

In Re Hilmer AND THE PARIS CONVENTION: AN INTERPRETATION OF THE RIGHT OF FOREIGN PRIORITY FOR PATENTS OF INVENTION

INTRODUCTION

Recently, the United States government began pressuring foreign countries to strengthen their patent laws. In many countries, U.S. inventors cannot get the same patent protection that they get in the United States.¹ Yet, at the same time, the United States' own patent laws discriminate against foreigners.² This comment concerns one of the discriminations against foreigners, the discrimination against foreign patent applications as prior art³ which was affirmed in the case of *In re Hilmer*.⁴ The comment concludes that the *Hilmer* rule violates U.S. obligations under the Paris Convention for the Protection of Industrial Property (hereinafter Paris Convention)⁵ and should therefore be changed.

Under the U.S. patent law, an application for U.S. Letters Patent must first be examined⁶ by the U.S. Patent and Trademark Of-

1. Wall Street Journal April 3, 1986, p.6, col. 3. Address by Ambassador Clayton Yeutter, Annual Meeting of the Am. Intell. Prop. L. Ass'n (Oct. 9, 1986), published in Am. Intell. Prop. L. Ass'n Bull. Sept.-Oct. 1986 p.304.

2. Donald S. Chisum, *Foreign Activity, Its Effect on Patentability under United States Law*, 11 IIC 26 (Int'l Rev. Indus. Prop. & Copyright L. 1980). Karl F. Jorda, *That Discriminatory U.S. Patent Law*, 61 J. PAT. OFF. SOC'Y 95 (1978).

3. See *infra* notes 9-11 and accompanying text.

4. 359 F.2d 859 (C.C.P.A. 1966). The rule was adopted at least as early as 1938 in *Viviani v. Taylor v. Herzog*, 72 U.S.P.Q. 448 (Comm'r Pat. 1938). However, it has attracted the most attention since *In re Hilmer*. See Note, *Patents-Patentability-Effective Prior Art-Date of an United States Patent as of the Foreign Filing Date-Conflicting Decisions*, 16 AM. U.L. REV. 335 (1967); *Recent Developments, Patent Law-Prior Foreign Filing Date of a United States Patent not effective for Purposes of Reference*, 13 HOWARD L.J. 2109 (1967); *Recent Decisions, Patents-Rule 131 Affidavits-Foreign Priority Date not the Effective Date of Patents as a Reference-In re Hilmer*, 35 GEO. WASH. L. REV. 137 (1966). For a general description of the rules involved see *Recent Decisions, U.S. Application by Foreign Inventor-Unclaimed Disclosures in Foreign Application Good as "Prior Art" Only From the Date of U.S. Filing*, 10 VAND. J. TRANSNAT'L L. 485 (1977); Ernest F. Marmorek, *Some Problems in the U.S. Patent Practice Concerning the International Priority*, 55 J. PAT. OFF. SOC'Y 670 (1973); R.B. Brody, *U.S. Treaty Law, The Paris Convention, and 35 U.S.C. § 119*, 53 J. PAT. OFF. SOC'Y 194-200, 256-64 (1971).

5. March 20, 1883, 25 Stat. 1372, T.S. 379, 1 Bevan 80. The latest revision was in Stockholm July 14, 1967, 21 U.S.T. 1583, T.I.A.S. 6923. For a general background see Friedrich-Karl Beier, *One Hundred Years of International Cooperation—the Role of the Paris Convention Past, Present and Future*, 15 IIC 1 (Int'l Rev. Ind. Prop. & Copyright L. 1984).

6. 35 U.S.C. § 131.

fice (PTO).⁷ Part of the examination consists of comparing the invention claimed⁸ in the patent application to the prior art, the state of the art before the applicant made his invention. The prior art consists of publications, patents, and U.S. patent applications.⁹ To pass the examination, the claimed invention must be, among other things, “novel”¹⁰ and “nonobvious”¹¹ in light of the prior art. Otherwise, the invention will be rejected. The prior art is therefore tremendously important to a patent applicant. One similar patent application, when admitted into the prior art, can mean the difference between rejection and allowance.¹² Accordingly, the rules for what qualifies as prior art must be very precise. The *Hilmer* rule is one such rule.

Consider the following scenario:

January 1. Ruritanian inventor R files a patent application in Ruritania.¹³

February 1. U.S. inventor U files a similar patent application in the U.S.¹⁴

7. 35 U.S.C. § 1.

8. A patent application consists of a specification, drawings, and an oath of inventorship, 35 U.S.C. § 111. The specification is a written description of the invention which concludes with one or more claims. The claims must particularly point out the subject matter which the applicant regards as his invention. 35 U.S.C. § 112.

9. 35 U.S.C. § 102 lists the following items as belonging to the prior art:

• More than one year prior to when the applicant made his invention: (1) a patent or printed, published description of an invention in any country and (2) any public use or sale of an invention in the U.S. 35 U.S.C. § 102(b).

Before the applicant made his invention: (1) invention of the same thing by another, 35 U.S.C. § 102(g), (2) knowledge or use of the invention in this country by others, (3) a description of the invention in a printed publication anywhere, 35 U.S.C. § 102(b), and (4) a description of an invention in a granted patent filed in the U.S. 35 U.S.C. § 102(e). A patent application functions as prior art starting on the day it is filed, not on the day it is allowed, even though it is kept secret until that day. *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390, 46 S. Ct. 324, 70 L. Ed. 651 (1926).

10. Novelty is defined in terms of the prior art. Anything which does not appear in the prior art is novel. 35 U.S.C. § 102. *See supra* note 9.

11. Obviousness is defined by 35 U.S.C. § 103.

A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

12. If the issue is novelty, the examiner decides whether the invention is described in the prior art. One earlier application that describes the invention, or claims the invention, if it qualifies as prior art, can bar the later application. If the issue is obviousness, the examiner considers several prior art references which together render the invention obvious. However, removing one of these references from the prior art can destroy the combination that creates the obviousness.

13. Ruritania is used as a variable through this comment. The name refers to any country except the one under discussion but to no country in particular.

14. It is assumed that U and R made their inventions independently and applied for patents in good faith.

March 1. Ruritanian inventor R files a patent application in the U.S. for the same invention claimed in his Ruritanian patent application.

