

PRIORITY AND THE RIGHT OF PRIORITY IN PATENT LAW – A RIGHT WITH AN AMBIGUOUS NATURE AND SURPRISING EFFECTS

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Abstract

Priorities and the right of priority in patent law have multiple meanings and diverse contents. They are rights with an ambiguous nature and effects that sacrifice substance in favour of form, as they are designed to ensure order, stability, and legal certainty, while also providing protection against the risk of earlier disclosures of the same invention, arising from deposits that become part of the prior art and, in the absence of recognition of such rights, can be cited and destructive of novelty.

Priority can only be recognized for those elements that are clearly disclosed in the patent application taken as a whole. In other words, the scope of protection claimed in the subsequent application cannot be broader than that of the priority application. The problem, the solution, and the essential features of the invention later filed for patenting must be identical to those in the earlier application for the priority date to be validly claimed for the subsequent application.

Moreover, for the priority derived from the earlier application to be accepted, the subsequent application must contain new inventive knowledge or information. If certain features of the invention in a subsequent application claiming priority are not found in any of the claims formulated in the earlier application, priority can still be recognized if these features are clearly and unambiguously derivable from the overall content of the earlier application.

Keywords: *priority, right of priority, conventional priority, internal priority, exclusion of the right of prior use, the rules of first to invent, first to file and first inventor to file.*

1. Introduction. The Concepts of Priority and the Right of Priority in Patent Law

The word „priority”, in everyday language, means precedence in time, in order, or in hierarchy and/or importance. In contrast, the expression „right of priority” refers to precedence as regulated by law.

In the field of intellectual property law – and particularly in industrial property law, where the applications are broader the term „priority” is used to denote precedence in the creation of an intellectual work or in making a scientific discovery, formulating a new idea, or theory. Meanwhile, the expression „right of priority” is used to designate a person’s entitlement to be the first and only one to acquire an exclusive right over an intellectual creation, based on the fact that this person was the first to fulfil the formal legal requirements. These requirements allow the competent authority (such as OSIM, EUIPO, or EPO), after verifying that the conditions for patentability or registrability are met, to grant a title of protection for a creation belonging to a category for which the law conditions the recognition of exclusive rights on the issuance of such a title (patent, registration certificate, or copyright certificate). This title gives the holder an exclusive right to exploit their creation (such as an invention, utility model, industrial design) or, as the case may be, to use a sign as a trade name or trademark. A blend of a moral rule and a legal rule, which is difficult to separate into distinct components.

In principle, priority should always be recognized in favour of the person who was the first to create an intellectual work. However, industrial property laws give preference to the person who first fulfilled the legal formalities required to obtain a title of protection (*first to file*), rather than to the one who was the first to actually create the work eligible for protection (*first to invent*). In other words, no matter how unfair it may seem at first glance, precedence in the creation of a protectable work does not always coincide with the legal recognition of a legal priority.

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In industrial property law, the right of priority has an additional dimension – that of extending the effects of a first application for the grant of a title of protection for a creation (invention, utility model, or industrial design) or for a distinctive sign (trademark, geographical indication, or designation of origin) to other jurisdictions where the priority date will be recognized as the date of the first filing.

2. The nature of the right of priority in patent Law

Being recognized as the first author of an invention is a moral obligation, supported by irrefutable philosophical arguments, ethical traditions, and principles of justice. Among the arguments supporting our theory, we mention the following:

- Every invention (like all other intellectual creations) is the expression of an individual's thinking – the inventor's and not recognizing the author's paternity of the invention, including by legal means, is equivalent to denying their identity;
- According to the philosophy of natural law (John Locke, Hugo Grotius), every individual has the right to the fruits of their labour. If a person creates something new through their own intellectual effort, that person is entitled to recognition as the author. Acknowledging someone else as the author would be a moral injustice – a violation of the natural right of the true and sole creator over their own work;
- Ethics upholds the value of truth as a fundamental principle of human relationships (not only Immanuel Kant). Society has a duty to recognize and uphold the truth, and distorting the reality regarding the author of an invention means promoting a lie. Recognizing the real author shows respect for truth and intellectual honesty - this is a matter of conscience for all other creators;
- Justice, based on the principle of „to each what they are due“, demands that benefits and recognition be distributed in accordance with each individual's contribution. To attribute undeserved merit to someone else means violating the principle of equity and creates a society in which rewards are not aligned with actual merit;
- If society fails to recognize genuine inventors, their motivation for research, creation, and progress diminishes. Thus, it is in society's interest to acknowledge true authors in order to encourage ongoing innovation.

