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RESTORATION OF THE RIGHT OF PRIORITY;
CORRECTION AND ADDITION OF PRIORITY CLAIMS

Document prepared by the International Bureau

BACKGROUND

1. At its first and second sessions, the Working Group considered proposals for amendment of the Regulations under the PCT¹ relating, as recommended by the Committee, to changes necessary or desirable to bring the requirements under the PCT in line with the letter and spirit of the Patent Law Treaty (PLT) (see the report of the first session of the Committee, document PCT/R/26, paragraphs 72 to 74).
2. There was wide agreement at the first session of the Working Group on the general approach to be taken (see document PCT/R/WG/1/9, paragraph 21). Among the matters agreed was that (see paragraph 21(v)):

¹ References in this document to “Articles” and “Rules” are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case may be (the current texts are available on WIPO’s Website at http://www.wipo.int/pct/en/access/legal_text.htm). Reference to “national laws,” “national applications,” “the national phase,” etc., include reference to regional laws, regional applications, the regional phase, etc. Reference to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT (see document PT/DC/47 on WIPO’s Website at http://www.wipo.int/eng/document/pt_dc/index.htm).

“priority should be given by the Working Group to those matters which would result in the greatest and most immediate practical benefits for users, having regard also to the degree of complexity involved and to workload implications for Offices and Authorities; for example, priority might be given to the following:

– provisions for restoration of the priority right in certain circumstances;

....”

3. The proposals prepared by the International Bureau for consideration at the first session of the Working Group included provisions for restoration of the right of priority similar to those in the PLT (see document PCT/R/WG/1/5, Annex III). The Working Group’s discussions are outlined in document PCT/R/WG/1/9, paragraphs 22 and 23:

“22. Discussions were based on document PCT/R/WG/1/5, and in particular on proposed new Rule 26 *bis*.3, contained in Annex III to that document, which would provide for restoration of the priority right for up to two months beyond the usual 12-month priority period. The comments and concerns expressed by various delegations included the following:

(i) there was general agreement with the idea of providing for a means of restoration of priority rights, consistently with corresponding provisions of the PLT, during the international phase of the PCT procedure;

(ii) noting that the administration of those provisions in the national phase would be a matter for ROs [receiving Offices], the importance of a single standard, or at least consistent practice, among the various ROs was emphasized by several delegations;

(iii) delegations differed in their views as to the appropriate criterion which should apply in the context of the PCT (under Rule 26 *bis*.3(a)(iii)) in cases where the applicant failed to file the international application within the 12-month priority period, noting that the PLT provided for Contracting Parties to choose between two criteria:

- most delegations favored adopting the more liberal criterion of “unintentional” failure in the context of the PCT;
- certain delegations favored adopting the more restrictive criterion of “due care”;
- certain delegations favored giving ROs a choice as to which of the two criteria to apply, as would be the case for Contracting Parties to the PLT;

(iv) it was recognized by the Working Group that provision for restoration of the priority right in the international phase implied that the RO’s decision would need to have effect for the purposes of the national phase;

(v) most delegations believed that the RO’s decisions should be binding on DOs [designated Offices] (as under proposed Rule 26 *bis*.3(f)), but certain delegations believed that the RO’s decisions should be subject to review by DOs in at least some

circumstances, although there was no agreement as to what circumstances should be relevant in this context;

(vi) it was pointed out that, if the PCT were to require that one particular criterion be applied by all IROs, it would be possible for an Office to have one criterion in its capacity as a PCT RO and the other criterion in its capacity as a national Office processing national applications or as a DO processing international applications entering the national phase;

(vii) it was recognized that priority dates had two related but distinct effects:

- “procedural” in the sense that certain important time limits under the PCT were calculated by reference to the priority date;
- “substantive” in the sense that it was at the priority date that it would be determined whether the inventions satisfied the requirements of novelty and inventive step (non-obviousness);

(viii) the recognition in the national phase of an RO’s decision to restore the priority right was more particularly related to the procedural effect; the procedural effect was the dominant consideration in, for example, PCT Article 2(xi) and Rule 26bis.2(a);

(ix) the fact that a considerable number of countries’ national laws did not presently provide for restoration of priority rights, at least according to PLT criteria, suggested that transitional reservations would need to be allowed for if restoration provisions were to be introduced under the PCT.

