

Claiming Priority from invalid Patent applications in the UAE

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In discussing the aforementioned question, we will refer to the UAE Federal Law No. 31 for 2006 (the 'UAE Patent Law'), the Paris Convention for the Protection of Industrial Property (the 'Paris Convention') and the Patent Cooperation Treaty ('PCT').

The UAE Patent Law does not provide a clear-cut answer, although Article 11 (1) of the UAE patent law provides some guidance:

An application may contain a request to claim priority from an application that has been filed in another state being a party of an agreement or a treaty with the UAE. In this case, the application date and number of the corresponding filed application should be indicated together with the name of the state.

Upon interpreting Article 11 (1-2) of the UAE patent law, we find that there are two conditions to claim priority in the UAE:

- The priority right shall be claimed from a corresponding filed patent application in another state being a party of an agreement or a treaty with the UAE; and
- The priority application date, number and state shall be indicated in the UAE patent application.

Accordingly, any application filed in another state being a party of an agreement or a treaty with the UAE is adequate to establish the right to claim priority, regardless of the subsequent fate of this application.

On the other side we find that article 4 A(2-3) of the Paris Convention provides clear guidance for claiming priority from invalid patent applications by stating that:

2. Any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognized as giving rise to the right of priority.

3. By a regular national filing it is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application.

In short, the right of priority is based on a regular national filing whatever the subsequent fate of the application. With reference to the priority right under the PCT, Article 8(1) and (2)(a) of the PCT states:

1. The international application may contain a declaration claiming the priority of one or more earlier applications filed in or for any country party to the Paris Convention for the Protection of Industrial Property.

2. a. The conditions for, and the effect of, any priority claim declared under paragraph (1) shall be as provided in Article 4 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property.

The right of priority can be claimed in the UAE from an invalid (withdrawn, abandoned or rejected) patent

application.