Law should never contradict morality – if only because behaviour established by people as a moral rule cannot, in principle, contradict a legal rule. And yet, in patent law, the right of the first inventor is overridden by the right of the first applicant to file a patent for the same invention. The preference given to the first applicant, to the detriment of the first inventor – no matter how many and how serious the injustices it has caused in the world of inventors – has a long tradition. Even the USA eventually aligned with this approach, albeit only in 2013 and in a somewhat milder version of the first to file rule. This version is known as the first inventor to file, which we believe better aligns with the need for order, stability, and legal certainty in the field of inventions. However, the fact that the first to invent rule was in effect in the USA until the 2013 amendment of the patent law does not mean that the principle of granting patents and protection to the first inventor had not already been overlooked in that country.

The case of insulin, invented by Romanian physician Nicolae Paulescu (and patented by him in Romania in 1924), and the case of the „flying sack“ created by Romanian inventor Justin Capră in the 1950s and later patented in the USA in 1961 by Bell Aerosystems – known as the „jetpack“¹ – are among the most well-known in Romania. In the case of insulin, the story is also internationally recognized, often referred to in the history of inventions as "the theft of the 20th century." Indeed, the discovery of insulin (pancrein, in 1916) and the invention of its manufacturing process (in 1921) by Romanian doctor Nicolae Paulescu was attributed to Canadian inventors who obtained a USA patent in 1922 and were even awarded a Nobel Prize for it. This stands as one of the most famous injustices in the scientific world - an example of the failure to recognize the priority of the true first inventor.²

¹ In the USA, Bell Aerosystems was granted US Patent no. 3021095A on 13.02.1962, for a „Propulsion Unit“, with Wendell F. Moore listed as the inventor. The patent describes an "individual flight device (rocket belt) powered by hydrogen peroxide, intended for personal transport over short distances." The patent expired on 13.02.1979. This information is available under <https://patents.google.com/patent/US3021095A/en>. However, in the United States, Justin Capră's priority was never recognized.

² Insulin was discovered by C. Paulescu in 1916, who at that time named it pancrein. On 23.07.1921, N. Paulescu published his 26-page paper titled „Pancrein and the Process of its Manufacture“ in the journal „Comptes Rendus Hebdomadaires des Séances et Mémoires de la Société de Biologie et de ses Filiales“ (see article on Ziare.com: „Insulin, a Romanian Invention: 90 Years Since the Theft of the Century – Documentary“). On 10.04.1922, the Ministry of Commerce and Industry, through its patent office, granted Nicolae Paulescu a patent for

Patent laws (and this is not limited to Romanian law) almost entirely overlook the moral rights of inventors, despite having every reason to acknowledge them and despite their importance – which is in no way lesser than that of creators protected under copyright law. While the right to be recognized as the inventor, the right to be named, and the right to disclose the invention (in the case of independent inventors) are undoubtedly moral rights of inventors, the **right of priority** has an ambiguous nature. This is for the simple reason that the right of priority can be transferred – whether for a price or not – whereas pure moral rights are intimately tied to the author's person and cannot be transferred. For this reason, we believe the right of priority has an ambiguous, uncertain, and unclear nature.

However, the right of priority in obtaining a title of protection is not truly effective unless it produces effects beyond those applicable in the country where the patent application is filed – specifically, in other jurisdictions where there is an interest in obtaining protection for an invention for which a filing has already been made.

3. Extended priorities recognized in patent law, their enforcement and invocation

The extended right of priority granted to an inventor is a legal entitlement that allows the inventor to benefit from the filing date of an initial patent application in a member state of the Paris Convention or the WTO, when seeking protection for the same invention in other member states, within a 12-month period starting from the date of the first application. This is an important rule in patent law (as well as in trademark and industrial design law).

