

QUESTIONNAIRE – PRIORITY CLAIMING UNDER PARIS CONVENTION

1. Has your country adopted the provisions of Article 4C(4) of the Paris Convention in its entirety?

In terms of claiming priority in Canada from foreign basic applications, Canada has adopted the provisions of Article 4C(4).

Section 28.4(5) of the *Patent Act* sets out requirements under which a previously regularly filed application may be considered to never have been filed for the purpose of claiming priority in Canada. In particular, Section 28.4(5) of the *Patent Act* requires the following.

- A subsequent application must be filed in the same country as the previously filed application.
- The previously regularly filed application must have been withdrawn, abandoned or refused without having been opened to public inspection and without leaving any rights outstanding.
- The previously regularly filed application must not have served as a basis for a request for priority in any country, including Canada.
- The requirements are judged at the time of filing the subsequent application.

Section 28.4(5) of the *Patent Act* also has an element of the AIPPI proposal.

- Section 28.4(5) of the *Patent Act* is not limited to only the first previously filed application (see sections 28.1(a), 28.1(b), 28.4(4), and 28.4(5)). Accordingly, possible intermediate applications may be treated as though they have never been filed, provided the requirements of section 28.4(5) have been met. Therefore, it is aligned with the AIPPI proposal that allows for first application and "any possible intermediate applications" to be disregarded.

Section 28.4(5) of the *Patent Act* requires that for a previously regularly filed application not to be the first filed application, it must have been filed more than 12 months before the filing date of the Canadian application or a PCT application. Accordingly, until 12 months has expired from the filing of an application, that application is not the first filed application. This is only an issue if there is a second application filed within a 12 month period and the applicant only wants to claim priority from the latter application, e.g., due to an error in the first application or so that material in the first filed application is not published.

2. If not, how does the law of your country operate to allow applicants to claim priority under the Paris Convention from second or subsequently filed priority applications?

Canada has adopted the provisions of Article 4C(4) of the Paris Convention. See the response to Q#1

3. Is an applicant required to provide details of patent applications filed in respect of the invention prior to the earliest priority date claimed, whether within the 12 month period prior to filing or earlier?

No. Canadian applicants are not required by law to provide details of patent applications filed prior to the earliest priority claim date, as the request for priority would not be based on those earlier applications.

A Canadian application is only required to provide details of patent applications on which a request for priority under section 28.4 of the *Patent Act* is based.

4. If so, what details are required and what is the mechanism and time frame for providing that information.

The applicant must inform the Commissioner of the filing date, country/office and number of each previously regularly filed application on which the request for priority is based (section 28.4(2) of the *Patent Act*; paragraph 88(1)(c) of the *Patent Rules*).

A certified copy is not required to claim priority. However, an examiner can also requisition a certified copy of a previously filed application of which a request for priority is based, and a certification from the patent office in which the application was filed indicating the actual date of its filing (paragraph 89 of the *Patent Rules*). This does not often occur.

5. What is the sanction, or effect on the priority claim, for failing to provide this information within the time frame, and are extensions available?

The priority claim and the required information to support the priority claim must be made within 16 months of the filing date of the earliest application from which priority is claimed.

No extension of time is available.

Failure to comply with a complete priority claim within the 16 month period will result in the loss of the priority claim.

6. If your country has requirements that must be satisfied in relation to any first application to be disregarded before allowing a priority claim to a subsequently filed application, are those requirements judged at the filing date of the subsequent application (as per Article 4C(4)) or at the date on which the Convention application is filed (as per original AIPPI proposal)?

The requirements must be satisfied on the filing date of the subsequently filed application or, if there is more than one such application, on the earliest of their filing dates (as per Article 4C(4))

7. Are there any published Patent Office decisions, court decisions, or other statements of law which deal with priority claims under Article 4C(4) or national equivalent?

No court decisions have been located.

- 8. If so, please provide references to these decisions, and brief summaries of the facts and the decisions or statements.**

None. See the response to Q#7

- 9. Are there any requirements not mentioned above in relation to claiming priority from a foreign application which in your experience, or to your knowledge, are not well understood or have caused significant confusion among foreign applicants, and that could represent a trap for foreign applicants?**

While Canada will accept requests for the restoration of the right of priority when acting as a receiving office, it will not accept such requests when acting as a designated office.

While restoration of priority claims are permitted under the PCT if a convention date is missed, the restored priority claim will not be recognized claim when the PCT application enters the national phase in Canada. A change is required to the Canadian *Patent Act* to permit a restored priority claim to be allowed.

- 10. If so, please explain those requirements.**