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Priority periods do the long jump: RCD may claim priority from PCT application within 12 months

European Union - [Bugnion SpA](#)

- The nature of the earlier right based on which priority is claimed is decisive to determine the duration of the priority period
- An RCD can claim priority from a PCT application if it is filed within 12 months of the PCT application
- It is still unclear whether the 12-month period is applicable to all patent applications or only to PCT applications

With training and the right equipment, even priority periods can improve their performance by jumping from six to 12 months.

Background

A multiple application for registration of registered Community designs (RCDs) (No 005807179) was filed on 24 October 2018, designating gymnastic or sports equipment. The applicant claimed priority based on the international patent application No PCT/EP2017/077469, filed on 26 October 2017. In [The KaiKai Company Jaeger Wichmann v European Union Intellectual Property Office](#) (EUIPO) (Case T-579/19), the General Court stated that, in this case, the priority period to be applied was 12 months.

The facts can be summarised in two points:

- an RCD application was filed claiming priority from a Patent Cooperation Treaty (PCT) patent application; and
- the priority claim was refused for all RCDs, because the filing date of the PCT patent application was more than six months before the filing date of the RCDs.

Decision

First point

The first point was not in dispute because the EUIPO has long accepted, and even advocated, the possibility of accepting PCT applications as a basis for priority claims for RCDs. A newsletter by the EUIPO (then named the Office for Harmonisation in the Internal Market) dated February 2010, entitled "Claiming a PCT priority for a Community design", states that:

the fact that the PCT covers the utility models existing in some member states and that all the PCT member states are also members of the Paris Convention explains why a Community design can rightfully claim the priority of a PCT application. The link is explicitly made in Article 41 [of Regulation 6/2002], which says that a priority may be claimed where the earlier application is for "a design right or a utility model in or for any state party to the Paris Convention".

This interpretation was maintained in Point 6.2.1 of the EUIPO design guidelines, which states that:

the priority of an international application filed under the [PCT] can be claimed, since Article 2 of the PCT defines the term 'patent' in a broad sense that covers utility models.

Second point

The issue raised by the second point is whether it is correct to apply a six-month priority period where an RCD claims priority from a PCT application. This issue arises because there is no explicit provision in this respect, either in Article 41 of [Regulation 6/2002 on Community designs](#) or in the [Paris Convention](#). The following legislative framework regulates the priority period in case of mixed (patent/design) priority periods:

- Article 4(A)(1) of the Paris Convention introduces priority rights;
- Article 4(C)(1) of the convention specifies that the periods of priority shall be 12 months for patents and utility models, and six months for industrial designs and trademarks;
- Article 4(E)(1) of the convention governs the priority period (six months) where a subsequent design application claims priority from a utility model application;

- Article 4(E)(2) of the convention allows the filing of a utility model by virtue of a right of priority based on the filing of a patent application, and vice versa.
- Article 2 of the PCT contains a broad definition of the terms 'application' and 'patent', with the latter comprising utility models.

These provisions can be read in two alternative ways:

- The wording of Article 41(1) of Regulation 6/2002 is exhaustive, meaning that only design or utility model applications can be used as a basis for a priority claim of a subsequent RCD. Patent applications are excluded, with the exception of PCT applications, as these also cover utility models in view of the broad definition under Article 2 of the PCT. The consequence is that there is only one possible priority period - that is, six months.
- The wording of Article 41(1) Regulation 6/2002 is not exhaustive, and the Paris Convention shall be used to fill the gap related to PCT patent applications. In this case, according to the general rule that the nature of the earlier right determines the duration of the priority period, there is always a 12-month priority period when claiming priority from a PCT patent application. Article 4(E)(1) of the Paris Convention provides an exception applicable only to utility models because, contrary to patent applications, they are quickly published, so applying a 12-month priority period in this case would involve an actual risk that the subject-matter of a published utility model would be re-filed as a design.

The General Court followed the second interpretation. However, this is probably not the end of the game as the decision can be appealed to the Court of Justice of the European Union (CJEU).

Comment

An appeal is not only likely, it would also be welcome if the CJEU explicitly clarifies whether the 12-month period is applicable to all patent applications or only to PCT applications due to the broad definition set forth in Article 2 of the PCT. Arguably, it is not clear in the General Court's decision, even if there was a clear contrast with Article 4(E)(1) of the Paris Convention, whether the 12-month period is applicable only to PCT applications as these encompass utility model applications.

The subject-matter of a patent can be a product, so where the patent application comprises drawings clearly showing the appearance of that product, why could this appearance not be claimed later in an RCD application?

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