If U's invention is similar to, or the same as R's invention and both seek U.S. patents, then it is crucial to know whether their applications qualify as prior art against each other.¹⁵ U.S. law answers the prior art questions as follows: First, as to U's application, neither of R's applications are prior art against U's application. According to *In re Hilmer*, a patent application becomes prior art as of the date it is filed in the United States PTO. For R this is March 1, one month after U filed his application.¹⁶ U's application precedes R's.

Second, regarding R's U.S. application, U's application is not prior art against it. Both the Paris Convention's Article 4¹⁷ and 35 U.S.C. section 119, which enables the Paris Convention,¹⁸ guarantee priority to R's application as of January 1, the date it was filed in Ruritania, one month before U filed his application. R's application precedes U's. The result is that both applications precede the other and are insulated from any rejections based on the other.

15. See *supra* notes 6-12 and accompanying text.

16. The situation in *Hilmer*, 359 F.2d 859 was slightly more complex than the hypothetical with R and U:

Jan. 24, 1957 Habicht's Swiss filing.

Jul. 31, 1957 Hilmer's German filing.

Jan. 23, 1958 Habicht's U.S. filing.

Jul. 25, 1958 Hilmer's U.S. filing.

The Court concluded that Hilmer was entitled to a patent because his German filing date preceded Habicht's U.S. filing date. The validity of Habicht's patent was not at issue, but applying the same rule, Habicht would be entitled to a patent too. His Swiss filing preceded Hilmer's U.S. filing.

Eli Lilly Co. v. Brenner, 375 F.2d 599, 126 U.S. App. D.C. 171 (D.C. Cir. 1967), followed the *Hilmer* rule. The facts of *Lilly* resemble the hypothetical of R and U more closely

Sept. 24, 1959 Feather's British filing.

July 19, 1960 Rapala's reduction to practice in U.S.

Sept. 19 1960 Feather's U.S. filing.

July 27, 1961 Rapala's U.S. filing.

Rapala's reduction to practice allowed him to show priority over Feather's U.S. filing. 35 U.S.C. § 102(g). The Court of Appeals, following *Hilmer*, concluded that Rapala was entitled to a patent notwithstanding Feather's British filing date. The validity of Feather's patent was not at issue.

17. See *infra* notes 31 & 32 and accompanying text.

18. An application for a patent for an invention filed in this country by any person who has . . . previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States . . . shall have the same effect as the application would have if filed in this country on the date on which the application for the same invention was first filed in such foreign country. . . .

35 U.S.C. § 119.

This is a problem because, contrary to the basic policy of the patent laws,¹⁹ it is possible for two patents to be granted for the same invention. If R and U apply for U.S. patents for the same invention, in reality, only one application can be novel. The other application must be anticipated by the one that precedes it. Yet, under the rules described above, both applications are considered novel, and both will be granted.

Similarly, if R and U apply for U.S. patents, and their applications, together with other prior art, render each other's inventions obvious, only one application can be nonobvious. The other application must be rendered obvious by the one that preceded it. Yet the same rules apply. Both applications were first. Both applications are granted.

The U.S. law responds to the problem of issuing similar patents with the interference proceeding. If the two patent applications claim substantially identical subject matter and scope, then the Commissioner of Patents and Trademarks declares an interference,²⁰ a proceeding to determine the first inventor of the conflicting claims.²¹ However, the interference can be avoided by changing the claims and manipulating the procedural rules.²² In addition, the

19. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186, 197, 14 S. Ct. 310, 38 L. Ed 121 (1893). *Radio Corp. v. Radio Engineering Laboratories, Inc.*, 293 U.S. 1, 3, 55 S. Ct. 928, 79 L. Ed 163 (1934).

20. 35 U.S.C. § 135.

21. Interference practice is intended to protect the first inventor from the first one to file a patent application. It was originally thought that large corporations with their large budgets would usually be the quickest to file patent applications, depriving the first inventor of his intrinsic rights. The interference was the small inventor's remedy. Donald R. Dunner, *First-to-File: Should Our Interference System be Abolished*, 68 J. PAT. OFF. SOC'Y 561 (1986).

Unfortunately, interference practice is expensive, risky and often unsatisfying. Robert A. Armitage, *Reform of the Law on Interference: A New Role for an Ancient Institution in the Context of a First-to-File System*, 64 J. PAT. OFF. SOC'Y 663, 665-66 (1983). The average interference lasts over two years, Calvert & Sofocleous, *Interference Statistics for Fiscal Years 1983 to 1985*, 68 J. PAT. OFF. SOC'Y 385 (1986); Calvert & Sofocleous, *Three Years of Interference Statistics*, 64 J. PAT. OFF. SOC'Y 699 (1983); De Simone, Gambrell & Gareau, *Characteristics of Interference Practice*, 45 J. PAT. OFF. SOC'Y 503 (1963). One now famous case lasted 13 years and two months before it was finally resolved in *Standard Oil Co. v. Montedison S.p.A.*, 664 F.2d 345, 212 U.S.P.Q. 327, *cert. den.*, 215 U.S.P.Q. 95 (1982). For a fully contested interference, attorney fees alone cost hundreds of thousands of dollars. Armitage, *supra*, 64 J. PAT. OFF. SOC'Y at 667.

Recently, the American Intellectual Property Law Association surveyed a portion of its members. Attorneys have a vested interest in complicated, expensive, proceedings because they generate large fees, yet 79% of those surveyed agreed that "interferences do not serve the interests of small inventors, universities, and non profit research organization because of the cost, delay, and uncertainty associated with contesting priority." Only 38% felt that patents should be granted to the first to invent rather than the first to file despite any weaknesses in the present system. Am. Intell. Prop. L. Ass'n Bulletin Jan.-Feb. 1987 p. 27.

