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WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)

Fifth Session

Geneva, November 17 to 21, 2003

RESTORATION OF THE RIGHT OF PRIORITY

Document prepared by the International Bureau

1. This document is being made available provisionally, on WIPO's Internet site, in advance of the formal convening of the fifth session of the Working Group. It is provisional in the sense that the formal convening of the fifth session of the Working Group, as recommended by the Working Group at its fourth session held in May 2003, is subject to approval by the Assembly of the PCT Union. The Assembly is invited, at its 32nd (14th ordinary) session from September 22 to October 1, 2003, held in conjunction with the 39th series of meetings of the Assemblies of the Member States of WIPO, to approve the proposal concerning future work contained in document PCT/A/32/2, paragraph 26(i), "that two sessions of the Working Group should be convened between the September 2003 and September 2004 sessions of the Assembly to consider proposals for reform of the PCT including, in particular, the matters for further consideration identified [in document PCT/A/32/2] above, on the understanding that the Committee could also be convened during that period if the Working Group felt it to be necessary."
2. Subject to the Assembly's approval, the fifth session of the Working Group will be formally convened and this document will then cease to be provisional in nature.

BACKGROUND

3. The Committee on Reform of the PCT (“the Committee”), at its first and second sessions, and the Working Group, at its first, second, third and fourth sessions, considered proposals for amendment of the Regulations under the PCT¹ relating to the restoration of the right of priority. The reports of the sessions of the Committee and the summaries by the Chair of the sessions of the Working Group set out the status of the matters discussed by the Committee and the Working Group, respectively, noting the range of views expressed and areas where agreement had been reached, and identifying what future work needed to be undertaken (see documents PCT/R/1/26, paragraphs 72 to 76; PCT/R/2/9, paragraphs 111 to 123 and 125; PCT/R/WG/1/9, paragraphs 22 and 23; PCT/R/WG/2/12, paragraphs 54 to 56; PCT/R/WG/3/5, paragraphs 13 to 27; PCT/R/WG/4/14, paragraphs 35 to 44).

4. The Working Group’s discussions at its last (fourth) session (see document PCT/R/WG/4/14, paragraphs 35 to 44) are outlined in the following paragraphs:

“OPTIONS FOR RESTORATION OF THE RIGHT OF PRIORITY

“35. Discussions were based on document PCT/R/WG/4/1, which set out three options for provisions designed to allow for restoration of the priority right in the international and/or the national phase, as consistently as possible with the principle adopted in the PLT, and document PCT/R/WG/4/1 Add.1, which outlined the replies received in response to a questionnaire concerning the application of the criteria of “due care” and “unintentionality” under national practice in cases of restoration of rights. The three options covered in document PCT/R/WG/4/1 were the following:

Option A: “unintentionality” criterion (set out in Annex I of document PCT/R/WG/4/1);

Option B: “due care” criterion (also set out in Annex I of document PCT/R/WG/4/1);

Option C: retain priority claim for international phase leaving restoration for national phase (set out in Annex II of document PCT/R/WG/4/1).

“36. The question of restoration of the right of priority had been discussed at several previous meetings in the context of reform of the PCT. Although the Working Group agreed that providing for such restoration was important, there remained no consensus as to how this should be implemented in the PCT procedure.

“37. The Working Group agreed that several general principles needed to be recognized in any draft provisions allowing for restoration of the right of priority during the international phase. First, there was a need that a decision by a receiving

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. References to “national laws,” “national applications,” “the national phase,” etc., include reference to regional laws, regional applications, the regional phase, etc. References to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT.

Office to restore a right of priority be recognized and given effect in designated Offices. Second, it needed to be clear that such a decision related only to the restoration, as such, of the right of priority and not to the ultimate validity of a priority claim in terms of substantive patent law, for example, as regards whether the subject matter of a claim was disclosed in the earlier application concerned. Third, a decision by a receiving Office refusing to restore a right of priority should not preclude the possibility that designated Offices might subsequently allow such restoration in the national phase.

“38. However, the Working Group remained divided as to whether the appropriate criterion for the restoration of a right of priority was that the failure to file the international application within the 12 month priority period was unintentional (as under Option A) or occurred in spite of due care having been taken (as under Option B), noting that those two alternatives were provided for under the PLT. A number of delegations expressed a preference for Option A and a slightly smaller number for Option B. Two delegations stated that the Offices in their countries had no experience with such restoration procedures and that they would need more time to consider the implications of the proposals in the context of their national laws. One of them requested that the possibility of making a reservation on the issue of restoration of the priority right be included.

