



## CONCEPT AND ESSENCE OF THE INSTITUTION OF PRIORITY IN INTELLECTUAL PROPERTY LAW

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### ABSTRACT

*The present scientific article is devoted to the research of the concept of the institute of priority in intellectual property law, as well as the analysis of doctrinal approaches to the definition of the concept of priority by national and foreign scholars. The article analyzes the legislation on the definition of the concept and essence of the institute of priority, its types, classifications by object and terms of validity of priority in accordance with the provisions of the Paris Convention for the Protection of Industrial Property.*

It is indisputable that the fundamental right in the field of intellectual property is the exclusive rights of the right holder to the results of intellectual activity created by him, which allow him to ensure the protection of his rights and limit the illegal use of the created results of intellectual activity by third parties. The emergence of exclusive rights to industrial property items, as a rule, is associated with the fulfillment of formal procedures in the form of filing an application, conducting expert examinations, and obtaining documents certifying the exclusive right in the form of a patent or certificate. However, often several persons claim the same intellectual property subject matter and in such cases the concept of priority is of crucial importance.

As correctly noted by N.S. Mikhailova, “in cases where the legislator presumes the possibility of the emergence of similar results of intellectual activity in the course of independent parallel creativity or when it comes to means of individualization, the question of priority arises”<sup>1</sup>. We agree with this statement, as there are often situations of simultaneous creation of objects of identical industrial property and application for registration of identical trademarks by several persons. In order to regulate such cases, the legislator has provided for the institute of priority, the essence of which we will try to further disclose in this paper.

The emergence of the concept of priority made it possible to exclude situations of granting several patents (certificates) for identical protected results of intellectual activity and granting several exclusive rights to the same subject matter. But what is the concept of “priority”? K.V. Rybkina gives the following definition: “the term ‘priority’ means in the general sense

<sup>1</sup> Mikhailova N. S. Priority in the field of intellectual rights // Ex jure. 2019. № 3. Pages 70-80. DOI: 10.17072/ 2619-0648-2019-3-70-80.



'superiority', 'preferential right', and here it means the date on which the novelty and inventive step of an invention or other signs of protectability of another object of industrial property (utility model, industrial design, trademark) are determined"<sup>2</sup>. Priority in its essence is an international mechanism of protection of property rights of "first" bona fide right holders, which allows them to claim a certain privilege in comparison with other applicants for registration of industrial property or trademark. There is no legal definition of the term "right of priority" in the legislation of the Republic of Uzbekistan. Nevertheless, the terms of validity of priority, the procedure for establishing and claiming priority are regulated by special norms of national legislation.

"Priority makes it possible to determine the primacy of the applicant and gives him an advantage in obtaining a patent over others who claimed the created intellectual property object later. It is the priority that is the 'reference point' that fixes the date, relative to which the patentability of the industrial property object will be determined,"<sup>3</sup> says the patent attorney of the Russian Federation and an expert in the field of industrial property Olga Dolgikh, also a patent attorney of the Russian Federation and an expert in the field of mechanics, notes.

A. K. Yurchenko defined the right of priority as a claim to fix the fact of filing an application (proposal) by one author before others<sup>4</sup>. The scientist disclosed the content of the subjective right of priority through the following powers:

- 1) the right to demand from the authorized body to carry out research of the application for novelty taking into account the information available only on the priority date;
- 2) the right to demand from the authorized body to conduct a study of the novelty of subsequent applications with mandatory involvement of the previously filed application;
- 3) the right to be considered in relations with third parties of the first applicant<sup>5</sup>.

The right of priority means that the applicant has the right to apply for protection of his industrial property or trademark within a certain period in all member countries after the filing of a duly executed national application in one of the member countries, and thus his application in other member countries of the Paris Convention will be considered as the date of filing of the first national application. In other words, within a certain period this applicant, in comparison with other applicants enjoys the privilege of priority even if in fact his application comes to the authorized body of the Paris Convention member country later than local applications.

The priority institute is aimed at protecting the rights of inventors, designers, entrepreneurs and other interested parties from illegal copying and legalization of the result of their intellectual activity. This institute allows subjects to protect their rights in other member states of the Paris Convention for the Protection of Industrial Property without losing the priority date. Priority rights also provide interested parties with a grace period to refine and improve their inventions and designs before filing an application in other countries.

Commenting on the provisions of the Paris Convention for the Protection of Industrial Property, Professor G. Bodenhausen pointed out that the right of priority (in this case,

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<sup>2</sup> Rybkina K.V. Correlation of the right of priority of intellectual property objects with other rights. INTELLECTUAL POTENTIAL OF THE XXI CENTURY: STAGES OF COGNITION. 2016. Page 172.

<sup>3</sup> <https://zuykov.com/about/articles/prioritet-izobreteniya-poleznoi-modeli-hto-eto-takoe-kakoi-on-bivaet-i-zachem-nuzhen/>

<sup>4</sup> Yurchenko A. K. Patent science. L.: Izd. v. Leningr. un-sta, 1973. Page 20.

