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Establishing Priority Dates Of Claims In A Patent Specification

Introduction

Priority date is imperative to claims of a patent application because knowledge or information available in the public domain before the priority date is taken into consideration while determining whether the claim(s) are entitled to be granted or rejected. Delay in securing the priority date may lead to addition of more information or knowledge to the public domain, which may adversely affect possibility of a patent grant. The approach applied by the patent office in India to assign priority date to claims is discussed in this article.

Determining priority date

A complete patent application may include one or more claims, and each and every claim of the patent application is assigned a priority date. In other words, different claims in a patent application can have different priority date.

In case a complete patent application is claiming priority from a previously filed provisional patent application, and if a claim of the complete patent application based on the subject matter disclosed in the provisional patent application, then the priority date of the claim will be the filing date of the provisional patent application.

The law in India allows an application filed as a complete patent application to be considered as a provisional patent application, if a request is made within 12 months of filing the above referred complete patent application. A subsequent complete patent application that is filed by claiming priority from such a provisional patent application can have a claim based on the subject matter disclosed in above referred provisional patent application. In such as scenario the claim's priority date will be the filing date of the provisional patent application (which was filed as a complete patent application earlier).

A complete patent application may be filed by claiming priority from two or more provisional applications. In case a claim in such a complete patent application is based on the subject matter disclosed in one of those provisional patent applications, then the priority date of the claim will be the filing date of the provisional patent application in which the subject matter is disclosed.

On the other hand, if a claim in such a complete patent application is based on the subject matter disclosed in parts in multiple provisional patent applications, then the priority date of the claim will be the filing date of the provisional patent application that was last filed.

A complete patent application may be filed within 12 months of a previously filed application in India, and claim priority from the same. In case a claim in such a complete patent application is based on the subject matter of the previously filed application, then the priority date of the claim will be the filing date of the previously filed application.

A claim in a divisional patent application will have its priority date as the filing date of an earlier application (provisional(s) or complete from which the divisional application originated) in which the subject matter on which the claim is based on is first disclosed.

A complete patent application filed in India may claim priority from one or more applications filed in a convention country. A claim in such a complete patent application will have the priority date as the filing date of the application in the convention country in which the subject matter on which the claim is based on was first disclosed.

Conclusion

Priority date of a claim has a bearing on what can be considered as prior art to a claim in a patent application. The points discussed above provide an overview of how priority date is determined in different scenarios. Hence, claims should be drafted in such a way that an earliest priority date is established, while also considering the scope of protection desired, especially when a complete patent application claims priority from multiple patent applications.

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