“23. It was agreed that the International Bureau should prepare a revised proposal which would:

- (i) provide for restoration of the priority right by the RO based on the “unintentional” criterion, but identifying alternatives in the related comments or explanation;
- (ii) make it clear that it was the procedural effect of the priority right, rather than the substantive effect, that should be recognized for the purposes of the national phase.”

4. Revised proposals relating to the reinstatement of priority and to the correction and addition of priority claims were prepared by the International Bureau for consideration by the Working Group at its second session (see document PCT/R/WG/2/3). The Working Group’s discussions are outlined in document PCT/R/WG/2/12, paragraphs 54 to 56:

“54. Although the contents of document PCT/R/WG/2/3 could not, in the time available, be discussed in detail, there was general support for proposed new Rule 26bis.3 relating to restoration of priority claims. Revised proposals should take into account the following considerations:

- (i) the substantive validity of a priority claim in terms of the Paris Convention would remain a matter for national law;

(ii) national law could make provisions concerning the prior rights of third parties and the right of third parties to intervene;

(iii) the need for information concerning the fact that a priority claim had been restored to be communicated to designated Offices, for example, by the inclusion of indications on the front page of the published application (PCT pamphlet);

(iv) considerations should be given to reducing or eliminating the ability of a designated Office to review a decision of the receiving Office to restore or refuse to restore a priority claim (see Rule 26 bis.3(h)).

“55. [...] Proposed amended Rules 26 bis.1 and 26 bis.2 and new Rule 80.8, relating to the correction and addition of priority claims, should similarly also proceed.

“56. It was agreed that revised proposals should preferably be submitted to the second session of the Committee, although it was recognized that the time available may not permit the necessary revision of the proposals.”

5. Revised proposals relating to the reinstatement of priority and to the correction and addition of priority claims were prepared by the International Bureau for consideration by the Committee at its second session (see document PCT/R/2/5). The Committee's discussions are outlined in document PCT/R/2/9, paragraphs 111 to 125:

“111. Discussion was based on the proposals by the International Bureau set out in document PCT/R/2/5.

[...]

“Restoration of Priority Claims

“117. The Delegation of Canada, supported by the Delegations of Australia and the United States of America, stated that, while it supported in principle the concept of providing relief where the 12-month priority period was not complied with, it was concerned that the restoration of a priority claim as proposed in Rule 26 bis.3 could be considered to be a matter of substance. Noting that the PLT and the PCT operated in different contexts, the Delegation suggested that such relief might, instead, be provided by amendment of Rules 4.10 and 26 bis.1.

“118. The Delegation of Japan stated that, although it supported the proposed restoration of priority claims in principle, it was concerned that, in some cases, such restoration could leave insufficient time for the transmittal of the record copy and translation within 13 months as required by Rule 22.1. The Delegation of Kenya also referred to the need to avoid problems of meeting time limits that might arise where a priority claim was restored.

“119. The Delegation of Austria, supported by the Delegations of Spain, Germany, Ireland, France, Sweden, Portugal, Denmark, the Netherlands and Greece and the Representative of the EPO, suggested that the criterion for restoration under proposed new Rule 26 bis.3(a)(iii) should be changed from “unintentional” to “due care.” The Delegation of the United Kingdom emphasized a preference for retaining a single criterion; otherwise, there was a possibility that applicants who had admitted the 12-

month priority period might shop around for receiving Offices with the most liberal criterion. The suggested change was opposed by the Delegation of Australia, supported by the Delegations of the United States of America and Canada, on the ground that the “unintentional” criterion was broader and therefore more applicant -friendly.

“120. The Committee agreed that the words “or the International Bureau, as the case may be,” in proposed new Rule 26 *bis*.3(e) were unnecessary.

“121. The Delegation of the United Kingdom and the Representative of the EPO suggested, in connection with proposed Rule 26 *bis*.3(g), that express provisions should be made, where the receiving Office refused a request for restoration of priority claim, for a designate d Office to review that decision, noting that Articles 24 and 25 would not appear to be applicable in such a case. The Committee agreed that the revised proposal should contain such a provision. The Delegation of the United Kingdom also questioned whether the review by a designated Office should be based on its own criterion or that used by the receiving Office.