“39. A large number of delegations stated that they could, at least by way of compromise, support provisions that would allow for a priority claim to be retained in the international application during the international phase, leaving a decision on restoration of the right of priority to be made separately by each designated Office during the national phase, as under Option C. However, several delegations opposed Option C, and some of the delegations that expressed support for it indicated that they would prefer a solution that would give greater certainty to applicants and minimize the need for restoration to be determined before separate designated Offices in the national phase. This might be achieved, for example, by combining certain elements from Options A, B and C. However, such a “combined” solution would necessarily require receiving Offices to apply one or other (or both) of the criteria referred to in Options A and B. Several delegations expressed concern at the possibility that Offices might be obliged to apply different criteria under different procedures, whether in respect of international applications (in the international phase in their capacity as receiving Offices and in the national phase in their capacity as designated Offices) and in respect of direct national filings. Some delegations queried in connection with Option C, in particular, whether a claimed priority date should be taken into account for the purposes of the international search and international preliminary examination where no decision on restoration was made during the international phase.

“40. The Working Group invited the International Bureau to prepare, for consideration at the next session, a draft proposal combining certain elements of Options A, B and C. A decision by the receiving Office to restore the right of priority would be binding on those designated Offices that applied the same or a less strict criterion. However, a designated Office that applied a stricter criterion than the receiving Office would not be bound by the receiving Office’s decision but would be permitted to decide the matter in the national phase based on its own criterion. In this connection, the Working Group noted that a decision to restore a right of priority based on the criterion of “due care” would be binding on designated Offices that applied the “unintentional” criterion. In any event, however, whatever criterion was

applied and whatever decision was made by the receiving Office, the priority claim would be retained in the application and would be used as the basis for computation of PCT time limits, as under Option C.

“41. One delegation suggested that, with a view to avoiding the need for certain Offices to apply different criteria in the international and national phases, consideration should be given to providing for the International Bureau to decide requests for restoration of the right of priority on a centralized basis. That suggestion was felt by several delegations to warrant further consideration but doubts were expressed by certain other delegations. The International Bureau noted that such a procedure could, if desired, be implemented by adapting the existing procedure under Rule 19.4, which already provided for the transmittal of international applications to the International Bureau as receiving Office in certain cases.

“42. Two delegations expressed concern that allowing for restoration of the right of priority could conflict with Article 8(2)(a), under which the conditions for, and effect of, any priority claim shall be as provided under the Paris Convention for the Protection of Industrial Property. It was noted that this concern needed to be borne in mind in the drafting of revised proposals.

“43. The Working Group noted the following suggestions made by delegations and representatives in respect of the proposals contained in Annexes I and II of document PCT/R/WG/4/1, to be taken into account by the International Bureau in preparing a revised proposal:

(a) The period for submitting a notice correcting the priority claim so as to comply with the requirements of Rule 4.10 should be subject to Rule 80.5 where that period expired on a non-working day (see Rule 26*bis*.2(b)).

(b) It should be ensured that the computation of time limits under proposed new Rule 80.8 would operate satisfactorily in relation to the time limit for performing the international search under Rule 42.1.

(c) Where the international application as filed did not claim the priority of the earlier application, the request for restoration of the right of priority should be accompanied by a notice adding the priority claim so as to comply with all the requirements of Rule 4.10 (see proposed new Rule 26*bis*.3(e)).

(d) In addition to the proposals contained in document PCT/R/WG/4/1, Rule 4 should be amended to enable the inclusion in the request form of a request for restoration of right of priority, at least where that request for restoration was on the ground of “unintentionality.”

(e) The importance of a prompt decision by the receiving Office under proposed new Rule 26*bis*.3(b) should be expressly reflected in the wording of the provisions.

(f) Information concerning a request for restoration should always be published together with the international application, that is, not only upon request made by the applicant (see proposed new Rule 26*bis*.3(g)(i)).

(g) Under Option C, a request to a designated Office for restoration of the right of priority should be made at the time of entry into the national phase or, at least, not later than the date on which the requirements under Article 22 must be complied with (see proposed new Rule 49*ter*.1(b)).

“44. The Chair invited delegations and representatives to submit directly to the International Bureau, preferably via the PCT reform electronic forum on WIPO’s Website, any further comments or suggestions for the preparation of revised proposals concerning restoration of the right of priority.”