22. Between R and U, U is the likely winner. R cannot use any acts that occurred in

legal standard for interference is different from the standards for novelty and obviousness. So, even if the interference is resolved, the claimed inventions may still lack novelty or nonobviousness in light of each other. Either R or U may still receive a patent to which he is not entitled. Worse yet, it may be practically impossible to work either patent without infringing²³ the other. Neither R nor U have received the exclusivity that the patent laws are supposed to bestow.²⁴

The problem is caused by the conflict between the *Hilmer* rule, which gives priority to U, and the Paris Convention, which gives priority to R. This Comment will show that the *Hilmer* rule violates the Paris Convention and should be discarded. Without the *Hilmer* rule, R's application would be prior art as of its Ruritanian filing date. Unless U could show that he was the first inventor,²⁵ R, who applied first, should receive his patent free of U's claims. With the *Hilmer* rule, R either shares his patent with U,²⁶ or loses his

Ruritania to show priority except his Ruritanian filing, January 1. 35 U.S.C. § 104. On the other hand, for U to win, he must have evidence that he conceived the invention or reduced it to practice before R's Ruritanian filing date. 35 U.S.C. § 102(g). This may be impossible because U's evidence must be corroborated. *Rieser v. Williams*, 255 F.2d 419, 424 (C.C.P.A. 1958).

Given the uncertainty, delay and expense of the interference, U and R will probably try to limit the proceeding as much as possible by manipulating their pleadings and settling. Absent the interference, both are entitled to patents. So an inventor will vigorously pursue an interference only if he knows, when the interference is declared, that the additional protection that will be granted the winner is worth the risk, delay and expense. Such a situation is rare. Finally even when claims do interfere, the Commissioner will not normally declare an interference when the application filing dates are more than six months apart. Manual of Patent Examining Procedure § 2903.

The patent laws acknowledge that interfering patents are sometimes granted. The owner of an interfering patent has a civil cause of action against the owners of other interfering patents. 35 U.S.C. § 291. See e.g., *Bell Telephone Labs., Inc. v. Hughes Aircraft Co.*, 564 F.2d 654 (3d Cir. 1977).

23. Whoever makes, uses or sells a patented invention in the U.S. without authorization from the patent owner infringes the patent. 35 U.S.C. § 271.

24. This is more of a problem for licensees than for patent owners. Patent rights may be licensed or assigned. 35 U.S.C. § 261. Typically, a licensee will be authorized to sell or use the invention in exchange for a royalty paid periodically in proportion to the amount sold or amount of use. Licensees may be forced, on the threat of an infringement suit, to pay royalties to both R and U. A licensee can, in good faith, purchase rights to work a patent and invest his capital to do so, only to find that there is another patent covering the invention. Because of the licensee's investment, the second patent owner is in a superior bargaining position and can demand exorbitant royalties. American patents only protect against infringement within the United States, 35 U.S.C. § 271, so the injured licensees will all be American operations. Regardless of benefits to American inventors, allowing two patents for the same invention hurts American licensees. See e.g., *Xerox Corp. v. Nashua Corp.* 314 F. Supp. 1187 (S.D.N.Y. 1970).

25. During examination, this can be done with an affidavit "swearing back" of the file date. It can also be done during an interference. See *supra* note 21 & 22 and accompanying text.

26. See *supra* notes 15-18 and accompanying text.

rights entirely.²⁷

This Comment uses two different methods of treaty interpretation to show Article 4's true meaning. The meanings arrived at will then be applied to the *Hilmer* rule. First, the Convention's plain and ordinary meaning will be applied and second, the practice of the parties in applying the Convention will be compared. Finally, several methods of correcting the U.S. law are mentioned.

INTERPRETATION OF ARTICLE 4

The Paris Convention for the Protection of Industrial Property grew out of a movement in the late 1800's to unify patent laws.²⁸ The movement culminated in 1880 at a conference of eighteen nations.²⁹ While the conferees failed to draft a uniform patent law, they did create an important treaty. The Paris Convention guarantees specific rights to industrial property owners both nationally and between nations.³⁰ One of these is the right of priority of Article 4, which reads in pertinent part:

Any one who shall have regularly deposited an application for a patent of invention . . . in one of the contracting States, shall enjoy for the purpose of making the deposit in the other States, a right of priority [for six months after the original deposit]³¹

In consequence, the deposit subsequently made in one of the other States of the Union³² before the expiration of this period [of six months] cannot be invalidated by acts performed in the interval, especially by another deposit [of a patent application]

This Comment proves an interpretation of this clause and applies it to the *Hilmer* rule. In doing this two rules of interpretation are used, both of which were accepted before 1883, the year that the Paris Convention was presented. This ensures that the interpretation proven here could have been anticipated even by the original draftsmen more than 100 years ago.

27. See *supra* note 22.

28. S. P. LADAS, PATENTS, TRADEMARKS AND RELATED RIGHTS: NATIONAL AND INTERNATIONAL PROTECTION 59-63 (1975).

29. Austria-Hungary, Argentina, Belgium, Brazil, France, Great Britain and Northern Ireland, Guatemala, Italy, the Netherlands, Portugal, Russia, Sweden and Norway, Salvador, Switzerland, Turkey, the United States, Uruguay, and Venezuela.

30. LADAS, *supra* note 28, at 63-67.

31. The interval was seven months for countries separated by the oceans. In 1911, the interval was changed to twelve months. Paris Convention, June 2, 1911, 1 Bev. 791, T.S. 579, 38 Stat. 1645.

32. The Paris Convention establishes a Union composed of the signatory States. Paris Convention, *supra* note 6 at art. 1.

A. Plain Meaning

The primary rule of treaty interpretation is to adopt the treaty's plain and ordinary meaning. The Vienna Convention on the Law of Treaties [hereinafter Vienna convention],³³ provides: "A treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in light of its object and purpose."³⁴

The plain meaning rule was not invented for the Vienna Convention. In 1758, Emer de Vattel in his treatise, *The Law of Nations or The Principles of Natural Law*, wrote:

The first general rule of interpretation is that it is not permissible to interpret what has no need of interpretation. When a deed is worded in clear and precise terms, when its meaning is evident and leads to no absurdity, there is no ground for refusing to accept the meaning which the deed naturally presents (emphasis in text).³⁵

The works of William Edward Hall (when the language of a treaty, taken in the ordinary meaning of the words, yields a plain and reasonable sense, it must be taken as intended to be read in that sense),³⁶ and Samuel B. Crandall (the words of a treaty are to be taken as used with their plain and natural meaning)³⁷ echo this view. The rule is also supported by intuition. If anything, a treaty should mean what it says.