“122. In response to a comment by the Delegation of China, the International Bureau explained that the transitional reservations provided for in proposed Rule 26 *bis*.3(h) were intended to apply only to the provisions of Rule 26 *bis*.3 and not to Rules 26 *bis*.1 and 26 *bis*.2, since the latter provisions were already in force and were not subject to reservations. So as to clarify the matter, the Committee agreed that the words “this Rule” should be replaced by “paragraphs (a) to (g).”

“123. Having regard to the number of outstanding issues connected with the proposed provisions relating to restoration of priority claims, and noting that the proposal had not been extensively considered by the Working Group, the Committee felt that they were not yet ripe to proceed to the Assembly.

“Correction and Addition of Priority Claims”

“124. The proposed amendments of Rules 26 *bis*.1, 26 *bis*.2 and 80.8 set out in Annex II to document PCT/R/2/5 could not, in the time available, be discussed by the Committee.

“Further Consideration”

“125. The Committee agreed to recommend to the Assembly that the proposed amendments of Rules 4.10, 26 *bis*.3 and 48.2 set out in Annex II to document PCT/R/2/5 should be revised by the International Bureau, taking into account the comments and concerns expressed at the Committee’s session, and submitted to the Working Group, together with the proposed amendments of Rules 26 *bis*.1, 26 *bis*.2 and 80.8, for discussion at its next session.”

6. Article 13 and Rule 14 of the PLT are reproduced for ease of reference in Annex I. Revised proposals for amendment of the PCT Regulation to provide for the restoration of right of priority (see Rule 48 as proposed to be amended and proposed new Rule 26 *bis*.3) and proposals relating to the possibility for the applicant to correct or add priority claims (see Rules 26 *bis*.1 and 26 *bis*.2 as proposed to be amended and proposed new Rule 80.8) are contained in Annex II.

RESTORATION OF THE RIGHT OF PRIORITY

Procedural and substantive aspects of priority rights

7. Although PLT Article 13(2) refers to the restoration of the *right of priority*, it was previously proposed to provide, in the context of the PCT procedure, for the receiving Office to be able to restore the *priority claim* (see paragraph 8 and proposed Rule 26bis.3 in document PCT/R/2/5). Upon further review, it is not any longer proposed to deviate from the terminology used in the context of the PLT, noting that, as regards substantive aspects of right of priority, both PLT and PCT expressly refer to the Paris Convention (see PLT Article 15 and PCT Article 8(2)(a) and that any deviation from the PLT -language may lead to confusion and possible misinterpretations.

8. PCT Article 8(2)(a) expressly provides that “the conditions for, and the effect of,” any priority claim declared in an international application are matters for Article 4 of the Paris Convention. Thus, the substantive aspects of priority claims, in terms of the validity and substantive effects of the right of priority concerned, are left for designated Offices to determine in the national phase. On the other hand, a priority claim has a procedural significance in the international phase which in some senses carries over into the national phase. For example, a number of time limits under the PCT are computed by reference to the priority date, and the priority date is taken into account in the carrying out of the international search and international preliminary examination.

9. It therefore appears to be necessary to ensure that, while a designated Office would always be free to *determine the validity of a right of priority* for the purposes of the national phase in terms of compliance with the Paris Convention, it should be strictly limited in its freedom during the national phase to *review a decision by the receiving Office to restore a right of priority* where the international application which claims priority of an earlier application was not filed within the priority period. In other words, while each designated Office would be free to determine, in the national phase, that the international application cannot validly claim the priority of an earlier application, for example, because the earlier application is not a “first filing” for the subject concerned within the meaning of Article 4C(2) of the Paris Convention, that Office should not be able to do so only because the international application has an international filing date which is later than the date on which the priority period expired where the right of priority had been restored in a decision by the receiving Office during the international phase.

10. Accordingly, proposed Rule 26bis.3(j)(i) and (ii) would, in general, oblige designated Offices to give due effect to a decision by the receiving Office to restore the right of priority and would restrict the circumstances in which a designated Office could decide to review such a decision, namely, to cases where there is a “reasonable doubt” on the part of the designated Office. If national law gives third parties the right to intervene, it would be open to a third party to persuade the designated Office that such a reasonable doubt existed.

11. Where the receiving Office has refused a request for restoration of right of priority, proposed Rule 26bis.3(i) provides that each designated Office may review that decision by the receiving Office and restore the right of priority, as far as the effects in the State of that designated Office are concerned, if it finds that the refusal was the result of an error or omission on the part of the receiving Office. In accordance with Article 27(4), where the national law applied by the designated Office provides for requirements for the restoration of right of priority that are more favorable than those under proposed Rule 26bis.3(i), that

designated Office may apply those more favorable requirements, instead of those under proposed Rule 26bis.3(i), except where the applicant insists that the requirements under that proposed Rule be applied to the international application concerned.

