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PROPOSED GUIDANCE FROM THE PARIS UNION ASSEMBLY ON IMPLEMENTATION OF THE PARIS CONVENTION RELATING TO THE RIGHT OF PRIORITY IN EMERGENCIES

Document prepared by the International Bureau

BACKGROUND

1. The right of priority, based on Article 4 of the Paris Convention for the Protection of Industrial Property (hereinafter referred to as the “Paris Convention”) is a fundamental mechanism for filing industrial property applications abroad. It is an overarching principle integrated in the national and regional industrial property systems, as well as in the international filing or registration systems of the World Intellectual Property Organization (WIPO), namely, the Patent Cooperation Treaty (PCT) System, the Madrid System for the international registration of marks and the Hague System for the international registration of industrial designs.
2. A variety of measures to mitigate the effects of various types of emergencies have been provided in the PCT, Madrid and the Hague Systems for international applications under those systems. However, as regards the implementation of provisions of the Paris Convention in national law for national applications and the application of those provisions in emergency situations, little guidance is available, including on questions concerning the right of priority.

3. In this regard, and due to the disruption caused by the COVID-19 pandemic, users of the industrial property system and intellectual property (IP) Offices have been facing a number of challenges in relation to, *inter alia*, the procedures relating to the priority right under the Paris Convention, such as:

- (i) applicants who seek to claim priority may have difficulties in complying with the priority period under Article 4C(1) of the Paris Convention;
- (ii) applicants who seek to claim priority may have difficulties in submitting a copy of the earlier application under Article 4D(3) of the Paris Convention;
- (iii) applicants may also have financial constraints resulting from the pandemic, which result in difficulty in paying fees associated with delays or extension of time limits;
- (iv) applicants may have practical difficulties in gathering and submitting evidentiary documents within a prescribed deadline;
- (v) applicants may struggle to become familiar with the number of very different solutions adopted by IPOs in response to the above difficulties, i.e., some national/regional Offices of WIPO Member States have declared special relief measures in relation to the claiming of the right of priority under the Paris Convention; and
- (vi) information about the relief measures provided by IP Offices may be not easily accessible to users of the industrial property systems, particularly as relates to foreign Offices, because of unfamiliarity by the applicants with the national Gazette or the national IP Office website.

4. In addition, there appears to be a lack of guidance on the scope of the relevant provisions under the Paris Convention and on the interpretation thereof. The international nature of Paris Convention priority means that uncertainties surrounding the timely claiming of the right of priority or the loss thereof potentially affect a large number of users of the industrial property system and third parties worldwide.

5. Since the beginning of the COVID-19 pandemic, the International Bureau of WIPO has been approached by a number of countries of the Paris Union and users of the IP system who have sought information on the application of Article 4 of the Paris Convention. Around 75 queries were received from Member States and users on legal and operational matters relating to priority claims and submission of priority documents. Therefore, it may be opportune for the Paris Union Assembly to consider the issues of the priority right in emergencies, and consider providing guidance to Paris Convention Contracting Parties on options for national implementation.

6. This document first provides an overview of the relevant provisions of the Paris Convention. It then addresses possible special relief measures for mitigating the risk of loss of the priority right in emergencies. This is followed by a discussion of practical elements that may be considered for the designing of such relief measures. Finally, the document presents draft guidance from the Paris Union Assembly to the countries of the Union on this subject, for consideration and adoption by the Assembly. The guidance does not bind the countries of the Paris Union.

7. It should be noted that in its capacity in performing the administrative tasks concerning the Union, the International Bureau is not in a position to provide an official interpretation of the treaties administered by it, such interpretation being the exclusive competence of the States party to the relevant treaties.

PRIORITY UNDER THE PARIS CONVENTION

Priority Period

8. Article 4C(1) of the Paris Convention states that the period of priority shall be twelve months for patents and utility models, and six months for industrial designs and trademarks.