Recall the two inventors R and U.³⁸ R regularly deposited a patent application. According to the Paris Convention, he is to enjoy a right of priority during the interval between his Ruritanian and U.S. patent application deposits. His priority interval lasts six months.³⁹ U then deposited an application during R's priority interval. The Paris Convention says that R's application "shall not be invalidated" because of U's deposit. What actually happens under the *Hilmer* rule is that R loses his exclusive rights. In fact, if there

33. 63 A.J.I.L. 875 (1969) May 22, 1969. While the U.S. is not a party to the Vienna Convention, over 35 other nations are. The Convention is cited here as much for its simple, logical structure as for its authority.

34. Vienna Convention, *supra* note 33, at art. 31(1).

35. E. DE VATTEL, II THE LAW OF NATIONS, ch. 17, § 263 (C.G. Fenwick trans. 1758 ed.).

36. W.E. Hall, II A Treatise on International Law, ch. 10, § 111(1) (4th ed. 1895).

37. S. B. CRANDALL, TREATIES, THEIR MAKING AND ENFORCEMENT § 171 (2d ed. 1916).

38. See *supra* notes 13 & 14 and accompanying text.

39. The interval was later extended. See *supra* note 31.

is an interference R may lose all his rights.⁴⁰

Does this mean that R's application invalidates U's application? Strictly speaking, it does not. R is still entitled to a patent. However, R's application for exclusive control over his invention, the most important of all patent rights, has been invalidated.

These answers suggest two possible "plain and natural" meanings for Article 4. The *Hilmer* rule takes the plain and natural meaning of Article 4 to be that applications shall not be invalidated by acts performed in the interval, but anything less than completely invalidating the application is permissible. On the other hand, if R could use his foreign filing date for prior art purposes, the plain and natural meaning of Article 4 would be that applications shall not be invalidated nor substantially deprived of their effect by acts that occur in the interval.

The second "plain and natural meaning" is clearly the most plain and natural. Unfortunately, the Paris Convention does not absolutely mandate this interpretation. It does not define invalidation, priority or even patent.

B. *Subsequent Practice*

A secondary rule of treaty interpretation is to apply the subsequent practice of the parties who signed the treaty. In the words of the Vienna Convention on the Law of Treaties: "There shall be taken into account, together with the context . . . any subsequent practice in the application of the treaty which established the agreement of the parties regarding its interpretation."⁴¹

This rule dates back to the turn of the century as well. Crandall writes that "a practical and common construction of the terms of a treaty by the parties . . . shortly after its conclusion is quite conclusive as to their meaning."⁴²

In this case the parties applied and construed the Paris Convention by changing their patent laws. By 1900, shortly after the Convention was completed, twelve jurisdictions had changed their patent laws to conform to the Paris Convention.⁴³

40. See *supra* text accompanying notes 26 and 27.

41. Vienna Convention, *supra* note 33, at art. 31(3)(b).

42. Crandall, *supra* note 37, at § 167.

43. The following jurisdictions signed the Convention before 1900: Great Britain, New Zealand, Queensland, New South Wales, Tasmania, Western Australia, Brazil, Denmark, Norway, Portugal, Sweden, Switzerland, Malta, Belgium, Dominican Republic, France, Italy, Netherlands, Spain, Tunisia, and the United States. Only the first 12 enacted enabling legislation by 1900. A. I. GREELEY, FOREIGN PATENT AND TRADEMARK LAWS § 68

This Comment analyzes the laws adopted by every one of these twelve jurisdictions plus France which applied the Convention without enabling legislation. The patent laws are analyzed to determine whether any of the countries construed the Paris Convention as allowing a rule of law like the *Hilmer* rule.⁴⁴ The countries which changed their patent laws in 1900 or later, the year of the first revision of the Paris Convention, are disregarded in order to separate out other variables. Starting in 1900, many things may have altered a nation's otherwise nonpolitical construction of the Paris Convention, for example, political maneuvers at the 1900 conference to modify the Paris Convention, retaliations against other Paris Union members, later treaties, and two world wars. Finally, to show the modern trend, the rules of the European Patent Convention and the Patent Cooperation Treaty,⁴⁵ which have been adopted by many of the original Paris Convention countries,⁴⁶ are discussed.

The hypothetical situation of R and U, used in applying the U.S. law,⁴⁷ is used throughout to apply the law of each country. For each country, it is assumed that U is a national of the jurisdiction under discussion and that R and U both seek patents there. For simplicity, it is assumed that R and U seek patents for the same invention.⁴⁸ Ruritania represents any jurisdiction that has signed

(1899). The U.S. enacted enabling legislation in 1903. 32 Stat. 1225.

44. This comment is limited to explicit legislative acts because it is difficult or impossible to determine what interpretation a government has given the Paris Convention when it has not taken any explicit action. Such a government has most likely not considered the Paris Convention at all. France is an exception because the courts decided and reported cases which are directly on point. See *infra* note 84 and accompanying text.

45. European Patent Convention, October 7, 1977, reprinted in 2K John P. Sinnott, *World Patent Law and Practice* (Matthew Bender 1987). Patent Cooperation Treaty, June 19, 1970, 28 U.S.T. 7645, T.I.A.S. no. 8733.

46. Of the countries listed *supra* note 43, Australia, New Zealand, Brazil, Denmark, Norway, Portugal, Malta, Dominican Republic, Spain, Tunisia, and the U.S. have not joined the EPC. On the same list, all but New Zealand, Portugal, Malta, Dominican Republic, Italy, Spain and Tunisia have acceded to the PCT. The U.S. ratified the PCT but retains a reservation under the treaty's Article 64(4).

47. See *supra* notes 13 & 14 and accompanying text.

48. The issue is what qualifies as prior art. Because the U.S. law uses the same prior art rules for novelty as it does for obviousness, it does not matter which issue is chosen for the hypothetical of R and U. Novelty is chosen because each of the 13 countries used prior art to determine novelty. Obviousness goes to whether the claimed invention is inventive or not. At the turn of the century, there was no international consensus on the standard for inventiveness. Even in the U.S., there was confusion. Comparing the prior art rules used for novelty gives a definite and certain result in each country simply from reading the statute. The comment also ignores whether a country used the "prior claims" or "whole contents" approach to examination. While the difference is vital to the effect of a prior art reference, it is immaterial to the issue here, whether the reference qualifies as prior art in the first place. Finally the comment ignores the possibility of interfering claims. It is assumed that patents

and abides by the Paris Convention other than the one discussed.