Priority, or the right of priority in patenting an invention, is a key legal principle introduced by the Paris Convention of 1883 (also reaffirmed in the TRIPS Agreement), with the purpose of preventing the invalidation of a patent application in a WIPO or WTO member country on the grounds that it was previously filed in another country. Without the rule of priority, the filing made in the other country would be considered part of the prior art and could constitute novelty-destroying prior disclosure.

The right thus recognized:

- Facilitates the international protection of inventions, as applicants are no longer required to file patent applications simultaneously in all the countries where they seek protection – filings can instead be made successively;
- Prevents the loss of rights due to the applicant's own actions, such as filing a patent application that – without the rule of priority – could be used against them in subsequent patent applications;
- Reduces the pressure on inventors, who, through the recognition of the right of priority, gain the time and flexibility needed to obtain protection in other countries and to identify opportunities for commercial exploitation of the invention;
- Grants all applicants, regardless of their country of origin, the same advantages, thus making the patent system fair and equitable.

Under this rule, as implemented in Romanian law, any person who has filed a patent application with OSIM (the State Office for Inventions and Trademarks) or its legal successor benefits from a right of priority starting

the process of producing insulin. The invention (both product and process) was later patented in the U.S. under the name insulin on October 9, 1923, under patent number 1,469,994, listing Frederick Grant Banting (who admitted to having previously read an article about insulin in a Paris publication, after which his research progressed rapidly), Charles Herbert Best, and James B. Bertram Collip as inventors. A Nobel Prize was awarded for this invention in 1923, which caused a huge scandal, as it was granted to F.G. Banting and James Rickard Macleod, who had no real merit aside from providing a suitable laboratory for the research. The title of the patented invention was: „An extract which may be obtained from the pancreas of mammals or from related glands in fish, useful in the treatment of diabetes mellitus, and a method for its preparation.” Information about this patent is available under number 1499077138431967948-01469994. Paulescu applied for his patent stating: „I give this name to the active substance I discovered in the pancreatic extract. This substance has the remarkable property that, when injected into a diabetic animal, it causes a reduction or even a temporary elimination of hyperglycemia...” and „In order for pancrein to be effectively used in the treatment of diabetes in humans, it must be prepared in large quantities, which requires significant capital. I claim the invention of the organic product pancrein, which, when injected into the bloodstream, produces a reduction or even a temporary elimination of diabetes symptoms.”

More information can be found in „103 Years Since the Discovery of Insulin (July 23, 1921)” —an article signed by three leading figures in Romanian medical science and published in ActiveNews (<https://www.activenews.ro/stiri/Despre-savantul-Nicolae-Paulescu-la-centenarul-descoperirii-insulinei-un-amplu-articol-semnat-de-trei-nume-de-referinta-ale-lumii-medicale-romanesti.-PLUS-FOTO-GALERIE-DE-LA-ACADEMIE-168219>), including a photo gallery from the Academy. Despite his efforts during his lifetime (1869-1931), Paulescu did not achieve success. However, following an international campaign by scientists worldwide, in 1969, the Nobel Committee officially recognized N. Paulescu's merits and priority in the discovery of insulin and the invention of its production process.

from the filing date of that application, against any subsequent filing relating to the same invention (art. 16 of the Romanian Patent Law no. 64/1991 – LBI).

Current Romanian patent law recognizes two types of priority:

- Conventional priority;
- Internal priority.

An **exhibition priority** in favour of inventors was eliminated by Law no. 28/2007, which nonetheless established that the introduction of an invention in an exhibition is **not considered novelty-destroying**.

4. Conventional priority

The conventional right of priority is regulated by art. 19 LBI, which stipulates that any person who has duly filed a patent application, utility model, or utility certificate application in any state that is a party to the Paris Convention for the Protection of Industrial Property or a member of the WTO, or their legal successor, benefits from a right of priority when filing a subsequent patent application in Romania for the same invention. This priority right is valid for 12 months from the filing date of the initial application.