9. The periods of priority must strike a balance between the interests of the applicant and of third parties. On the one hand, applicants should be able to enjoy the right of priority during an adequate period from his/her first filing date, while on the other hand, third parties should not be confronted with loss of their right to industrial property because of the too extensive periods of priority.¹ The history behind this provision suggests that while many countries were not in favor of an extension of the priority period in cases where applicants were not able to observe such period due to the reasons beyond their control, restoration of the right of priority in such circumstances is in conformity with the Paris Convention.²

10. In view of the above, it is understood that strict interpretation of the twelve-month or six-month priority period is compatible with relief measures that strike a balance between the legitimate interests of the applicant and of third parties, particularly in emergencies.

Priority Period in Case of Non-Opening of the Office

11. Article 4C(3) of the Paris Convention states that if the last day of the priority period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day. The purpose of this provision is to avoid the loss of the priority right due to the closure of the Office where the subsequent application is to be filed.

12. This provision does not specify any grounds for which the Office is not open for the filing of applications. Therefore, it may be construed to encompass any reason that has led the Office to not be open for such filing, including emergencies.³

13. In addition, the Convention does not address, and does not limit, the duration of such a temporary period during which the Office is not open. According to the historical record, Article 4C(3) was adopted with the understanding that a situation during which “the office is not open for the filing of applications” could only result from a formal decision of the official administration concerned.⁴

14. The provision addresses only the specific case where the Office is not open for the filing of a subsequent application. In other words, if the Office is not open for other types of operations, such as processing of the already filed applications, but is open for the filing of applications, Article 4C(3) does not apply.

15. Presently, many Offices accept more than one means of communication for filing applications and for submitting required documents, for example, on paper, *via facsimile* or *via electronic filing platforms*. The question arises whether Article 4C(3) of the Convention applies in cases where the Office continues to accept one means of communication (for example,

¹ G.H.C. Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property*, 1968, p.44.

² In order to explicitly stipulate that Article 13(2) of the Patent Law Treaty (PLT) concerning the restoration of the right of priority is in conformity with the Paris Convention, the expression “Taking into consideration Article 15” was inserted in PLT Article 13(2) during the Diplomatic Conference for the Adoption of the PLT (Explanatory Notes on the PLT and the Regulations under the PLT, paragraph 13.05).

³ The Delegation of the Netherlands, in explaining its proposal, stated that Article 4C(3) applied to all cases where the patent office is closed for the filing of applications (*Actes de Londres*, p.364).

⁴ *Actes de Londres*, p.453.

electronic filing) but not another means of communication (for example, paper filing), due to an emergency situation. There could be cases where an office is physically open, but its electronic filing system is not available. In other cases, an office is physically closed, but an electronic filing system continues to operate. While the interpretation of the term “not open for the filing of applications” is left to Contracting Parties, if applicants are given the option of using one of the means of communication accepted by the Office, the equal treatment for all applicants using various means of filing applications should be considered.

Late Submission of a Copy of the Earlier Application

16. As one of the formal requirements for claiming priority, countries of the Paris Union may require a copy (or a certified copy) of the previously filed application on which the priority claim is based. According to Article 4D(3) of the Paris Convention, the certified copy may be filed, without fee, at any time within three months of the filing of the subsequent application. In accordance with the history of this provision, the Convention permits a submission of a copy of the priority document after the minimum period of three months stipulated in Article 4D(3), in which case the Office may require payment of a fee.⁵

RELIEF MEASURES

Paris Convention and Relief during Emergencies

17. No provision in the Convention specifically addresses relief measures for mitigating the risk of losing the priority right due to emergencies. At the same time, it appears that nothing in the Paris Convention explicitly prohibits Contracting Parties from providing measures that are particularly tailored to mitigate the loss of the priority right in emergencies, in addition to the extension of the priority period until the first working day in Article 4C(3) of the Paris Convention.

18. This point is corroborated by two special agreements under the Paris Convention, i.e., the Patent Law Treaty (PLT)⁶ and the Singapore Treaty on the Law of Trademark (Singapore Treaty)⁷ that are applicable to the formality requirements relating to national/regional patent and trademark applications, respectively, filed with the Offices of the Contracting Parties concerned.