Under U.S. law, both R and U obtained patents even though R applied first. If U cannot be entitled to a patent under the law of the other thirteen countries to be discussed, then R's Article 4 priority has defeated U's application. In such a country, the *Hilmer* rule would not be possible.

1. *Brazil*—Brazil was the first to amend its patent legislation to accord with the Paris Convention. Brazil's Law of October 14, 1882 grants patents to inventions that have absolute novelty.⁴⁹ The patent guarantees exclusive use of the invention to the patentee.⁵⁰ Article II, section 1 enacts the Paris Convention. It provides, in pertinent part:

The priority of right of property of an inventor who, having solicited a patent in a foreign country, shall make a similar petition to the imperial government within seven months, will not be invalidated by facts which may occur during this period—such as another similar petition, the publication of the invention and its use or employment.⁵¹

This is the same wording as the Paris Convention's Article 4 made into a statute, with one exception. Rather than insulating the application from acts that occur in the interval, the Brazilians insulated the priority right from acts that occur in the interval. Once priority is established, it cannot be taken away by a later applicant. Article V, section 2 states that, "The patent shall be null . . . If the patentee did not have priority." Priority, therefore, determines patentability.

Applying Brazil's law to the case of R and U, where U is Brazilian, shows that the *Hilmer* rule is not possible. When R files his application of January 1, he obtains priority under Article II, section 1. U can do nothing to displace this priority. But, even if U does somehow obtain a patent, Article V, section 1 nullifies U's patent.

with interfering claims are granted on occasion. See *supra* note 22. Rather than adjusting the hypothetical for each jurisdiction, it is simply assumed that the filing dates are as given and that a priority dispute exists in which novelty is the issue.

49. Absolute novelty means that the invention may not be known, used, or described in a publication anywhere in the world. Brazil Law of October 14, 1882, art. 1, § 1.

50. *Id.*, art. 1, preamble.

51. The translation is from B. V. ABBOT, *THE PATENT LAWS OF ALL NATIONS*, 51 (1886).

2. *United Kingdom of Great Britain*—Great Britain first enabled the Paris Convention August 25, 1883.⁵² This law awarded patents to the inventor with the earliest filing date. The Convention was enacted through section 103, in pertinent part:

[A]ny person who has applied for protection for any invention [in a foreign state which adheres to the Paris Convention] . . . shall be entitled to a patent for his invention . . . under this Act, in priority to other applicants; and such patent . . . shall have the same date as the date of the protection obtained in such foreign state.

Return to R and U. U is now a Briton filing under the British Act of 1883. U has very little chance of gaining a patent. R, upon filing in Britain in March would claim priority from the January date of his Ruritanian filing. If the patent office did not deal with the conflict, he could instigate an opposition to U's patent under Section 11. It reads, in pertinent part:

Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the patent office of opposition to the grant of the patent . . . on the ground that the invention has been patented in this country on an application of prior date. . . .

While both R and U may pass examination, only R, who has the prior date, by virtue of section 103, will be granted a patent.

English case law supports this result also, but the first reported cases on the issue did not appear until long after 1883. In both *In re Scherico*⁵³ and *In re Mono Containers Ltd.*,⁵⁴ patent claims were defeated by patent applications with earlier foreign filing dates. In both cases, the English Patent Appeals Tribunal, construing the Patents Act of 1949 denied patents to English applicants who filed during the foreign inventors' priority intervals.

3. *Sweden*—Sweden was next to enable the convention by changing its patent laws. The Swedish law of May 16, 1884⁵⁵ is remarkably clear and simple. Section 25 guarantees the right of priority. In pertinent part:

[P]ersons, who within seven months from the date the [patent] application was filed in the foreign state, apply for a patent for

52. 57 Vict. no. 57.

53. 1968 R.P.C. 407 (U.K. Pat. App. Trib. 1968).

54. 1970 R.P.C. 217 (U.K. Pat. App. Trib. 1970).

55. Abbot, *supra* note 51, at 536.

the same invention in this country, shall with regard to earlier applications for patents, be considered as if the application was filed in this country at the same date as the application was filed in the foreign state.

Section 9 of the Law explains the importance of the filing date:

When several persons desire to obtain a patent for the same or a similar invention, the right of preference will be granted to the inventor whose documents . . . were earliest lodged with the patent authorities.

Returning to R and U, where U is now Swedish, R's application will be treated as if it were lodged with the patent authorities on January 1. This is earlier than any date that U can claim, so R is granted the patent over U.

4. *Queensland*—Queensland enabled the Paris Convention October 13, 1884.⁵⁶ Under the Act, the application filing date determines priority:

Every patent shall take effect and be expressed to take effect as of the day of the application. . . . Provided . . . that in case of more than one application for the same invention, the sealing of a patent⁵⁷ on one of those applications shall not prevent the sealing of a patent on an earlier application.⁵⁸

In a priority dispute, only the earlier application is granted:

Any person may . . . give notice . . . of opposition to the grant of a patent . . . on the ground that the invention has been patented in this colony on an application of prior date, or on the ground . . . that the specification appears . . . to comprise the same invention as is comprised in a specification bearing the same or a similar title and accompanying a previous application. . . .⁵⁹

Section 80 enables the Paris Convention. In pertinent part:

[A]ny person who has applied for protection for any invention . . . in a foreign State . . . shall be entitled to a patent for his invention . . . under this Act in priority to other applicants, and such patent . . . shall take effect from the same date as the date of the protection obtained in . . . such foreign State . . .

Were U now of the colony of Queensland, then R, by virtue of

56. *Id.* at 447.

57. The sealing of the patent indicates that the patent is granted. The Patents, Designs, and Trade Marks Act, 1884, *supra* note 56 at § 19.

58. *Id.* at § 16.

59. *Id.* at § 14(1).

Section 80, would have priority over applicants filing after his Ruritanian filing date of January 1. R's Queensland patent would take effect as of the same date. R could then oppose U's patent, under Section 14(1), by showing that he had a patent before U made his application, one month later, on February 1. The *Hilmer* rule was not possible under the law of Queensland.