5. As invited by the Working Group, the International Bureau has prepared further revised proposals relating to the restoration of the right of priority. Annex I to the present document contains a draft proposal combining certain elements of the previous Option A (“unintentionality”), Option B (“due care”) and Option C (“retain priority claim for international phase leaving restoration for national phase”) as contained in document PCT/R/WG/4/1, Annexes I and II, taking account of the suggestions made by delegations and representatives of users at the fourth session (see document PCT/R/WG/4/14, paragraph 43). The main features of the draft proposal are represented in the flowchart appearing on page 6, below, and are outlined in the following paragraphs. Article 13 and Rule 14 of the PLT are reproduced, for ease of reference, in Annex II.

RETENTION OF PRIORITY CLAIM; RESTORATION OF RIGHT OF PRIORITY

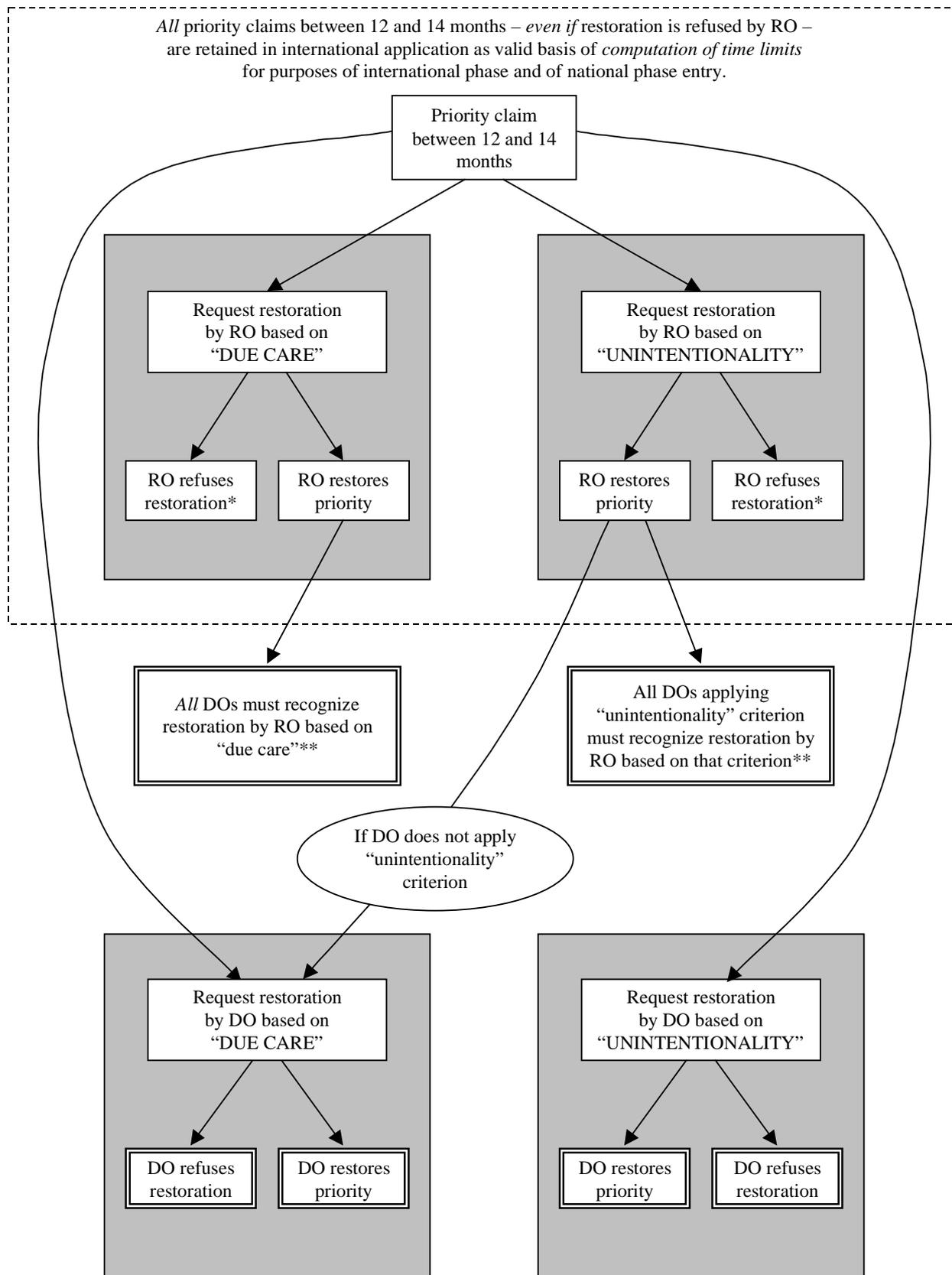
Automatic Retention of Priority Claim During International Phase