Options for National Implementation

19. Apart from the extension of the priority period to the first working day, if the last day of the priority period is a day when the IP Office is not open for the filing of applications (Article 4C(3) of the Paris Convention), the applicable national/regional law is the primary basis for countries to adopt any relief measures in response to difficulties faced by applicants in meeting the priority-related time limits due to emergencies.

⁵ The three-month period in Article 4C(3) is considered as a minimum term (*Actes de La Haye*, pp 429, 538 and *Actes de Londres*, p.513). The Office may require payment of a fee if a copy of the earlier application is submitted after that minimum period (*Actes de Londres*, p.513).

⁶ PLT Article 13(2) and (3) requires its Contracting Parties to provide for restoration of the priority right in two circumstances: (i) where the timely filing of the subsequent application was not possible in spite of due care required by the circumstances having been taken, or at the option of the PLT Contracting Party, was unintentional; and (ii) where the Office with which the earlier application was filed failed to provide a copy of that application in time, and consequently the priority is lost despite a timely request by the applicant for such a copy to that Office. In both cases, the Contracting Party may require the applicant to file a declaration or other supportive evidence and/or payment of a fee for restoration. When implementing the PLT at the national level, a Contracting Party may provide for requirements, which, from the viewpoint of applicants, are more favorable than those stipulated in the PLT (Article 2(1)). Therefore, it appears that the PLT does not prevent its Contracting Party from, for example, restoring the right of priority in emergency situations with a set of requirements that are more favorable than those in the PLT, on the basis of the applicable national law (for example, no requirement on fee payment).

⁷ See Article 14 of the Singapore Treaty.

20. Non-exhaustive examples of mechanisms that could be applied in emergencies to address such difficulties of applicants and those of IP Offices in providing operational services, include the following:

(i) Restoration of rights

Where a time limit could not be observed because of the emergency, and the right was consequently lost, the concerned party may submit a request to the IP Office, seeking restoration of the right. In order to prevent unduly late submission of such a request, a cut-off date for the submission of the request is usually provided.

(ii) Extension of time limits

If a time limit falls within the defined period of emergency, the time limit is extended for a specific period, either upon request by the concerned party or automatically.

(iii) Suspension of time limits

An IP Office may suspend time limits during a certain period of emergency. In general, if the counting of the time limit has already started at the beginning of the suspension period, the counting of the remaining time period will be resumed, after the suspension period, from where it had stopped. If the time limit starts during the suspension period, the counting of that time limit will start after the suspension period.

(iv) Time limits deemed to have been complied with

If a time limit falls within the defined period of emergency, compliance with a specific time limit after the emergency is considered as if the applicant had met the original time limit, either upon request by the concerned party or automatically.

21. It should be clarified that item (ii) of the previous paragraph does not cover the extension of the twelve or six months priority period that goes beyond Article 4C(3) of the Paris Convention (see paragraphs 8 to 10, above).

22. The nature of global emergencies requires responsive and simple measures to mitigate the risk of the loss of rights. Such measures should not be overly burdensome, unnecessarily complicated or costly. In emergencies, particular consideration may be given to the waiver of additional fees. Similarly, parties might have difficulties in collecting evidence to demonstrate that a delay was due to the emergency. The feasibility of a simple mechanism for claiming circumstances that would justify the case, such as a simple statement/declaration by the party through ticking a box on the pre-printed form, may be explored.

23. In the context of its technical cooperation work, the International Bureau stands ready to provide tailored legislative advice to individual Member States upon request, taking into account the legitimate interests of applicants and of third parties.⁸

⁸ WIPO provide policy and legislative assistance upon demand from its Member States and in a range of formats. This assistance generally draws on expert knowledge and/or best practices and can help policy makers get the most out of IP in their specific national context.

INTERNATIONAL COORDINATION

Lack of Concerted Approach

24. Under the current circumstances, national measures vary in response to existing difficulties regarding compliance with the priority-related time limits prescribed by the Paris Convention. The global nature of the Paris Convention (with 177 Contracting Parties) justifies an internationally concerted approach to address the issues effectively, particularly in emergencies having a global impact, such as COVID-19.