Criterion for restoration of right of priority (“unintentionality” or “due care”)

12. PLT Article 13(2)(iv) leaves it at the option of each PLT Contracting State to decide whether the Office requires the failure to file the subsequent application within the priority period to have been “unintentional” or that it “occurred in spite of due care required by the circumstances having been taken”. At the first and second session of the Working Group and at the second session of the Committee, there was no agreement whether, in the context of the PCT, restoration of the right of priority should be based on the more liberal requirement that the failure was “unintentional” (as favored by most delegations), on the more strict criterion of “due care” (as favored by certain delegations), or whether receiving Offices should be given a choice as to which of the two criteria to apply, as would be the case for Contracting Parties to the PLT (as favored by certain other delegations).

13. Certain delegations pointed out that, if the PCT were to require that one particular criterion be applied by all receiving Offices, it would be possible for an Office to have to apply one criterion in its capacity as a PCT receiving Office processing international applications filed with it, and the other criterion in its capacity as a national Office processing national applications or as a designated Office processing international applications entering the national phase. On the other hand, the importance of providing a single standard, or at least of ensuring consistent practice, among receiving Offices was emphasized by several delegations.

14. Upon further review, it is now proposed to base the decision by the receiving Office on a request for restoration of the right of priority on either of the two criteria (“due care” or “unintentional”) and to leave the choice to the applicant, who could either submit a request for a decision by the receiving Office based on the “due care” criterion (together with the payment of a relatively low fee for the benefit of the receiving Office) or a request for a decision by the receiving Office based on the “unintentional” criterion (together with the payment of a relatively high fee for the benefit of the receiving Office).

15. While such an approach would not avoid the fact that the same Office may, in its different capacities (as a receiving Office, designated Office or national Office), apply different criteria when deciding on a request for restoration of the right of priority, it would ensure that all Offices would at least gain experience in applying both criteria. Furthermore, it would avoid a situation where an applicant could “shop” around for the receiving Office with the most liberal criterion. The Working Group may wish to consider whether it would be preferable, so as to ensure consistent practice among all receiving Offices, to provide guidance to receiving Offices on how to apply the criteria of “due care” and “unintentionality”, for example, by way of inclusion of corresponding provisions in the Administrative Instructions or the Receiving Office Guidelines, or whether this matter should be left to the national law and practice of each receiving Office.

Prior rights of third parties and the right of third parties to intervene

16. It does not seem necessary or appropriate to attempt to regulate under the PCT itself the rights of third parties affected by the restoration of a right of priority. Rather, any recognition of the rights of such third parties, including any prior user right and any right to request a

designated Office to review a decision of the receiving Office to restore a right of priority, should be left to the applicable national law in the designated States. In the event that it were thought desirable to make that position clear in the Regulations, consideration would also need to be given to the rights of third parties whom might be affected in other ways under the PCT procedure, for example, by the correction or addition of a priority claim under Rule 26*bis*.

Transitional reservation

17. A transitional reservation provision has been included as proposed Rule 26 *bis*.3(k), recognizing that time may be needed for the national law applicable by certain designated Offices to be brought into line with the provisions of proposed Rule 26 *bis*.3(a) to (j).

CORRECTION AND ADDITION OF PRIORITY CLAIMS ²

18. It is proposed to amend Rule 26 *bis*.1(a) and to add a new Rule 80.8(b) so as to extend the period available to the applicant for the correction or addition of a priority claim prior to international publication of the international application where the applicant mistakenly makes a priority claim which is more than 12 months preceding the international filing date (see document PCT/R/WG/1/4, paragraph 4, and document PCT/R/WG/1/9, paragraphs 32 and 33). Since, under proposed new Rule 80.8(b), a priority claim which does not comply with Rule 4.10(a)(i) (that is, a priority claim related to an earlier application which has a filing date not falling within the period of 12 months preceding the international filing date) would not be taken into account for the purposes of computing the 16-month time limit under Rule 26*bis*.1, the applicant would always have 16 months from the corrected priority date to submit a request for correction. The previous "four month from the international filing date" minimum time limit seems to be no longer needed and is thus proposed to be deleted.