5. *Norway*—Norway responded to the Paris Convention on June 16, 1885.⁶⁰ In most cases, the Norwegian law grants the patent to the first to file:

The right to obtain a patent is available . . . to the first inventor only. . . . In cases where it cannot be clearly ascertained who, among several applicants for a patent for a given invention, is the first inventor, the patent will be granted to the first one that handed in an application.⁶¹

Section 33 enacts the Paris Convention:

If any one who shall have in a foreign country applied for a patent for an invention within a period of seven months after such foreign application hands in an application for patent in this country for the same invention, this last application shall . . . be considered in relation to other applications as if it had been handed in at the same time that the application was made in the foreign state.

Were U now in Norway under the law of 1885, his application would be rejected. R's application would be treated as if it were "handed in" first, and the matter would be settled. If U were the first inventor, he could still prevail, but that goes beyond the scope of the *Hilmer* rule. *In re Hilmer* only concerned application dates, not invention dates.

6. *New Zealand*—The New Zealand Act of 1889⁶² grants patents to the first to file. If the patent office notices a conflict, it will grant a patent only to the first to file.⁶³ If an application has already been published, then the one seeking a conflicting patent must file an opposition.⁶⁴

Section 106 enacts the Paris Convention. It is virtually identical

60. Abbot, *supra* note 51, at 427.

61. Law of June 16, 1885, *supra* note 60, at § 3.

62. 53 Vict. no 12.

63. *Id.* § 10.

64. *Id.* § 15.

to section 80 of the Queensland Act of 1884.⁶⁵ As with the Queensland Act, the law grants priority and effect as of the foreign filing date. As in the case of Queensland, R could prevail over his New Zealand opponent U, because R's New Zealand patent takes effect retroactively, as of his Ruritanian filing date.

7. *Tasmania*—The Tasmanian Act of September 29, 1893⁶⁶ follows the Queensland and New Zealand Acts very closely. Section 13 limits patents to the first filed application. Oppositions are allowed by Section 19, and the Paris Convention is provided for by Section 106. The Tasmanian Act of 1893 prevents the *Hilmer* rule the same way that the Queensland and New Zealand Acts do.

8. *Denmark*—The Danish patent law of March 28, 1894,⁶⁷ operates very much like the Swedish law for purposes of this discussion. Section 3 guarantees patents to the first to file: "If several persons apply for a patent for the same or substantially the same invention, the person who has applied first shall have the preferential right to obtain the patent."

Section 28 provides for the Paris Convention:

[A]ny person who has lodged an application for a patent for an invention in [a] foreign State, if he lodged an application for a patent for the same invention in this country . . . the application so lodged in this country shall, relatively to other applications, be considered as made at the same time as the application in the foreign State.

If U were now Danish, he could not challenge R's Danish patent application. As in Sweden, R's Danish application is given the Ruritanian filing date. R is, therefore, considered to have filed first and, by virtue of section 3, R prevails.

9. *Western Australia*—Western Australia enacted the Paris Convention October 10, 1894.⁶⁸ The Act differs from those of Queensland, New Zealand, and Tasmania in only one way. Rather than providing that the foreign applicant's patent shall "take effect"⁶⁹ on the foreign priority date, the Western Australian Act provides that the foreign applicant's patent "shall have the same

65. See *supra* note 59 and accompanying text.

66. 57 Vict. no. 6.

67. 1 *Patent Laws of the World*, 630 (1911) (Chartered Institute of Patent Agents).

68. 58 Vict. no. 4.

69. See *supra* notes 56-58 and accompanying text.

date” as its foreign counterpart.⁷⁰ As Western Australia’s Law grants patents to the first to file,⁷¹ this can serve only to strengthen the argument that R’s application prevails over U’s.

10. *Portugal*—Portugal’s law of December 15, 1894⁷² provides the patent to the first to file. Article 28 provides, in pertinent part:

The right to the grant of the privilege of invention belongs to the first to present the application accompanied by the corresponding documents to the Department of Industry. A person, however, who has regularly made an application for a privilege of invention in one of the countries allied with Portugal by a special convention on this subject shall enjoy the right of priority for a patent in Portugal. . . .

Article 29 continues with, in pertinent part:

Whoever has obtained a patent of invention in a foreign county allied to Portugal by a convention on this subject may, if he makes a declaration to that effect, obtain an antedate for the patent, which shall be granted to him as of the date of the patent in the country of origin.

I return to R and U, where U is now Portuguese, to show that Portugal’s law of 1894 did not allow a rule like the *Hilmer* rule. In a dispute between R and U, the sole issue would be who shall be considered the first to have presented his documents to the Department of Industry. Initially, U, by his application of February 1, would be the first. However, R, upon making a declaration in his March 1 application, would obtain an antedate to January 1, his foreign filing date. R would then be considered the first to file and accordingly prevail.

11. *New South Wales*—The British Crown colony of New South Wales responded to the Paris Convention with an Act on December 10, 1897.⁷³ It is, for the purposes of this comment, indistinguishable from Western Australia’s Act of November 26, 1888. The same results apply.

12. *Switzerland*—Switzerland’s first response to the Paris Convention became effective November 15, 1888.⁷⁴ The law authorized

70. 58 Vict. no 4, § 1.

71. 52 Vict. no. 5, § 10(5).

72. PATENT LAWS OF THE WORLD, *supra* note 67, vol. 2, at 315.

73. 61 Vict. no. 35.

74. 10 A.S. 764 (Switz. 1889).

patents for new and useful inventions,⁷⁵ “new” meaning that the invention was neither known nor previously in use in Switzerland.⁷⁶ If it were found that a patent had issued for an invention which was not new, then the patent lapsed.⁷⁷

Article 32 of the law covered the Convention priority right. It allowed seven months between the foreign filing and the Swiss filing during which no new developments, whether another patent application or a publication could injure the validity of the patent.

Article 32 addresses the *Hilmer* issue directly. Under the *Hilmer* rule, a patent application filed in the U.S. during the priority interval can preempt a foreign filer’s priority right. Article 32 expressly prohibits patent applications filed during the priority interval from affecting the foreign filer’s priority right. Switzerland, in 1888, expressly rejected the *Hilmer* rule.