25. In the context of claiming priority, disruptions in either the Office with which the earlier application is filed or the Office with which the subsequent application is filed may affect the applicant's right of priority. Furthermore, the emergency in the country in which the applicant resides may also affect the timely submission of a copy of the earlier application to the Office with which the subsequent application is filed. For this reason, a concerted approach by the countries of the Paris Union in respect of relief measures in emergencies would benefit all parties concerned. It would be useful to gather and share information and experiences among Member States regarding their application of Article 4C(3) of the Paris Convention. Recognizing the different national implementations of the relevant provisions among Offices, the Assembly may wish to consider further work to minimize them in a way that preserves the balance between the interests of applicants and third parties.

Use of Digital Technologies

26. In order to enhance certainty with respect to the growing use of electronic means for the provision, storage and dissemination of priority documents, in 2004, the Assemblies of the Paris Union and the PCT Union adopted the agreed understanding on the principles applicable to the application, *inter alia*, of Article 4D(3) of the Paris Convention.⁹ The agreed understanding states that it is for the competent authority furnishing the priority document to determine what constitutes certification of a priority document and how it will certify such a document. Examples of such forms of certification agreed to be acceptable include certification in electronic character coded form and an electronic image of a certification on paper. In emergencies, the Office of the earlier application may be able to issue a certificate in one form (for example, an electronic image of a certification), but not in another form (for example, a certificate in paper form). Given the agreed understanding adopted in 2004, at least for the purpose of complying with the time limit for the submission of a certified copy of the earlier application, IP Offices should accept certification issued by the authorities of the countries in emergency situations.

27. In addition, the International Bureau encourages Member States to participate in the WIPO Digital Access Service (DAS), which considerably facilitates submission of a certified copy of the earlier application in emergency situations.¹⁰

Transparency Mechanism about National/Regional Relief Measures

28. With a view to attempting to maximize legal certainty, the *ad hoc* nature of the relief measures in emergencies would also require the prompt dissemination of the complete information about such measures to the public so that both applicants and third parties would be able to take appropriate actions. In particular, since IP Offices may allow different means of

⁹ Documents A/40/6 and A/40/7 (paragraphs 161 to 173).

¹⁰ DAS is an electronic platform that allows priority documents to be securely exchanged between participating IP Offices. It offers a simple and safe digital alternative to filing paper copies of priority documents with multiple IP Offices. *Via* the DAS service, an applicant claiming priority may ask participating Offices of second filing to retrieve a copy of the priority document themselves. See <https://www.wipo.int/das/en/>.

communication for filing applications and submitting documents, clarification about the applicability of the relief measures for each means of communication would be helpful for users. Similarly, Offices may also disseminate information about the means of communication that continue to be in operation during the emergency period, if any.

29. In addition, considering the international dimension and effects of the relief measures relating to the right of priority, an international focal point may be established. Once an emergency situation arises, Member States may promptly send the information on the relevant national measures adopted by them to the international focal point, which will then publish and disseminate the information to all Member States and to the public. The International Bureau is well placed to carry out the role of such an international focal point, in conjunction with related activities in this regard.¹¹

Time Limits for Payment of Fees

30. In many instances non-payment of fees within the time limit leads to the loss of right, while many parties (applicants, owners or other parties involved in the office procedures) may have difficulties in timely payment of various fees during emergencies. Although it is a matter beyond the scope of this document, it should be noted that Article 5bis(2) of the Paris Convention confirms the right of the countries of the Union to provide for the restoration of patents which have lapsed by reason of non-payment of maintenance fees. The significance of this provision in emergencies may also be highlighted.

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31. Given the relevance of the subject under discussion, guidance from the Paris Union Assembly to the countries of the Paris Union, illustrating the practices that may be considered by the countries in implementing the provisions of the Paris Convention relating to the right of priority in emergency situations, might be conducive to a coordinated approach to the global challenges faced due to COVID-19.

