

## **Chapter 7**

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## Chapter 7

### Internal priority and convention priority

#### 7.01 Filing requirements when priority is requested

For applications filed after October 1, 1996:

The requirements for requesting priority in respect of a patent application are set out in section 28.4 of the *Patent Act* and sections 65, 88 and 89 of the *Patent Rules*. A request may be relied upon only if an application has been filed in Canada within 12 months of the earliest date on which any corresponding application has been filed in Canada or in any country belonging to the Paris Convention or in any World Trade Organization (WTO) member country (subparagraph 28.1(1)(a)(ii) and paragraph 28.1(1)(b) of the *Patent Act*).

Priority for applications filed under the provisions of the Patent Cooperation Treaty (PCT) is recorded in accordance with the procedures outlined in Section 7.01.02 below.

An application is not entitled to the "claim date" conferred by Section 28.1 of the *Patent Act*, unless the applicant requests priority based on a previously regularly filed application before the expiry of four months after the filing date of the application in Canada (paragraph 88(1)(b) of the *Patent Rules*).

The request for priority may be made in the petition or in a separate document (paragraph 88(1)(a) of the *Patent Rules*).

The applicant must provide the Commissioner with the date and country of each previously regularly filed application on which the request for priority is based, before the expiry of the four-month period after the filing date of the application in Canada (paragraph 88(1)(c) of the *Patent Rules*).

The applicant provide the Commissioner with the application number of each previously regularly filed application on which the request for priority is based, before the expiry of the later of the four-month period after the filing date of the subject application in

Canada, and the twelve-month period after the date of filing of the previously regularly filed application (paragraph 88(1)(d) of the *Patent Rules*).

No extension of time is permitted for requesting priority and providing the Commissioner with the date and country of each previously regularly filed application and for providing the application number of such applications (subsection 88(2) of the *Patent Rules*).

An applicant will be afforded the benefit of a request for priority only if the priority document adequately discloses at least part of the invention described in the subject application. Where a previously regularly filed application on the basis of which a request for priority is based is taken into account pursuant to sections 28.1 to 28.4 of the *Patent Act*, the applicant may be required to file a certified copy of such application and a certification from the patent office in which the application was filed, indicating the actual date of its filing (section 89 of the *Patent Rules*). If the previously regularly filed application is not written in either English or French, the applicant will be requisitioned to provide a translation in one of these languages (section 71 of the *Patent Rules*).

The benefit of a request for priority is not afforded by the Patent Office if an applicant has filed two applications in one or more countries for the same subject matter, and one of those filings was more than a year before the Canadian filing. Under normal circumstances no priority benefit may be based on the second application, even if it has been filed less than a year before the Canadian filing, except for new matter appearing in the second application. However, if the first filed application is considered never to have been filed in accordance with subsection 28.4(5) of the *Patent Act*, an inventor may be entitled to full priority rights based upon the subsequently filed application.

Priority is based on the specification in priority applications and thus not restricted to the invention claimed. A provisional patent application filed in a foreign jurisdiction such as a United States provisional application, may also serve as a basis for claiming priority for a Canadian application.

For applications filed prior to October 1, 1996 and after October 1, 1989:

A request for priority must be received by the Patent Office within six months of the filing date of the application (the subject application). The applicant must also provide the Commissioner with the date and country of filing and the application number of

each previously regularly filed application on which the request for priority is based before the expiry of the six-month period after the filing date of the subject application (section 142 of the *Patent Rules*). Other than the time limits specified, all other provisions affecting priority are as given above.

No extension of time is permitted for requesting priority and providing the Commissioner with the date and country of each previously regularly filed application and for providing the application number of such applications (subsection 142(2) of the *Patent Rules*).

#### **7.01.01 Internal priority**

It is permitted to request priority based on a previously regularly filed Canadian application in a subsequently filed application provided the request is made within 4 months of the filing of the subsequently filed application. The applicant must provide the date of filing of the subject application within four months of the filing of the subsequently filed application and must also provide the application number of the subject application within the later of the four-month period after the filing date of the subsequently filed application and the twelve-month period after the date of filing of the subject application.