19. *The Committee is invited to consider the proposals contained in Annex II.*

[Annexes follow]

² Note that the proposals relating to the possibility for the applicant to correct or add priority claims (see Annex II, Rules 26 *bis*.1 and 26 *bis*.2 as proposed to be amended and proposed new Rule 80.8) are as presented to the second session of the Committee and have not been further revised.

ANNEXI

ARTICLE 13 AND RULE 14 OF THE PATENT LAW TREATY (PLT)

Article 13

Correction or Addition of Priority Claim; Restoration of Priority Right

(1) [*Correction or Addition of Priority Claim*] Except where otherwise prescribed in the Regulations, a Contracting Party shall provide for the correction or addition of a priority claim with respect to an application (“the subsequent application”), if:

- (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;
- (ii) the request is filed within the time limit prescribed in the Regulations; and
- (iii) the filing date of the subsequent application is not later than the date of the expiration of the priority period calculated from the filing date of the earliest application whose priority is claimed.

(2) [*Delayed Filing of the Subsequent Application*] Taking into consideration Article 15, a Contracting Party shall provide that, where an application (“the subsequent application”) which claims or could have claimed the priority of an earlier application has a filing date which is later than the date on which the priority period expired, but within the time limit prescribed in the Regulations, the Office shall restore the right of priority, if:

- (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;
- (ii) the request is filed within the time limit prescribed in the Regulations;
- (iii) the request states the reasons for the failure to comply with the priority period; and
- (iv) the Office finds that the failure to file the subsequent application within the priority period occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, was unintentional.

(3) [*Failure to File a Copy of Earlier Application*] A Contracting Party shall provide that, where a copy of an earlier application required under Article 6(5) is not filed with the Office within the time limit prescribed in the Regulations pursuant to Article 6, the Office shall restore the right of priority, if:

- (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;
- (ii) the request is filed within the time limit for filing the copy of the earlier application prescribed in the Regulations pursuant to Article 6(5);

(iii) the Office finds that herequestforthe copy to be provided had been filed with the Office with which the earlier application was filed, within the time limit prescribed in the Regulations; and

(iv) a copy of the earlier application is filed within the time limit prescribed in the Regulations.

(4) [Fees] A Contracting Party may require that a fee be paid in respect of a request under paragraphs (1) to (3).

(5) [Evidence] A Contracting Party may require that a declaration or other evidence in support of the reasons referred to in paragraph (2)(iii) be filed with the Office within a time limit fixed by the Office.

(6) [Opportunity to Make Observations in Case of Intended Refusal] A request under paragraphs (1) to (3) may not be refused, totally or in part, without the requesting party being given the opportunity to make observations on the intended refusal within a reasonable time limit.

Rule 14

Details Concerning Correction or Addition of Priority Claim and Restoration of Priority Right Under Article 13

(1) [Exception Under Article 13(1)] No Contracting Party shall be obliged to provide for the correction or addition of a priority claim under Article 13(1), where the request referred to in Article 13(1)(i) is received after the applicant has made a request for early publication or for expedited or accelerated processing, unless that request for early publication or for expedited or accelerated processing is withdrawn before the technical preparations for publication of the application have been completed.

(2) [Requirements Under Article 13(1)(i)] A Contracting Party may require that a request referred to in Article 13(1)(i) be signed by the applicant.

(3) [Time Limit Under Article 13(1)(ii)] The time limit referred to in Article 13(1)(ii) shall be not less than the time limit applicable under the Patent Cooperation Treaty to an international application for the submission of a priority claim after the filing of an international application.

(4) [Time Limits Under Article 13(2)] (a) The time limit referred to in Article 13(2), introductory part, shall expire not less than two months from the date on which the priority period expired.

(b) The time limit referred to in Article 13(2)(ii) shall be the time limit applied under subparagraph (a), or the time that any technical preparations for publication of the subsequent application have been completed, whichever expires earlier.

(5) [Requirements Under Article 13(2)(i)] A Contracting Party may require that a request referred to in Article 13(2)(i):

(i) be signed by the applicant; and

(ii) be accompanied, where the application did not claim the priority of the earlier application, by the priority claim.

(6) [*Requirements Under Article 13(3)*] (a) A Contracting Party may require that a request referred to in Article 13(3)(i):

(i) be signed by the applicant; and

(ii) indicate the Office to which the request for a copy of the earlier application had been made and the date of that request.