6. As under previous Option C, it is proposed to provide for the automatic retention, during the international phase, of a priority claim where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date. Such a priority claim would be retained irrespective of whether the applicant requests the receiving Office to restore the right of priority and even where such a request is made but refused by the receiving Office. In other words, such a priority claim would not be considered not to have been made (as would be the case under the present Regulations) and would therefore be taken into account during the international phase for the purposes of international search and international preliminary examination, and for the computation of time limits, including that for entry into the national phase.

Restoration of the Right of Priority by the Receiving Office during the International Phase

7. As under previous Options A and B, the applicant would have the possibility of requesting the receiving Office to restore the right of priority during the international phase. The receiving Office, when deciding on a request for restoration, would be free to apply either the more strict criterion of “due care” or the less strict criterion of “unintentionality.” Although not expressly stated in the proposed amended provisions, it is to be understood that a receiving Office could, if it wished, apply both criteria and leave the choice to the applicant as to which criterion is sought to be applied in a specific case. Furthermore, a receiving Office would also be free to apply, upon request of the applicant, first the “due care” criterion and, if the receiving Office finds that that criterion was not complied with, the “unintentionality” criterion. Those understandings could, if necessary, be expressed by the Assembly in amending the Regulations.

RESTORATION OF RIGHT OF PRIORITY



* Refusal by RO does not preclude a subsequent request to DO based on either criterion.

** Restoration by RO is subject to review by DO where reasonable doubt that requirements were met.

8. It would be advantageous for the applicant to obtain a positive finding by the receiving Office on the stricter criterion of “due care” since such a finding would be effective in all designated States, unlike a finding on the less strict “unintentionality” criterion (see paragraph 9, below).

Effect of Receiving Office Decision on Designated Offices

9. A decision by the receiving Office to restore a right of priority based on the criterion of “due care” would be effective in all designated States (subject to a transitional reservation provision). A decision by the receiving Office to restore a right of priority based on the criterion of “unintentionality” would be effective only in those designated States whose applicable national law provided for restoration of the right of priority based on that criterion.

Restoration of the Right of Priority by Designated Office during the National Phase

10. As under previous Option C, all designated Offices (including elected Offices) would be obliged to provide for the restoration of the right of priority in the national phase (subject to a transitional reservation provision). As under the PLT and the provisions applicable to the receiving Office mentioned above, the national law applicable by the designated Office would have to provide for the restoration of the right of priority either on the basis of the more strict criterion of “due care” or the less strict criterion of “unintentionality.” Although not expressly stated in the proposed amended provisions, it is to be understood that a designated Office could, if it wished, apply both criteria and leave the choice to the applicant as to which criterion is sought to be applied in a specific case. Furthermore, a designated Office would also be free to apply, upon request of the applicant, first the “due care” criterion and, if the receiving Office finds that that criterion was not complied with, the “unintentionality” criterion. Those understandings could, if necessary, be expressed by the Assembly in amending the Regulations.

11. In practice, of course, restoration of the right of priority by a designated Office during the national phase would only be necessary where the receiving Office had not already restored the right of priority with binding effect for the designated Office concerned.

12. The Working Group is invited to consider the proposals contained in Annex I to this document.

[Annex I follows]

ANNEX I

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:²

RESTORATION OF THE RIGHT OF PRIORITY

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² 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 *Mandatory and Optional Contents; Signature*

(a) and (b) [No change]

(c) The request may contain:

(i) and (ii) [No Change]

(iii) declarations as provided in Rule 4.17₂.

(iv) a request for restoration of the right of priority.

[COMMENT: See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 43(d). Upon consideration, it would not appear necessary to restrict paragraph (c)(iv) to requests for restoration on the ground of “unintentionality” but to also allow for the inclusion in the request form of a request for restoration on the ground of “due care.”]

(d) [No change]

4.2 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, ~~being a date falling within the period of 12 months preceding the international filing date;~~

[COMMENT: See Rule 26bis.2 as proposed to be amended, and the Comment thereon, below.]