13. *Japan*—Japan’s first enabling legislation for the Paris Convention came into effect July 1, 1899.⁷⁸ This law granted the patent to the first inventor.⁷⁹ In addition, when an application was first filed in a Paris Convention country, the later Japanese application had “the same validity as if it had been made on the date of the first application.”⁸⁰

Unfortunately, the wording of the Act was not crystal clear. Japan went through many short lived patent acts around the turn of the century and the uncertainties were never clearly resolved.⁸¹ However, by at least 1974, Japan had resolved to give prior art status to Japanese patent applications as of their foreign filing dates and the *Hilmer* rule had been rejected in Japan.⁸²

14. *France*—Under the French constitution, treaties have the effect of law. No legislative action is required and none was made before 1900.⁸³ Scholars debated the meaning of Article 4 of the Paris Convention but courts consistently preserved the rights of the

75. *Id.*, Art. 1.

76. *Id.*, Arts. 2 & 4.

77. *Id.*, Art. 10(1).

78. The translation is from a pamphlet by W.A. DeHavilland, *Law and Rules Relating to Copyright, Patents, and Trademarks*, at p. 9 (1908).

79. *Id.* Art. 1.

80. *Id.*, Art. 14.

81. Gadsby, *The Progress of the Japanese Patent Law*, 27 L.Q. REV. 60 (1911).

82. Reinhard Wiczorek, *Convention Applications as Patent Defeating Prior Art*, 6 IIC 135, 161-62 (1975).

83. Greeley, *supra* note 43.

foreign filer.⁸⁴ Originally, in a case between R and U, U being French, the courts would have held U's patent invalid. It was defeated by R's Ruritanian filing. By 1914, courts were beginning to consider U's application simply dormant. In other words, U's patent was ineffective so long as R's patent was valid, but if R's patent lapsed, for whatever reason, U's patent immediately awoke to finish its own term. Under either theory, R is protected from U. The *Hilmer* rule is rejected.

C. *The Common Construction as of 1899*

Subsections 1-14 of the comment demonstrate that the *Hilmer* rule violates Article 4 of the Paris Convention. Eight countries and five British colonies responded to the 1883 draft of the Paris Convention with enabling legislation. Every one of those jurisdictions rejected the *Hilmer* rule result. Even France, with no enabling legislation, rejected the rule.

D. *Recent Developments*

Since 1900, the European Patent Convention [hereinafter EPC] and the Patent Cooperation Treaty (PCT)⁸⁵ have been adopted. Both treaties establish a patent examining procedure with rules for prior art.⁸⁶ These treaties do not enable the Paris Convention, they go several steps beyond.⁸⁷ They begin a uniform world patent law much like the eighteen nation conference of 1883 unsuccessfully tried to do more than 100 years ago.⁸⁸

Both the European Patent Convention and the Patent Cooperation Treaty, are first to file systems. The invention for which a patent application is filed may not have been disclosed in any publication or in a patent application with an earlier filing date.⁸⁹ Any foreign filing with a Paris Convention country establishes a filing date indistinguishable from the filing date with the EPC or PCT authorities.⁹⁰ Because the one filing date applies for all purposes, there can be no *Hilmer* rule with either treaty.

As the industrialized world modifies its patent laws to coincide

84. Wiczorek, *supra* note 82, at 157-59.

85. *See supra* note 45.

86. EPC Art. 54. Pct. Art. 33(2) and Regulations rule 33.1.

87. Note, *International Patent Cooperation: The Next Step*, 16 CORNELL INT'L L. J.229 (1983).

88. *See supra* note 28.

89. *See supra* note 86.

90. EPC *supra* note 45 Art. 88 & 89. PCT *supra* note 45 Art. 8.

with the rules of the EPC and PCT,⁹¹ it continues to reject the *Hilmer* rule. The construction of the other parties to the Paris Convention, shortly after the Convention was drafted, and today has been, and is now that the *Hilmer* rule violates that convention.

CONCLUSION

Two methods of interpretation have been applied to the Paris Convention's Article 4. First, the plain meaning of the Convention was examined. Second, the subsequent practice of the original parties in adopting the Convention was examined. Both methods yield the same result. The *Hilmer* rule, in addition to harming the U.S.' own licensees⁹² and embarrassing U.S. efforts to eliminate discriminations in foreign patent laws, violates Article 4 of the Paris Convention.

Fortunately, the problem can be solved. Both the courts and the legislature can eliminate the rule. The courts need simply to extend 35 U.S.C. section 119 following the District Court opinion in *Eli Lilly Co. v. Brenner*.⁹³ However, this is unlikely. The decision in *Hilmer*⁹⁴ was based on a long standing PTO practice and an extensive analysis of the legislative history.⁹⁵ The Court had before it some seven essays published in the Journal of the Patent Office Society discussing the merits of the domestic law on the point.⁹⁶ The opinion was rendered by the Court of Customs and Patent appeals which had some expertise in patent matters and the opinion itself was written by Judge Giles Sutherland Rich, an expert in the field and a participant in the drafting the 1952 Patent Act.⁹⁷ Finally the decision has been followed by a few other courts including the Court of Appeals for the District of Columbia Circuit.⁹⁸

91. See e.g., Schonherr, *Recent Changes in Patent and Trademark Law of Austria*, 9 IIC 85 (Int'l Rev. Ind. Prop. & Copyr. L. 1978); Armitage, *New British Patent Legislation*, 9 IIC 207 (1978); Osterborg, *Recent Changes in the Danish Patent Law*, 10 IIC 314 (1979); Vianes, *New French Patent Law*, 11 IIC 131 (1980); Kriegel, *New German Patent Law*, 13 IIC 1 (1982); Tornroth, *Swedish Patent Legislation in Recent Years*, 17 IIC 161 (1986).

92. See *supra* note 24.

93. 248 F. Supp. 402 (D.D.C. 1965).

94. See *supra* note 4.

95. 359 F.2d at 883.

96. 359 F.2d at 865-67.

97. Giles S. Rich, *Thirty Years of this Judging Business*, 14 Am. Intel. Prop. L. Ass'n Q.J. 140 (1986).

98. *Eli Lilly Co. v. Brenner*, 375 F.2d 599, 126 U.S. App. D.C. 171 (D.C. Cir. 1967); *Tyler Refrigeration Corp. v. Kysor Indus. Corp.*, 601 F. Supp. 590, 599, 225 U.S.P.Q. 492 (D. Del. 1985); *Studiengesellschaft Kohle mbH v. Dart Indus. Inc.*, 549 F. Supp. 716 (D. Del. 1982).

