September 16, 2012. See 35 U.S.C. 121 (pre-AIA) for the law otherwise applicable.]

If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. The validity of a patent shall not be questioned for failure of the Director to require the application

to be restricted to one invention.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)); amended Sept. 16, 2011, Public Law 112-29, secs. 4(a) and 20(j) (effective Sept. 16, 2012), 125 Stat. 284.)

35 U.S.C. 365 Right of priority; benefit of the filing date of a prior application.

(a) In accordance with the conditions and requirements of subsections (a) through (d) of section 119, a national application shall be entitled to the right of priority based on a prior filed international application which designated at least one country other than the United States.

(b) In accordance with the conditions and requirements of section 119(a) and the treaty and the Regulations, an international application designating the United States shall be entitled to the right of priority based on a prior foreign application, or a prior international application designating at least one country other than the United States.

(c) In accordance with the conditions and requirements of section 120, an international application designating the United States shall be entitled to the benefit of the filing date of a prior national application or a prior international application designating the United States, and a national application shall be entitled to the benefit of the filing date of a prior international application designating the United States. If any claim for the benefit of an earlier filing date is based on a prior international application which designated but did not originate in the United States, the Director may require the filing in the Patent and Trademark Office of a certified copy of such application together with a translation thereof into the English language, if it was filed in another language.

(Added Nov. 14, 1975, Public Law 94-131, sec. 1, 89 Stat. 686; amended Nov. 8, 1984, Public Law 98-622, sec. 403(a), 98 Stat. 3392; Dec. 8, 1994, Public Law 103-465, sec. 532(c)(4), 108 Stat. 4987; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)); amended Sept. 16, 2011, Public Law 112-29, sec. 20(j) (effective Sept. 16, 2012), 125 Stat. 284.)

35 U.S.C. 172 Right of priority.

[Editor Note: Applicable to any patent application subject to the first inventor to file provisions of the AIA (see 35

U.S.C. 100 (note)). See 35 U.S.C. 172 (pre-AIA) for the law otherwise applicable.]

The right of priority provided for by subsections (a) through (d) of section 119 shall be six months in the case of designs. The right of priority provided for by section 119(e) shall not apply to designs.

(Amended Dec. 8, 1994, Public Law 103-465, sec. 532(c)(2), 108 Stat. 4987; amended Sept. 16,

2011, Public Law 112-29, sec. 20(j) (effective Sept. 16, 2012) and sec. 3(g)(effective March 16, 2013), 125 Stat. 284.)

35 U.S.C. 119 Benefit of earlier filing date; right of priority.

[Editor Note: 35 U.S.C. 119(a) as set forth below is only applicable to patent applications subject to the first inventor to file provisions of the AIA (see 35 U.S.C. 100 (note)). See 35 U.S.C. 119(a) (pre-AIA) for the law otherwise applicable.]

(a) An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed.

(b) (1) No application for patent shall be entitled to this right of priority unless a claim is filed in the Patent and Trademark Office, identifying the foreign application by specifying the application number on that foreign application, the intellectual property authority or country in or for which the application was filed, and the date of filing the application, at such time during the pendency of the application as required by the Director.

(2) The Director may consider the failure of the applicant to file a timely claim for priority as a waiver of any such claim. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed claim under this section.

(3) The Director may require a certified copy of the original foreign application, specification, and drawings upon which it is based, a translation if not in the English language, and such other information as the Director considers necessary. Any such certification shall be made by the foreign intellectual property authority in which the foreign application was filed and show the date of the application and of the filing of the specification and other papers.

(c) In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application in the same foreign country instead of the first filed foreign application, provided that any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.

(d) Applications for inventors' certificates filed in a foreign country in which applicants have a

right to apply, at their discretion, either for a patent or for an inventor's certificate shall be treated in this country in the same manner and have the same effect for purpose of the right of priority under this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents, provided such applicants are entitled to the benefits of the Stockholm Revision of the Paris Convention at the time of such filing.