(ii) to (v) [No change]

(b) to (d) [No change]

4.11 to 4.18 [No change]

Rule 26bis

Correction or Addition of Priority Claim

26bis.1 [No change]

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

[COMMENT: The proposed amendment of the title of Rule 26bis.2 is consequential on the proposed deletion of the reference to “invitation” in paragraph (b), below.]

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

(i) that a priority claim does not comply with the requirements of Rule 4.10; ~~or~~

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

(iii) that the international application has an international filing date which is later than the date on which the priority period expired;

the receiving Office or the International Bureau, as the case may be, shall invite the applicant to correct the priority claim or, in the case referred to in item (iii), where the international filing date is within two months from the date on which the priority period expired, to submit a request under Rule 26bis.3 for restoration of the right of priority.

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

[COMMENT: The proposed amendment of Rules 4.10(a) (see above) and 26bis.2(a) is consequential on the proposed introduction into the PCT system of the possibility to request restoration of the right of priority. The wording of proposed new item (iii) is modeled on PLT Article 13(2) and PLT Rule 14(4)(a).]

(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 or, in the case referred to in paragraph (a)(iii), a request for restoration of the right of priority in accordance with Rule 26bis.3 ~~so as to comply with the requirements of Rule 4.10,~~ that priority claim shall, subject to paragraph (c), be canceled. Where a priority claim is canceled it 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~~

[COMMENT: The proposed amendment of Rule 26bis.2(b) is consequential on the proposed introduction into the PCT system of the possibility to request restoration of the right of priority. See also paragraph (c) as proposed to be amended, below. With regard to the suggestion by one delegation concerning Rule 80.5 (see the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 43(a)), it would appear that no further amendment to paragraph (b) is needed since Rule 80.5 already applies to the expiration of the time limit under Rule 26bis.1(a).]

(c) A priority claim shall not be canceled ~~considered not to have been made~~ only because:

(i) the indication of the number of the earlier application referred to in Rule 4.10(a)(ii) is missing; ~~or because~~

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

(ii) an indication in the priority claim is not the same as the corresponding indication appearing in the priority document; or

(iii) the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date.

[COMMENT: See paragraph 6 of the Introduction to this document.]

(d) ~~(e)~~ Where the receiving Office or the International Bureau has made a declaration under paragraph (b), 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 the priority claim which was anceled ~~considered not to have been made~~. A copy of that request 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).

26bis.3 Restoration of Right of Priority by Receiving Office

(a) Where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the receiving Office shall restore the right of priority if:

(i) a request to that effect is submitted to the Office within a time limit of 14 months from the date on which the earlier application was filed;

(ii) the request states the reasons for the failure to file the international application within the priority period; and

(iii) the Office finds that the failure to file the international application within the priority period occurred in spite of due care required by the circumstances having been taken or, at the option of the Office, was unintentional.

[COMMENT: See paragraph 7 of the Introduction to this document.]

(b) Where a priority claim in respect of the earlier application is not contained in the international application, the request referred to in paragraph (a)(i) shall be accompanied by a notice under Rule 26bis.1(a) adding the priority claim.

[COMMENT: See also the summary of the fourth session by the Chair, document PCT/R/WG/4/14, paragraph 43(c).]

[Rule 26bis.3, continued]

(c) The submission of a request under paragraph (a)(i) may be subjected by the receiving Office to the payment to it, for its own benefit, of a fee for requesting restoration. The amount of that fee, if any, shall be fixed by the receiving Office.

[COMMENT: Earlier drafts provided for a fee for requesting restoration equal to 25% of the international filing fee referred to in item 1 of the Schedule of Fees, not taking into account any fee for each sheet of the international application in excess of 30 sheets. Upon further reflection, and in view of the fact that the number of requests for restoration of the right of priority is likely to be small, it appears preferable to simplify the provision further by allowing the receiving Office to fix the fee, as in the case of the transmittal fee under Rule 14.1(b).]

(d) The receiving Office may require that a declaration or other evidence in support of the statement of reasons referred to in paragraph (a)(ii) be filed with it within a time limit which shall be reasonable under the circumstances. The applicant may furnish to the International Bureau, and the International Bureau shall include in its files, a copy of any such declaration or other evidence filed with the receiving Office.

[COMMENT: See also Rule 48.2(b)(vii) as proposed to be added, below.]