<sup>5</sup> Yurchenko A. K. Problems of Soviet inventive law. L.: Izd. v. Leningr. un-sta, 1963. Pages 93-95.



conventional priority) arises only on the basis of the first filing of an application in one of the member countries. This right may be transferred to a successor irrespective of the transfer or non-transfer of the first application on which this right is based. This right remains autonomous until, during the term of the right, it is used as the basis for an application in one or more Member countries. In that case, the right of priority becomes concessional to the application filed<sup>6</sup>. In other words, the right of priority passes to the heirs and successors as it is not a personal non-proprietary right of the first applicant.

The essence of the institution of priority is to enable applicants to protect their rights to an intellectual property object if they have already filed an application for that object in another country. This means that an applicant can use priority to assert its right to an intellectual property object and protect it from unfair competition. The institution of priority in intellectual property law plays an important role in ensuring the protection of the rights of applicants and stimulating the development of the sphere of innovation and modern technologies. Understanding its essence and mechanisms of use is necessary for effective protection of intellectual property and ensuring fairness in the market of innovation, creativity and entrepreneurship.

Based on the above definitions, it can be concluded that the right of priority should be understood as the right of a person who has applied for registration of an industrial property object in one country to require the same filing date in the other countries where he applies in the following six (twelve) months. For example, if an inventor applies for a patent in his own country and then applies for the same patent in another Paris Convention Member State within twelve months of filing the first application, he may claim the filing date of the first application as the filing date of the second application.

As Ning Zhang correctly points out, the right of priority is important for the protection of exclusive rights in subject matter at the global level, especially for enterprises operating in multiple countries. It provides a mechanism for inventors and designers to protect their rights in multiple jurisdictions without having to simultaneously file separate applications in each country, which can be costly and time-consuming<sup>7</sup>. For example, if an enterprise applies for trademark registration in Uzbekistan, it retains the privilege of registering the same trademark within six months from the date of filing of the original application in the remaining member states of the Paris Convention for the Protection of Industrial Property.

The legislation of the Republic of Uzbekistan links the establishment of priority to a specific date, in other words, equates priority to the original filing date of the application. Therefore, there is a point of view in civilistics, according to which priority is the date on which novelty and other conditions of patentability are established. Undoubtedly, such a viewpoint has the right to exist, but it is hardly justified at present, since the current civil legislation links priority to a specific date, but does not identify it with it. In addition, such an approach to the establishment of priority is not the only one. Thus, A. A. Pilenko, answering the question “who is authorized to obtain a patent for an invention?”, considered the American, Anglo-German and

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<sup>6</sup> Bodenhausen G. Paris Convention for the Protection of Industrial Property. Commentary. Moscow: Progress, 1977. Pages 51-52.

<sup>7</sup> <https://flatfeecorp.com/articles/priority-rights-intellectual-property>



French systems of law. In the United States, a patent was granted to the first and true inventor. In France, it was granted to the first applicant<sup>8</sup>.

Priority, according to the current legislation of the Republic of Uzbekistan and international acts, may be conventional or exhibition. As noted by O.E. Koteneva, "conventional priority is a rule according to which an application filed in one of the member countries of the Paris Convention for the Protection of Industrial Property has priority in all other countries for 12 months for inventions and utility models and 6 months for trademarks and industrial designs from the date of filing of the first application. The condition for convention priority is that the national application be properly filed in accordance with the domestic law of the country"<sup>9</sup>. The rule of conventional priority allows an applicant to prepare application documents for filing with the patent offices of the Member States without fear of losing the novelty of the subject matter of the application within the prescribed time limit, since any acts performed between the filing dates of the first and later applications within the agreed time limit do not deprive the applicant of the right to obtain a protection document for the later application<sup>10</sup>. Where an application for which priority is claimed is filed, the earlier application shall be recognized as withdrawn. However, priority may not be established on the basis of the filing date of an application for which earlier priority has already been claimed.

Priority may also be claimed in respect of a divisional application. As noted by V.V. Likholetov, "filing a divisional application allows obtaining a patent in respect of those variants of the application that do not raise objections of the examination, and in respect of 'rejected' variants there is an opportunity to continue the proceedings within the framework of an independent application. The priority of such variants will be established by the date of filing of the original application by the same applicant with Rospatent, and if there is a right to establish an earlier priority for the original application - by the date of this priority under the following conditions: - as of the date of filing of the divisional application, the original application has not been withdrawn or recognized as withdrawn; - the divisional application is filed before the possibility provided by the legislation to file an opposition to the decision on refusal to grant a patent for the original application is exhausted, or before the date of registration of the invention"<sup>11</sup>.

It is noteworthy that in the Republic of Uzbekistan conventional priority may be claimed in respect of all industrial property objects, trademark and breeding achievement. However, exhibition priority may be claimed only in respect of a trademark. In other words, an applicant, when filing an application for registration of an invention, utility model or industrial design, as well as breeding achievement, may not request exhibition priority. This norm, in our opinion, limits the rights of potential right holders for industrial property objects and selection achievements, as these objects are more susceptible to violations of personal non-property and exclusive rights.