Thus, conventional priority refers to the privileged situation granted to a person who has filed a national application in one of the countries that are either party to the Paris Convention or members of the WTO. This person may acquire a right of priority that uses the filing date of the initial application for any subsequent application submitted in Romania.

This right is a legal fiction under which later patent applications filed in other countries claiming priority are treated as if they were filed on the same date as the first application, taking precedence over applications filed by others during the priority period for the same invention.

Any filing that qualifies as a regular national filing under the national laws of a state party to the Paris Convention or a WTO member state where it was made gives rise to a right of priority.

A European patent application designating Romania, for which a filing date has been accorded, is considered equivalent to a regular national filing in Romania, taking into account, when applicable, the priority claimed in the European patent application.

The applicant of a patent application in Romania may benefit from the priority of an earlier patent application for the same invention if, along with the application, they submit a declaration claiming the priority, supported by priority documents. The priority claim declaration must include: (a) the filing date of the earlier application; (b) the number of the earlier application; (c) if the earlier application is a national one, the name of the state party to the Paris Convention or WTO member state in which it was filed; (d) if the earlier application is a regional application, the name of the authority granting regional patents under the relevant treaty; (e) if the earlier application is an international application, the name of the receiving office where it was filed.

These details can only be corrected if: a) a request signed by the applicant or authorized representative, explicitly asking for correction, is filed within two months after the 12-month priority period; b) the publication fee for the correction is paid within four months from the date the patent application was filed or the national phase was entered.

If the earlier application is regional or international, the priority claim may also specify one or more Paris Convention countries for which the earlier application was filed. If the earlier application comes from a state that is neither a Paris Convention party nor a WTO member, the priority claim must include at least one Paris Convention or WTO member state for which the earlier application was filed.

A patent application may claim multiple priorities only for those elements disclosed in the application(s) whose priority is claimed. Multiple priorities can be claimed for the same claim if applicable. Priorities from different earlier applications, including from different countries, may be claimed, but cascading priorities are not permitted.

Priority can only be recognized for elements clearly disclosed in the earlier patent application considered in its entirety. In other words, the scope of protection claimed in the subsequent application cannot exceed that of the priority application. The problem, solution, and essential features of the invention in the subsequent application must be identical to those of the earlier one for the priority date to be validly claimed. Furthermore, the subsequent application must contain new inventive knowledge to support the recognition of priority from the earlier application. If certain features in the later application do not appear in any claim of the earlier

application, priority may still be recognized if those features are clearly and unambiguously derivable from the overall content of the earlier application.

In a patent application claiming one or more priorities from earlier applications, each claimed priority will be recognized even if the application contains one or more features not disclosed in the earlier application(s), provided there is unity of invention. Recognition of each priority applies only to the part of the subsequent application's disclosure that is contained in the disclosure of the earlier application(s). For parts not disclosed in the earlier application(s), the filing date of the subsequent application will serve as the priority date.

The applicant may claim priority from a first filing of a non-unitary application, whether or not it was divided in the country of origin. A divisional application may benefit from the priority claimed in the original application that was divided.

Priority may also be recognized for a patent application filed after the expiration of the priority period, provided it is no more than two months late and the fee is paid, if: a) an express request is submitted under the rules of the implementing regulation; b) the request is timely; c) the request explains why the priority period was missed; d) OSIM finds that the late filing was despite the applicant's due diligence or that the delay was unintentional.

If the applicant claims a priority right belonging to another person, OSIM requires an authorization from the assignor confirming that the applicant has the right to claim that priority. The authorization must be submitted within three months from the date the priority was claimed.

If an applicant fails to claim priority at the time of filing, the claim can be made within two months from the filing date, with the legal fee paid.

For a patent application filed within 12 months from the earliest priority date, priority may be claimed within two months after the expiration of the 12-month period, provided that: a) a signed request to add the priority claim is submitted within the two-month window; b) the fee for claiming priority after the filing date is paid.

The application must be filed before requesting its publication or before OSIM processes a withdrawal request or issues a rejection.