(e) The receiving Office shall not refuse, totally or in part, a request under paragraph (a)(i) without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances.

[Rule 26bis.3, continued]

(f) The receiving Office shall promptly:

(i) notify the International Bureau of the receipt of a request under paragraph (a)(i):

(ii) make a decision upon the request;

[COMMENT: See the summary of the fourth session by the Chair, document PCT/R/WG/4/14, paragraph 43(e).]

(iii) notify the applicant and the International Bureau of its decision and of the criterion referred to in paragraph (a)(iii) upon which the decision was based.

(g) Each receiving Office shall inform the International Bureau as to which of the criteria referred to in paragraph (a)(iii) it is, in general, prepared to apply. The International Bureau shall promptly publish such information in the Gazette.

[COMMENT: So as to achieve a uniform approach to the question of restoration of the right of priority at least during the international phase, it is not proposed to provide for a transitional reservation provision in Rule 26bis.3 so as to permit receiving Offices to make a transitional reservation where the national law applied by the receiving Office is not compatible with other provisions of Rule 26bis.3, in particular, paragraph (a)(iii) (as was suggested in respect of a similar provision by one delegation during the third session of the Working Group; see the summary by the Chair of the third session of the Working Group, document PCT/R/WG/3/5, paragraph 23).

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

(a) The pamphlet shall contain:

(i) to (ix) [No change]

(x) any declaration referred to in Rule 4.17(v), and any correction thereof under Rule 26*ter*.1, which was received by the International Bureau before the expiration of the time limit under Rule 26*ter*.1;

(xi) any information concerning a request under Rule 26*bis*.3 for restoration of the right of priority and the decision of the receiving Office upon such request, including information as to the criterion referred to in paragraph (a)(iii) upon which the decision was based.

[COMMENT: See the summary of the fourth session by the Chair, document PCT/R/WG/4/14, paragraph 43(f).]

[Rule 48.2, continued]

(b) Subject to paragraph (c), the front page shall include:

(i) to (iii) [No change]

(iv) where applicable, an indication that the request contains any declaration referred to in Rule 4.17 which was received by the International Bureau before the expiration of the time limit under Rule 26*ter*.1;

[COMMENT: Clarification only.]

(v) where applicable, in connection with a request under Rule 26*bis*.3 for restoration of the right of priority, a reference to the fact that the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date;

(vi) where applicable, an indication that the pamphlet contains information concerning a request under Rule 26*bis*.3 for restoration of the right of priority and the decision of the receiving Office upon such request;

[COMMENT: See Comment on proposed new Rule 48.1(a)(xi), above.]

[Rule 48.2(b), continued]

(vii) where applicable, an indication that the applicant has, under Rule 26bis.3(d), furnished copies of any declaration or other evidence to the International Bureau.

(c) to (i) [No change]

(j) If, at the time of completion of the technical preparations for international publication, a request under Rule 26bis.3 for restoration of the right of priority is still pending, the pamphlet shall contain, in place of the decision by the receiving Office upon that request, an indication to the effect that such decision was not available and that the decision (when it becomes available) will be separately published.

[COMMENT: The inclusion of a provision requiring republication would appear appropriate. The proposed wording is modeled in part on Rule 48.2(h).]

48.3 to 48.6 [No change]

Rule 49ter

Effect of Restoration of Priority Right by Receiving Office:

Restoration of Right of Priority by Designated Office

49ter.1 Effect of Restoration of Priority Right by Receiving Office

(a) Where the receiving Office has restored a right of priority under Rule 26bis.3 based on a finding by it that the failure to file the international application within the priority period occurred in spite of due care required by the circumstances having been taken, that restoration shall, subject to paragraph (c), be effective in each designated State.

[COMMENT: See paragraph 9 of the Introduction to this document. As regards a transitional reservation provision, see paragraph (e) and Rule 49ter.2(f), below.]

(b) Where the receiving Office has restored a right of priority under Rule 26bis.3 based on a finding by it that the failure to file the international application within the priority period was unintentional, that restoration shall, subject to paragraph (c), be effective in any designated State whose applicable national law provides for restoration of the right of priority based on that criterion.

[COMMENT: See paragraph 9 of the Introduction to this document. Restoration by the receiving Office would also be effective in any designated Office whose applicable national law provided for the restoration of the right of priority based on a criterion more favorable than the “unintentionality” criterion. A decision by the Assembly may be necessary to ensure that such understanding is agreed upon by all Contracting States. As regards a transitional reservation provision, see paragraph (e) and Rule 49ter.2(f), below.]