(b) A Contracting Party may require that:

(i) a declaration or other evidence in support of the request referred to in Article 13(3) be filed with the Office within a time limit fixed by the Office;

(ii) the copy of the earlier application referred to in Article 13(3)(iv) be filed with the Office within a time limit which shall be not less than one month from the date on which the applicant is provided with that copy by the Office with which the earlier application was filed.

(7) [*Time Limit Under Article 13(3)(iii)*] The time limit referred to in Article 13(3)(iii) shall expire two months before the expiration of the time limit prescribed in Rule 4(1).

[Annex II follows]

ANNEXII

PROPOSED AMENDMENTS OF THE PCT REGULATIONS: ¹RESTORATION OF THE RIGHT OF PRIORITY;
CORRECTION AND ADDITION OF PRIORITY CLAIMS

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¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

Rule 4

The Request (Contents)

4.1 to 4.9 [No change]

4.10 *Priority Claim*

(a) Any declaration referred to in Article 8(1) (“priority claim”) may claim the priority of one or more earlier applications filed either in or for any country party to the Paris Convention for the Protection of Industrial Property or in or for any Member of the World Trade Organization that is not party to that Convention. Any priority claim shall, subject to Rule 26bis.1, be made in the request; it shall consist of a statement to the effect that the priority of an earlier application is claimed and shall indicate:

(i) the date on which the earlier application was filed, that date being subject to Rule 26bis.3, a date falling within the period of 12 months preceding the international filing date;

[COMMENT: It is proposed to amend item (i) of paragraph (a) so as to clarify that, where the applicant is submitting a request for restoration of the right of priority, the date on which the earlier application was filed as indicated in the request does not have to be a date falling within the period of 12 months preceding the international filing date.]

(ii) to (v) [No change]

(b) to (d) [No change]

4.11 to 4.18 [No change]

Rule 26 bis

Correction or Addition of Priority Claim ; Restoration of Right of Priority

26 bis.1 Correction or Addition of Priority Claim

(a) The applicant may correct or add a priority claim by a notice submitted to the receiving Office or the International Bureau within a time limit of 16 months from the priority date or, where the correction or addition would cause a change in the priority date, 16 months from the priority date as so changed, whichever 16-month period expires first ~~provided that such a notice may be submitted until the expiration of four months from the international filing date~~. The correction of a priority claim may include the addition of any indication referred to in Rule 4.10.

[EXAMPLE: An international application with an international filing date of 4 June 2002 claims the priority of an earlier application, (erroneously) indicating that the earlier application was filed on 5 February 2001; the correct priority date should have been 5 February 2002.

Presentsituation : According to present Rule 26 bis.1(a), the applicable time limit for submitting a correction would be four months from the international filing date, that is, 4 October 2002.

Situation under the Rules as proposed to be amended : According to Rule 26 bis.1(a) as proposed to be amended and proposed new Rule 80.8(b), the applicable time limit for submitting a correction would be 16 months from the corrected priority date, that is, 5 June 2003.]

(b) [No change]

[Rule 26bis.1, continued]

(c) ~~[Deleted] Where the correction or addition of a priority claim causes a change in the priority date, any time limit which is computed from the previously applicable priority date and which has not already expired shall be computed from the priority date as so changed.~~

[COMMENT: The content of current Rule 26 bis.1(c) is proposed to be moved to proposed new Rule 80.8(a) (see below) so as to deal with all matters relating to time limits computed from the priority date in one place.]

26bis.2 ~~Invitation to Correct~~ Defects in Priority Claims

[COMMENT: Consequential on the proposed deletion of the reference to “invitation” in paragraph (b).]

(a) Where the receiving Office or, if the receiving Office fails to do so, the International Bureau, finds that:

(i) a priority claim does not comply with the requirement of Rule 4.10(a)(i) and a request for restoration of the right of priority under Rule 26bis.3 has not been filed; or

(ii) a priority claim does not comply with the other requirements of Rule 4.10; or

[Rule 26bis.2(a), continued]

(iii) ~~that~~ any indication in a priority claim is not the same as the corresponding indication appearing in the priority document ~~;~~

the receiving Office or the International Bureau, as the case may be, shall invite the applicant to correct the priority claim.