Priority documents must be submitted within 16 months from the earliest claimed priority date or, as applicable, within four months from the national phase entry date.

If OSIM deems it necessary during examination, the applicant may be asked to provide a Romanian translation of the earlier application that forms the basis of the priority claim.

If the applicant fails to meet the deadlines for submitting the priority document or comply with the legal provisions for priority recognition, OSIM will decide, within six months from the filing date or national phase entry, that the priority is not recognized.

The fee for each claimed priority must be paid:

- within four months from the filing date, if the priority was claimed at filing; or
- upon national phase entry.

Failure to pay the priority fee in the correct amount and within the legal deadline will result in the priority not being recognized.

5. Internal priority

In addition to regulating conventional priority, LBI also provides for internal priority. Thus, art. 20 LBI stipulates that if, within 12 months from the filing date of a patent application (as established by OSIM), a subsequent patent application is filed by the applicant of the earlier application or their legal successor, the subsequent application may claim a right of priority for the same invention.

Internal priority may be claimed either upon filing the subsequent application or within two months from its filing date.

If internal priority is claimed in a subsequent application, the earlier application from which priority is claimed shall be deemed withdrawn, provided that no decision has been issued in the meantime.

At the request of the applicant and upon payment of the issuance fee, a certificate of internal priority is issued by OSIM and attached to the subsequent patent application in which the internal priority is claimed. The fee for claiming internal priority must be paid within four months from the filing date of the subsequent application.

Internal priority of an earlier application, claimed in a later application, will not be recognized if:

- at least one of the patent applications has already benefited from a priority right;
- the earlier application claimed internal priorities, and one of those priorities has a date earlier than 12 months prior to the filing date of the later application;
- the internal priority certificate was not submitted within the timeframe provided by the implementing regulations of the present law.

Furthermore, failure to claim internal priority in the subsequent application, failure to submit the required certificate, or failure to pay the internal priority fee will lead to the non-recognition of the claimed priority.

6. The elimination of exhibition priority from patent law

In the legislation of many countries, an exhibition priority has also been recognized in favour of applicants who, before filing a patent application, introduced their invention at an international or internationally recognized exhibition. However, in the field of inventions, this type of priority has been gradually abandoned; in Romanian law, its elimination was effected by Law no. 28/2007 (amending the Patent Law). Nonetheless, this priority has been retained in trademark and industrial design law.

Exhibition priority functioned similarly to conventional (or union) priority, beginning from the date the invention was introduced at the international or internationally recognized exhibition. Its elimination resulted from several causes. Among those identified (though not necessarily in order of importance), the arguments in favour of eliminating it include:

- exhibition priority conflicted with the principle of absolute novelty found in modern patent systems;
- the Paris Convention of 1883 regulates only conventional priority. Regarding inventions introduced at exhibitions, it merely provides that member countries shall grant, under their national laws, temporary protection to patentable inventions exhibited at international or internationally recognized exhibitions;
- a lack of clarity and practical difficulties – it was often hard to determine whether an invention shown at an exhibition was identical to the one later claimed in the patent application, raising questions about the level of detail needed for an invention to be considered disclosed;
- risk of abuse and subjective interpretation, as exhibitors might attempt to claim priority without properly documenting the invention, and some exhibitions lacked clear rules on verifying the content of the displayed inventions;
- administrative and legal complications, since patent authorities had to analyse exhibition documents to verify whether the invention met the conditions for priority. The absence of internationally uniform standards made this process difficult;
- lastly, the genuine and serious interest in such a priority has decreased, as filing a patent application is relatively easy today, and even an incomplete first filing is enough to secure a right of priority.

Exhibition priority was justifiably eliminated because it was difficult to manage, subject to potential abuse, and had become unnecessary in the presence of conventional priority, which is clearer and easier to apply. Inventors are now generally cautious enough to file a patent application before publicly disclosing their invention, thereby avoiding the loss of protection rights.