<sup>8</sup> Pilenko A. A. op. cit. pages. 322-325.

<sup>9</sup> Koteneva O.E. Legal protection of intellectual property objects: educational and methodical manual / O.E. Koteneva. - SPb.: ITMO University, 2018. Page 56.

<sup>10</sup> Likholetov, V.V. Economic and legal protection of intellectual property: textbook / V.V. Likholetov, O.V. Ryazantseva. Likholetov, O.V. Ryazantseva. - Chelyabinsk: SUSU Publishing Center, 2018. Page 92.

<sup>11</sup> Likholetov, V.V. Economic and legal protection of intellectual property: textbook / V.V. Likholetov, O.V. Ryazantseva. Likholetov, O.V. Ryazantseva. - Chelyabinsk: SUSU Publishing Center, 2018. Page 92.



According to part three of Article 12 of the Law of the Republic of Uzbekistan “On Trademarks, Service Marks and Appellations of Origin of Goods”, the priority of a trademark placed on the exhibits of official or officially recognized international exhibitions organized in the territory of one of the States that have acceded to the Paris Convention for the Protection of Industrial Property, may be established by the date of the beginning of the public display of the exhibit at the exhibition (exhibition priority), if an application to the Ministry of Justice of the Republic of Uzbekistan for the registration of the trademark is submitted to the Ministry of Justice of the Republic of Uzbekistan. Consequently, in order for the interested party to benefit from exhibition priority in the Republic of Uzbekistan, the exhibition at which the exhibit containing the trademark was displayed must be:

- 1) official or international;
- 2) the country in which the exhibition was organized must be a party to the Paris Convention for the Protection of Industrial Property.

Similar requirements for the exhibition are provided for in the territory of the Russian Federation. As K. Filippova notes, “the exhibition priority is the date of the beginning of the public display of the exhibit, which contains (on the packaging or directly inside itself) the image of the trademark applied for registration. This takes into account only the participation of the exhibit in an official or officially recognized international exhibition organized in the territory of a member state of the Paris Convention providing protection of industrial property”<sup>12</sup>.

It should be emphasized that the right of priority does not apply to copyright objects, but only in relation to industrial property and means of individualization. As correctly pointed out by V.S. Antimonov, E.A. Fleishits, the concept of primacy (priority) in copyright law is irrelevant. Since the form has decisive importance for copyright objects, it is practically impossible for two works to be identical both in their content and in their form<sup>13</sup>. However, there is another point of view in the scientific literature, according to which copyright also has a right of priority, even if it is not fixed by the letter of the law. One of the adherents of this idea is V.A. Rassudovsky, according to whom “The moment of creation of works of science is usually fixed in time, because before their publication they are not published, they have the right of priority. The moment of creation of works of science is usually fixed in time, because before their publication they pass a number of intermediate stages, prepare for reproduction. stages, are prepared for reproduction in the form of manuscripts, drawings, are discussed. The submission of the work to the editorial office of the journal also has a certain significance; the deadline for receipt of the manuscript is noted and in a number of scientific journals is indicated at the time of its publication. All these are ways of fixing the priority, although the priority itself is not legally certified”<sup>14</sup>.

We agree with the opinion of V.A. Rassudovsky and believe that priority takes place not only in the field of patent law and means of individualization, but also in copyright law, since copyright works can also be simultaneously claimed by several persons. This is confirmed by the presence in the Law of the Republic of Uzbekistan “On Copyright and Related Rights” of the

<sup>12</sup> <https://legal-support.ru/information/fag/trademark/chto-takoe-konvencionnyi-i-vystavochnyi-prioritet/>

<sup>13</sup> Antimonov B. S., Fleishits E. A. Inventive Law. Moscow: Gosurizdat, 1960. Page 16.

<sup>14</sup> Rassudovsky V. A. Law and scientific and technical creativity. Moscow: Profizdat, 1975. Page 39.



concept of deposit of works. The essence of deposit, according to Article 22 of the Law, is to fix the fact and date of use of a copyright work, which allows to claim the right of priority, so that in case of disputes to be able to prove the date and the fact of creation of the work by one or another author.

Summarizing the research article, we can conclude that the institution of priority is an international right of applicants from the countries participating in the Paris Convention for the Protection of Industrial Property to indicate the filing date of the initial application in subsequent applications in other countries. In this case, the original applicants will be granted the privilege of registration even if their application in other countries is actually received later than the national applications. The priority period is 12 months for inventions and utility models, 6 months for trademarks and industrial designs. Priority may be convention and exhibition, but in both cases, the applicants must be from a country party to the Paris Convention for the Protection of Industrial Property, and the exhibition must also be held in the territory of a country party to the Paris Convention for the Protection of Industrial Property in the prescribed order.

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