Nevertheless, it could be argued that the Paris Convention, which was given short shrift by the *Hilmer* Court,⁹⁹ demands a different result.¹⁰⁰ The *Hilmer* rule relies on Congress' probable intent in adopting 35 U.S.C. sections 102(e) and 119. If Congress intended to enact the Paris Convention and not to violate it, then *Hilmer* must be reconsidered. It should be assumed that Congress intends to comply with treaties unless there is conclusive evidence to the contrary. The *Hilmer* Court provided no such evidence. The Court did not see the violation.

The problem could also be solved by legislation. Over the past twenty years there have been many sweeping proposals to streamline the patent laws. Most of these proposals would abolish the *Hilmer* rule.¹⁰¹ Recent proposals have focused on harmonizing the patent laws of all nations, or at least as many as possible.¹⁰² These

99. 359 F.2d at 872-73.

100. It would be difficult to invoke Article 4 directly as if it had the status of a statute under U.S. Constitution art. VI cl. 2. This would require first, that the treaty be self-executing and second, that the treaty not be modified by a later act of Congress. *Whitney v. Robertson*, 124 U.S. 194, 8 S. Ct. 456, 31 L. Ed. 386 (1883).

It was assumed in 1913 that the Paris Convention is not self-executing. *Cameron Septic Tank Co. v. Knoxville*, 227 U.S. 39, 33 S. Ct. 209, 57 L. Ed. 407 (1913) (This case also summarizes previous decisions). There is little new evidence to show that the U.S. Supreme Court should be reversed on this point.

The Paris Convention was finalized in 1883. The U.S. ratified it in 1887. Congress enabled Article 4 as R.S. 4887 in 1903. The *Milburn* decision, see *supra* note 9, gave prior art status to applications as of their filing dates in 1926. The Patent Office construed this to exclude foreign applications by 1938. *Viviani v. Taylor v. Herzog*, 72 U.S.P.Q. 448 (1938). A new patent act which retained R.S. 4887 and adopted most of these decisional rules was passed in 1952. *Hilmer* was decided in 1966 and was followed by *Lilly* 375 F.2d 599, 126 U.S. App. D.C. III, March 29, 1967. The last revision to the Paris Convention was July 14, 1967 and was ratified by the U.S. Senate shortly thereafter. Congress amended 35 U.S.C. § 102(e) to put international applicants filing through the Patent Cooperation Treaty on the same status as Paris Convention applicants in 1975. None of this is conclusive unless one argues that Congress has considered the statutes and decisions and has not taken any definite action. The wording of the statutes dating all the way back to 1903 is not crystal clear on the question which arose in *Viviani* and in *Hilmer*.

101. For a general overview, see Mark T. Banner & John J. McDonnell, *First-to-File, Mandatory Re-examination, and Mandatory "Exceptional Circumstance": Ideas for Better? Or Worse?* 69 J. PAT. OFF. SOC'Y 595 (1987). In 1967, a presidential commission released its report. See e.g., Wm. R. Woodward, *Changes in the Patent System Recommended by the Presidential Commission*, 27 Fed. B.J. 189 (1967); Charles F. Voytech, *The Case for the First-to-File Patent System*, 54 A.B.A. J. 989 (Oct. 1968); George E. Frost, *The 1967 Patent Law Debate—First-to-Invent vs. First-to-File*, 1967 DUKE L.J. 923 (1967); *First-to-File System: Possibilities and Problems*, 12 IDEA 944 (1968); Roy B. Moffit, *Is First-to-File System Constitutional?*, 50 J. PAT. OFF. SOC'Y 754 (1968); Harry Goldsmith, *Why Not a First-to-File System?*, 49 J. PAT. OFF. SOC'Y 699 (1967).

There were a number of bills presented to Congressional committees in the 1970's. See Wiczorek, *supra* note 82 at 153-56.

Recent articles on the topic include Armitage, *supra* note 21, and Harold C. Wegner, *Patent Law Simplification and the Geneva Patent Convention*, 14 Am. Intell. Prop. L. Ass'n Q.J. 154, 158-59 (1986).

102. See e.g., Comment, *First to File vs. First to Invent, or Should We Also Change*

proposals are all very broad in scope with far reaching consequences. Their merits will be left for others to discuss. The problem could be solved immediately with a simple amendment to 35 U.S.C. § 102(e), the statute on which the *Hilmer* rule is based. The amendment would simply make it clear that a qualifying foreign filing determines the date that an application becomes prior art.¹⁰³

While other countries may violate the Paris Convention in other ways,¹⁰⁴ the United States is unique. The United States strives to be a model for other countries to follow. It is proud of its legal system and its prominence in science and technology. Surely, if the United States is to erect roadblocks against foreigners, they should not be erected to the detriment of its own licensees. No one wins from this brand of protectionism. The mantle of hypocrisy should be cast off immediately. Abolishing the *Hilmer* rule is a step in that direction.

*Gordon R. Lindeen III**

Mining Law, Water Law and Trademark Law? 69 J. PAT. OFF. SOC'Y 167 (1987); Comment, *A "Re-examination" of "First-to-Invent,"* 69 J. PAT. OFF. SOC'Y 289 (1987). On European efforts, see e.g., *Harmonization of Industrial Property and Copyright Law in the European Community*, 18 IIC 303 (Int'l Rev. Ind. Prop. & Copyr. L. 1987).

103. A possible amendment would be as follows:

Section 102

A person shall be entitled to a patent unless-

(e) The invention was described in a patent granted *in the United States* on an application for patent by another filed in the United States *or in a foreign country* before the invention thereof by the applicant for patent. [or on an international application by another who fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.]

The additions are underlined. Deletions are bracketed.

The additional phrase "in the United States" limits the prior art to applications which have successfully qualified under section 119 or section 371. Any other foreign filings cannot result in U.S. patents. The additional clause "or in a foreign country" grants the same status to international applications as it does to foreign applications. International applications must still be filed in some country. This change makes the deleted language unnecessary.

104. George R. Gansser, *Violations of the Paris Convention for the Protection of Industrial Property*, 11 IIC 1 (Int'l Rev. Indus. Prop. L. 1980), 63 J. PAT. OFF. SOC'Y 138 (1981). The U.S. also has roadblocks for U.S. inventors seeking patents abroad. Note, *Pitfalls of Foreign Patent Filing*, 7 LOY. U. CHI. L.J. 313, 58 J. PAT. OFF. SOC'Y 415 (1976).

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