7. Submission of the exhibition certificate

Although exhibition priority is no longer applicable in patent law, if an invention was presented at an international or internationally recognized exhibition, the submission of an exhibition certificate is required to counter the consequences of a novelty-destroying disclosure. The exhibition presentation is considered a non-prejudicial disclosure. In other words, the exhibition certificate is essential to prove that the disclosure at the exhibition does not affect the novelty of the invention. Without this certificate, there is a risk that the exhibition would be treated as a public disclosure, which could lead to the loss of the right to obtain a patent.

The exhibition certificate must be submitted within four months from the filing date of the patent application (art. 28 of the Implementing Regulations of LBI) and must include:

- the name and address of the authority responsible for industrial property protection at the exhibition where the invention was displayed and which issued the certificate;
- the name of the exhibition, its location, and opening date;

- the name and address of the individual or the name and registered office of the legal entity that submitted the invention for exhibition;
- confirmation that the invention was indeed exhibited;
- the date of the first disclosure of the invention;
- the certificate number and issue date;
- a copy of the description of the exhibited item, written in Romanian and certified by the authority responsible for industrial property protection at the exhibition, proving that the exhibited item is identical to the one described.

If the first disclosure of the invention occurred after the opening of the exhibition, the certificate must state the actual date of the first disclosure. The certificate may be accompanied by a document identifying the inventor, authenticated by the relevant authority. The certificate must be submitted in Romanian; if not, a certified translation must be provided upon OSIM's request.

8. Omission of priority claim and proof of priority right

If the applicant failed to claim priority at the time of filing the patent application, it may still be claimed within two months from the filing date, upon payment of the legal fee [art. 21 para. (1) and (2) LBI]. The priority document must be submitted within 16 months from the date of the earliest priority. It consists of a copy of the first patent application, including the certified filing date by the office where it was filed. This may also confirm the filing of a utility model application, which can serve as the basis for claiming priority.

9. Non-recognition of Claimed Priority

The examination commission must reject claimed priorities when:

- the applicant does not claim the priority within the legal deadline (at filing or within two months from the filing date, and within 12 months from the first filing date);
- there are significant differences between the initial and subsequent applications – if the claimed invention does not match or contain the same technical essence as the one in the priority application, priority is denied;
- the priority application was invalidated, withdrawn, or cancelled;
- the applicant is not the rightful holder of the priority application and cannot prove ownership (*e.g.*, through assignment or legal succession);
- required documents (certified copy and translation if necessary) are missing or late;
- multiple priority claims are incorrect or conflicting;
- the priority application is not the first for the same invention – if another application was filed earlier and priority was not claimed from it, the new claim is rejected.

In such cases, the patent application will be examined without the benefit of priority, which may affect the invention's novelty and patentability.

10. Priority in international patent applications

When priority is claimed in an international application and the national phase is opened, but the priority document was not submitted to WIPO within 16 months as per Rule 17 of the PCT Regulations, it can be submitted to OSIM within:

- four months from national phase entry, if the applicant proceeds in Romania;
- two months from national phase entry, if that occurs within two months after the 30-month deadline.

Upon request, OSIM may retrieve the priority document in electronic form from a digital library of a Paris Convention or WTO member state.

11. Authorization for transfer of priority rights

The authorization for the transfer of priority rights, permitted under the Paris Convention of 1883, is the document by which the holder of a patent (or utility model) application transfers the priority right to another

person or entity. This right allows the assignee to claim the priority date of the initial application when filing in other jurisdictions.

The object of the transfer is the right to claim the priority – not necessarily the entire patent application – and the beneficiary may use this right to file in other countries while preserving the same priority date.

The authorization must be filed at OSIM by the assignee, and it must state the right to claim the first filing's priority. The filing deadline is 17 months from the priority date (art. 24 of the Implementing Regulations). If the authorization is not filed, OSIM will reject the priority claim. If successive assignments occurred, all must be registered at OSIM within 17 months of each transfer.

12. Conclusions

The right of priority is an essential mechanism for both domestic and international protection of inventors and their inventions. It ensures equal treatment among applicants from different countries. Its regulation in Romanian law aligns with international standards, offering effective protection tools and legal certainty. Correct and timely invocation of priority can make the difference between the approval and the rejection of a patent application.

References

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