[COMMENT: There appears to be no need for an invitation to correct a priority claim where a request for restoration of that right of priority has been filed by the applicant, showing that the applicant, while being aware of the fact that the filing date of the earlier application as indicated in the request does not fall within the 12 months preceding the international filing date, has no intention to correct that priority date but rather wishes to have the right of priority restored under Rule 26 bis.3, below.]

(b) If, ~~in response to an invitation under paragraph (a),~~ the applicant does not, before the expiration of the time limit under Rule 26bis.1(a), submit a notice correcting the priority claim so as to comply with the requirements so ~~for~~ Rule 4.10, or does not, where applicable, before the expiration of the time limit under Rule 26bis.3(b), submit a request for restoration of the right of priority, that priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made and the receiving Office or the International Bureau, as the case may be, shall so declare and shall inform the applicant accordingly, provided that a priority claim shall not be considered not to have been made only because the indication of the number of the earlier application referred to in Rule 4.10(a)(ii) is missing or because an indication in the priority claim is not the same as the corresponding indication appearing in the priority document.

[Rule 26bis.2(b), continued]

[COMMENT: Paragraph (b) is proposed to be amended so as to clarify that a priority claim cannot be considered not to have been made under this paragraph where the applicant has filed a request for restoration of right of priority. Rather, the decision by the receiving Office on whether or not to consider the priority claim not to have been made is governed by proposed new Rule 26bis.3, below (that is, the decision to restore the right of priority or to refuse the request for restoration). In this context, it is also proposed to delete the words, “, in response to an invitation under paragraph (a),” which appear to be superfluous; whether or not the notice of correction or the request for restoration is received as a result of an invitation would seem irrelevant.]

(c) [No change]

26bis.3 Restoration of Right of Priority

(a) The receiving Office shall, subject to paragraphs (b) to (f), restore the right of priority where the international application which claims or could have claimed the priority of an earlier application has an international filing date which is later than the date on which the priority period referred to in paragraph (f) expired but is within two months from that date if the receiving Office finds that the failure to comply with the priority period:

(i) in the case referred to in paragraph (b)(i), occurred in spite of due care required by the circumstances having been taken; or

(ii) in the case referred to in paragraph (b)(ii), was unintentional.

[Rule 26bis.3, continued]

(b) Restorations shall be made on the request of the applicants submitted to the receiving Office within a time limit of two months from the date on which the priority period referred to in paragraph (f) expired, stating the reasons for the failure to comply with that priority period and indicating whether that failure:

(i) occurred in spite of due care required by the circumstances having been taken;

or

(ii) was unintentional.

(c) The request referred to in paragraph (b) shall be subjected to the payment to the receiving Office, for its own benefit, of a fee:

(i) in the case referred to in paragraph (b)(i), equal to [XXX];

(ii) in the case referred to in paragraph (b)(ii), equal to [YYY].

(d) The receiving Office:

(i) may require that a declaration or other evidence in support of the statement of reasons referred to in paragraph (b) be filed within a time limit which shall be reasonable under the circumstances;

[Rule 26bis.3(d), continued]

(ii) shall not refuse, totally or in part, a request under paragraph (b) for restoration of the right of priority without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances.

(e) Where the international application did not claim the priority of the earlier application, the request referred to in paragraph (b) shall be accompanied by a notice adding the priority claims so as to comply with the requirements of Rule 4.10.

(f) The priority period referred to in paragraphs (a) and (b) shall be 12 months calculated from the priority date that would apply if the right of priority were restored.

(g) Where the receiving Office refuses a request for restoration of the right of priority under paragraph (b), the priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made and the receiving Office shall so declare and shall inform the applicant accordingly.

(h) Where the receiving Office has refused a request under paragraph (b) for restoration of the right of priority, or where such a request is pending at the time of the completion of the technical preparations for international publication, the International Bureau shall, upon request made by the applicant and received by the International Bureau prior to the completion of the technical preparations for international publication, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish, together with the international application, information concerning that request for

[Rule 26bis.3(h), continued]

restoration. A copy of the request under this paragraph shall be included in the
communication under Article 20 where a copy of the pamphlet is not used for that
communication or where the international application is not published by virtue of
Article 64(3).