(e) (1) An application for patent filed under section 111(a) or section 363 for an invention disclosed in the manner provided by section 112(a) (other than the requirement to disclose the best mode) in a provisional application filed under section 111(b), by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b), if the application for patent filed under section 111(a) or section 363 is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application. No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this subsection during the pendency of the application

(2) A provisional application filed under section 111(b) may not be relied upon in any proceeding in the Patent and Trademark Office unless the fee set forth in subparagraph (A) or (C) of section 41(a)(1) has been paid.

(3) If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day.

(f) Applications for plant breeder's rights filed in a WTO member country (or in a foreign UPOV Contracting Party) shall have the same effect for the purpose of the right of priority under subsections (a) through (c) of this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents.

(g) As used in this section—

(1) the term "WTO member country" has the same meaning as the term is defined in section 104(b)(2); and

(2) the term “UPOV Contracting Party” means a member of the International Convention for the Protection of New Varieties of Plants.

(Amended Oct. 3, 1961, Public Law 87-333, sec. 1, 75 Stat. 748; July 28, 1972, Public Law 92-358, sec. 1, 86 Stat. 501; Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Dec. 8, 1994, Public Law 103-465, sec. 532(b)(1), 108 Stat. 4985; subsection (b) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-563 (S. 1948 sec.4503(a)); subsection (e) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-564, 588, 589 (S. 1948 secs. 4503(b)(2), 4801 and 4802; subsections (f) and (g) added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-589 (S. 1948 sec. 4802); subsections (e), (g) amended Sept. 16, 2011, Public Law 112-29, secs. 15(b) (effective Sept. 16, 2011) and 20(j) (effective Sept. 16, 2012), 125 Stat. 284; subsection (a) amended Sept. 16, 2011, Public Law 112-29, sec. 3(g) (effective March 16, 2013), 125 Stat. 284.)

35 U.S.C. 255 Certificate of correction of applicant’s mistake.

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Director may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

35 U.S.C. 171 Patents for designs.

Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

35 U.S.C. 112 Specification.

[Editor Note: Applicable to any patent application filed on or after September 16, 2012. See 35 U.S.C. 112 (pre-AIA) for the law otherwise applicable.]

(a) IN GENERAL.—The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly

connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

(b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

(c) FORM.—A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

(d) REFERENCE IN DEPENDENT FORMS.—Subject to subsection (e), a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

(e) REFERENCE IN MULTIPLE DEPENDENT FORM.—A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

(f) ELEMENT IN CLAIM FOR A COMBINATION.—An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. (Amended July 24, 1965, Public Law 89-83, sec. 9, 79 Stat. 261; Nov. 14, 1975, Public Law 94-131, sec. 7, 89 Stat. 691; amended Sept. 16, 2011, Public Law 112-29, sec. 4(c), 125 Stat. 284, effective Sept. 16, 2012.)

35 U.S.C. 386 Right of priority

(a) National Application.—

In accordance with the conditions and requirements of subsections (a) through (d) of section 119 and section 172, a national application shall be entitled to the right of priority based on a prior international design application that designated at least 1 country other than the United States.

(b) Prior Foreign Application.—

In accordance with the conditions and requirements of subsections (a) through (d) of section 119 and section 172 and the treaty and the Regulations, an international design application designating the United States shall be entitled to the right of priority based on a prior foreign



application, a prior international application as defined in section 351(c) designating at least 1 country other than the United States, or a prior international design application designating at least 1 country other than the United States.

(c) Prior National Application.—

In accordance with the conditions and requirements of section 120, an international design application designating the United States shall be entitled to the benefit of the filing date of a prior national application, a prior international application as defined in section 351(c) designating the United States, or a prior international design application designating the United States, and a national application shall be entitled to the benefit of the filing date of a prior international design application designating the United States. If any claim for the benefit of an earlier filing date is based on a prior international application as defined in section 351(c) which designated but did not originate in the United States or a prior international design application which designated but did not originate in the United States, the Director may require the filing in the Patent and Trademark Office of a certified copy of such application together with a translation thereof into the English language, if it was filed in another language.

(Added Pub. L. 112–211, title I, § 101(a), Dec. 18, 2012, 126 Stat. 1529.)

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