32. As to the nature and scope of the guidance, it should be reiterated that:

- the guidance from the Paris Union Assembly merely elucidates the practices that the Assembly encourages Member States to consider. It neither creates binding provisions for Member States nor imposes any obligation on Member States to implement it. Nevertheless, clarification of certain issues may be helpful not only for the industrial property offices but also for applicants and third parties;
- the guidance does not alter the right of the countries of the Paris Union to interpret the Paris Convention and to implement the Convention in accordance with their national law;
- the guidance covers relief measures in a specific situation, i.e., in emergencies, for national applications, which are of national competence of each Member State;
- subject to Article 4C(3) of the Paris Convention, the priority period should not be extended beyond what is foreseen in Article 4C(1) of the Convention, while loss of the priority right during and as a result of emergencies, may be avoided by appropriate relief measures; and

¹¹ The International Bureau has already begun to perform this function in an effort to be of assistance to all WIPO Contracting States, users of its registration systems and third parties, with the recently inaugurated COVID-19 Policy Tracker (<https://www.wipo.int/covid19-policy-tracker/#/covid19-policy-tracker/ipo-operations>).

- the term “emergency” is not defined: Member States may address each individual situation most appropriately without a common definition, as the potential factors concerned could be diverse.

33. Taking into account the above, it is proposed that countries of the Paris Union consider the following proposed Guidance on Implementation of the Paris Convention relating to the Right of Priority in Emergencies, which applies to national applications:

- (a) In applying Article 4C(3) of the Paris Convention in emergencies, the expression “when the office is not open for the filing of applications in the country where protection is claimed” in that Article should be construed to encompass any duration of the temporary period during which the Office is not open, as determined by the relevant competent authority of that country, taking into account the legitimate interests of the applicant and of third parties.
- (b) In relation to the expression “when the office is not open for the filing of applications in the country where protection is claimed” in Article 4C(3), each Office should clarify the implementation of this provision when more than one means of filling are accepted by the Office.
- (c) Countries of the Paris Union should consider providing a relief measure in accordance with their national law in order to limit difficulties experienced by concerned parties during emergencies in:
 - (i) filing a subsequent application claiming priority of an earlier application within the priority period; and
 - (ii) submitting, within the applicable time limit, a copy (or certified copy) of the earlier application on which the priority claim is based.

Non-exhaustive examples of mechanisms for such a relief measure include:

- extension of the time limit referred to in item (ii);
- suspension of the time limit referred to in item (ii) or the priority period during a certain period of emergency;
- compliance with a specified time limit after the emergency is considered as if the applicant had met the original time limit referred to in item (ii) or the priority period;
- restoration of the right of priority lost during and as a result of the emergency,

provided that the priority period specified in Article 4C(1) of the Paris Convention should not be extended through interpretation of the Convention, except as otherwise stated in Article 4C(3).

- (d) As regards the relief measure relating to paragraph (c)(ii), due account should be taken with respect to the emergency situations in the country in which the earlier application was filed, the country in which the applicant resides and the country of the Office to which a copy the earlier application is to be submitted.

(e) The relief measures referred to in paragraph (c) should take into account the legitimate interests of the applicant as well as of third parties, and should not be unnecessarily complicated or costly. Fees applicable to benefit from those measures could be exceptionally waived in the context of emergencies, in accordance with the applicable law of each Member State.

(f) Given the agreed understanding on the provision of priority documents under the Paris Convention and the PCT, adopted by the Assemblies of the Paris Union and the PCT Union, respectively, in 2004, for the purpose of complying with the time limit for the submission of a certified copy of the earlier application, IP Offices should make best efforts to accept certification issued by the authorities that received the earlier application, which locate in the countries in emergency situations.

(g) To increase transparency, and taking into account the legitimate interests of applicants and of third parties, information about relief measures implemented by Offices should be promptly communicated to the public. The Member States of the Union are encouraged to send such information to the International Bureau, which will publish the information on the WIPO website.

34. The Paris Union Assembly is invited to encourage the application of the above Guidance on Implementation of the Paris Convention relating to the Right of Priority in Emergencies contained in paragraph 33 of this document, and adopt the said Guidance.

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