This practice provides an applicant the opportunity to file an application for patent as early as possible after an invention has been made in order to obtain the filing date for the disclosed subject matter. If the applicant subsequently makes improvements or alterations to the original invention, the applicant may file an additional application adding the new matter and requesting priority on the first filed application. This allows the applicant to maintain the original filing date for the subject matter disclosed in the first filed application while receiving a later filing date for the new matter. The applicant has the option of proceeding with both applications or abandoning the first application and proceeding with the second application.

#### **7.01.02 PCT priority**

The filing of an international application has the effect of filing a regular national application in each designated state. For the purposes of the Paris Convention, the effect of an international application is equivalent to that of a national filing. Priority rights, for example, may be based on an international application.

If the international application has acquired priority rights before the International Bureau based on an earlier filed national application, those rights would be extended to the applicant upon national entry in Canada.

For priority requests under the provisions of the Patent Cooperation Treaty (PCT) see Chapter 22 of this Manual.

## **7.02 Time limits for requesting priority under the Paris Convention**

Applications requesting priority rights must be filed in Canada on or before the first anniversary date of the first filing in a Paris Convention country, a WTO member or Canada. The "twelve months" referred to in paragraph 28.1(1)(b) of the *Patent Act* ends on and includes the anniversary date of the first filing. However, if the anniversary date is a day when the Patent Office is closed for business, the filing may be made on the next day when the Patent Office is open for business (section 78 of the *Patent Act*).

## **7.03 Priority and OPI date in Canada**

The date of the earliest previously filed application on which a request for priority is based will determine the date of opening to public inspection in Canada. In accordance with subsections 10(1) and (2) of the *Patent Act*, the application and all documents filed in connection with the application will be opened on the expiry of an 18 month confidentiality period beginning on the earliest priority date unless the applicant requests an earlier opening.

### **7.03.01 Withdrawal of priority**

Under subsection 28.4(3) of the *Patent Act*, an applicant may withdraw a request for priority, either entirely or with respect to one or more previously regularly filed applications, by filing a request with the Commissioner. The Commissioner shall send a notice to the applicant advising that the request for priority has been withdrawn (subsection 90(1) of the *Patent Rules*). The effective date of the withdrawal of the

request for priority will be the date the request for withdrawal is received by the Commissioner (subsection 90(2) of the *Patent Rules*).

#### **7.04 Petty Patents and Authors' Certificates**

The Patent Office recognizes convention priority based on petty patent applications, applications for authors' certificates, and utility models filed in foreign countries, since these are considered forms of patent applications. On the other hand, no priority may be based on a foreign application for an industrial design registration, design patents or their equivalent.

#### **7.05 U.S. Continuation-in-part applications**

Under some conditions, priority may be based on United States continuation-in-part applications. A continuation-in-part application may serve as a priority document for new matter disclosed in it and not in the original United States application if the Canadian application is filed within a year of the continuation-in-part.

Where a Canadian application is filed more than a year after the filing date of the original United States application, but less than a year after the continuation-in-part, the applicant is not entitled to priority on subject matter common to the two United States applications, even if the original has been abandoned. While under the Paris Convention an applicant may claim priority based on a second foreign application when the first has been abandoned, this is only so if there are no rights whatsoever remaining (Subsection 28.4(5) of the *Patent Act*). In the case of a continuation-in-part application, certain rights are carried over from the abandoned original application.

If both the original and the continuation-in-part applications are filed within the year preceding the filing of the Canadian application, priority may be based on both the original application and on the new matter in the continuation-in-part.

Where, therefore, priority is necessary to support a claim date in the prosecution of a Canadian application claiming priority from a United States continuation-in-part application only, it is necessary to identify the matter derived from the original United

States application, thereby to determine the priority rights of the applicant. Because a United States continuation-in-part application does not identify the new matter added to the original United States application, the applicant must submit certified copies of the original and continuation-in-part applications whenever required to do so by the Patent Office.

## **7.06 Multiple priorities**

Subsection 28.4(4) of the *Patent Act* provides for multiple convention priorities.

A Canadian application, the subject application, may be a composite of several earlier filings of the inventor, and entitled to priority in respect of each for the subject matter contained therein, provided, that the subject application was filed within a year of the earliest filed application on which the request for priority is based.

Claim dates under section 28.1 of the *Patent Act* may be based on one or more previously regularly filed applications in the same or different countries which describe the subject matter of the claim in question. See also Chapter 15 of this Manual.