[Rule 49ter.1, continued]

(c) Where the receiving Office has restored a right of priority under Rule 26bis.3, any designated Office may review the decision of the receiving Office if it has reasonable doubts that a requirement applied by the receiving Office under that Rule was complied with. In such case, the designated Office 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.

(d) No designated Office shall be bound by a decision of the receiving Office refusing a request under Rule 26bis.3 for restoration of the right of priority.

(e) If, on [date of adoption of these modifications by the PCT Assembly], any provision of paragraphs (a) to (c) 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 be 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.

[COMMENT: A designated Office whose applicable national law did not provide for the restoration of the right of priority at all or did provide for the restoration of the right of priority based on a more stringent criterion than the “due care” criterion would have to make use of the transitional reservation provision under paragraph (e) and also of the transitional reservation provision under Rule 49ter.2(f).]

49ter.2 Restoration of Right of Priority by Designated Office

(a) Where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the designated Office shall restore the right of priority if:

(i) a request to that effect is submitted to the Office within a time limit of one month from the applicable time limit under Article 22;

[COMMENT: See the summary by the Chair of the fourth session of the Working Group, document PCT/R/WG/4/14, paragraph 43(g). Upon further consideration, it would appear reasonable to give the applicant at least one month from the applicable time limit under Article 22 to request restoration before the designated Office.]

(ii) the request states the reasons for the failure to file the international application within the priority period;

(iii) the Office finds that the failure to file the international application within the priority period occurred in spite of due care required by the circumstances having been taken or, at the option of the Office, was unintentional.

[COMMENT: See paragraph 10 of the Introduction to this document.]

[Rule 49ter.2, continued]

(b) The designated Office:

(i) may require that a fee be paid in respect of a request under paragraph (a)(i);

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

(c) The designated Office shall not refuse, totally or in part, a request referred to in paragraph (a)(i) for restoration of a 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.

(d) Where the national law applicable by the designated Office provides, in respect of the restoration of the right of priority, for requirements which, from the viewpoint of applicants, are more favorable than the requirements provided for under paragraph (a), the designated Office shall, when determining the right of priority, apply the requirements under the applicable national law instead of the requirements under that paragraph.

(e) Each designated Office shall inform the International Bureau as to which of the criteria referred to in paragraph (a)(iii) it is, in general, prepared to apply or, where applicable, of the requirements of the national law applicable in accordance with paragraph (d). The International Bureau shall promptly publish such information in the Gazette.

[Rule 49ter.2, continued]

(f) If, on [date of adoption of these modifications by the PCT Assembly], any of the provisions of paragraph (a) 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 be 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.

[COMMENT: Any designated Office whose national law provided for a criterion more stringent than the “due care” criterion or did not provide for restoration of the right of priority at all could make use of the transitional reservation provision under proposed new paragraph (f). Designated Offices whose applicable national law provided for the restoration of the right of priority based on requirements similar but not identical to the requirements under Rule 49ter.2(a) would not need to make use of the transitional reservation provision, provided the requirements under the applicable national law were, from the viewpoint of applicants, at least as favorable as the requirements under Rule 49ter.2(a). A decision by the Assembly may be necessary to ensure that such understanding is agreed upon by all Contracting States.]

Rule 76³

Application of Certain Rules to Procedures Before Elected Offices;

~~Copy, Translation and Fee Under Article 39(1);~~ Translation of Priority Document

[COMMENT: The proposed amendment of the title of this Rule is consequential on the proposed amendment of the subtitle of Rule 76.5 (see below).]

76.1, 76.2 and 76.3 *[Remain deleted]*

76.4 [No change]

76.5 Application of Certain Rules ~~22.1(g), 47.1, 49, 49bis and 51bis~~

[COMMENT: Clarification and simplification only.]

Rules 22.1(g), 47.1, 49, 49bis, 49ter and 51bis shall apply, provided that:

[COMMENT: The proposed amendment of Rule 76.5 is consequential on the proposed addition of new Rule 49ter.]

(i) to (v) [No change]

76.6 *[Remains deleted]*

[Annex II follows]

³ The “present” text shown is that of Rule 76 as amended by the Assembly on October 1, 2002 (see document PCT/A/31/10) and due to enter into force on January 1, 2004.

ANNEX II

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 the request for the 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).

[End of Annex II and of document]