(i) Where the receiving Office has refused a request under paragraph (b) for restoration
of the right of priority, each designated Office may, on the request of the applicant, review the
decision by the receiving Office and, if it finds that the refusal was the result of an error or
omission on the part of the receiving Office, shall, as far as effects in the State of the
designated Office are concerned, restore the right of priority, provided that a copy of the
international application (unless the communication provided for in Article 20 has already
taken place) and the appropriate translation (as prescribed) have been furnished and the
national fee (if any) has been paid within the time limit applicable under Article 22 or 39(1),
as the case may be, that would apply if the right of priority were restored. The designated
Office may require that a request for review shall be presented to it within the time limit
applicable under Article 22 or 39(1), as the case may be, and be subject to the payment of a
fee for its own benefit.

(j) Where the receiving Office has restored a right of priority under paragraph (a):

[Rule 26bis.3(j), continued]

(i) no designated Offices shall review the decision of the receiving Office unless it has reasonable doubts that a requirement under this Rule was not complied with, in which case it shall notify the applicant accordingly, indicating the reasons for those doubts and giving the applicant an opportunity to make observations within a reasonable time limit;

(ii) no designated States shall disregard the right of priority only because the international application has an international filing date which is later than the date on which the priority period referred to in paragraph (f) expired, unless a requirement under this Rule was not complied with.

(k) If, on [date of adoption of these modifications by the PCT Assembly], any provision of paragraphs (a) to (j) is not compatible with the national law applied by the designated Office, that provision shall not apply in respect of that Office for as long as it continues not to become compatible with that law, provided that the said Office informs the International Bureau accordingly by [three months from the date of adoption of these modifications by the PCT Assembly]. The information received shall be promptly published by the International Bureau in the Gazette.

Rule48

InternationalPublication

48.1 [Nochange]

48.2 *Contents*

(a) Thepamphletshallconta in:

(i) to(ix) [Nochange]

(x) anydeclarationreferredtoinRule4.17(v),andanycorrectionthereofunder Rule 26*ter.1*,whichwasreceivedbytheInternationalBureaubeforetheexpirationofthetime limitunderRule26 *ter.1*;

(xi) indicationsconcerninganyrightofprioritywhichhasbeenrestoredunder Rule 26*bis.3(a)*.

[COMMENT:Thisitemhasbeenincludedfollowingagreementatthesecondsessionofthe WorkingGroupasto“theneedforinformationconcerningthefactthatapriorityclaimhad beenrestoredtobecomunicatedtodesignatedOffices,forexample,bytheinclusionof indicationsonthefrontpageofthepublishedapplication(PCTpamphlet)”(seedocument PCT/R/WG/2/12,paragraph54(iv)).]

(b)to(i) [Nochange]

48.3to48.6 [Nochange]

Rule80

ComputationofTimeLimits

80.1to80.7 [Nochange]

80.8 TimelimitsComputedFromthePriorityDate

(a) Whereachangeintheprioritydateiscausedby:

(i) thecorrectionoradditionofapriorityclaimunderRule 26bis.1;or

(ii) therestorationofarightofpriorityunderRule26 bis.3;

anytimelimitwhichiscomputedfromthepreviouslyapplicableprioritydateandwhichhas
notalreadyexpiredshallbecomputedfromtheprioritydateassochanged.

[COMMENT:Seecomment onRule26 bis.1(c),above.Itisproposedtomovethecontentof
currentRule26 bis.1(c)toproposednewRule 80.8(a)soastodealwithallmattersrelatingto
timelimitscomputedfromtheprioritydate,includingarestoredpriorityclaim,inoneplac e.]

(b) Forthepurposesofcomputingtimelimits,ifapriorityclaimdoesnotcomplywith
Rule 4.10(a)(i)becausethedateonwhichtheearlierapplicationwasfiledwasnotadate
fallingwithinthe12 monthsprecedingtheinternationalfilingdate,t hatpriorityclaimshall
not,subjecttoparagraph (a)(ii),betakenintoaccountforthepurposesofdeterminingthe
prioritydate.

[Rule 80.8, continued]

[COMMENT: See the Comment on Rule 26 *bis*. 1(a), above. It appears necessary to make this provision “subject to paragraph (a)(ii)” so as to ensure that a priority claim which does not comply with Rule 4.10(a)(i) that, if the date on which the earlier application was filed is a date falling within the 12 months preceding the international filing date, it is taken into account where that right of priority is restored under proposed new Rule 26 *bis*. 3(a).]

[End of Annex II and of document]