



Restoring the Priority Right

WIPO PCT Webinar Series
Session 5

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Mr. Matthias Reischle-Park
Deputy Director
PCT Legal and User Support Section
PCT Legal and User Relations Division

Ms. Hanna Kang
Legal Officer
PCT Legal and User Support Section
PCT Legal and User Relations Division

Ms. Mineko Mohri
Legal Officer
PCT Legal and User Support Section
PCT Legal and User Relations Division

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Restoration of the Right of Priority

Poll questions



1. Restoration may be requested during:

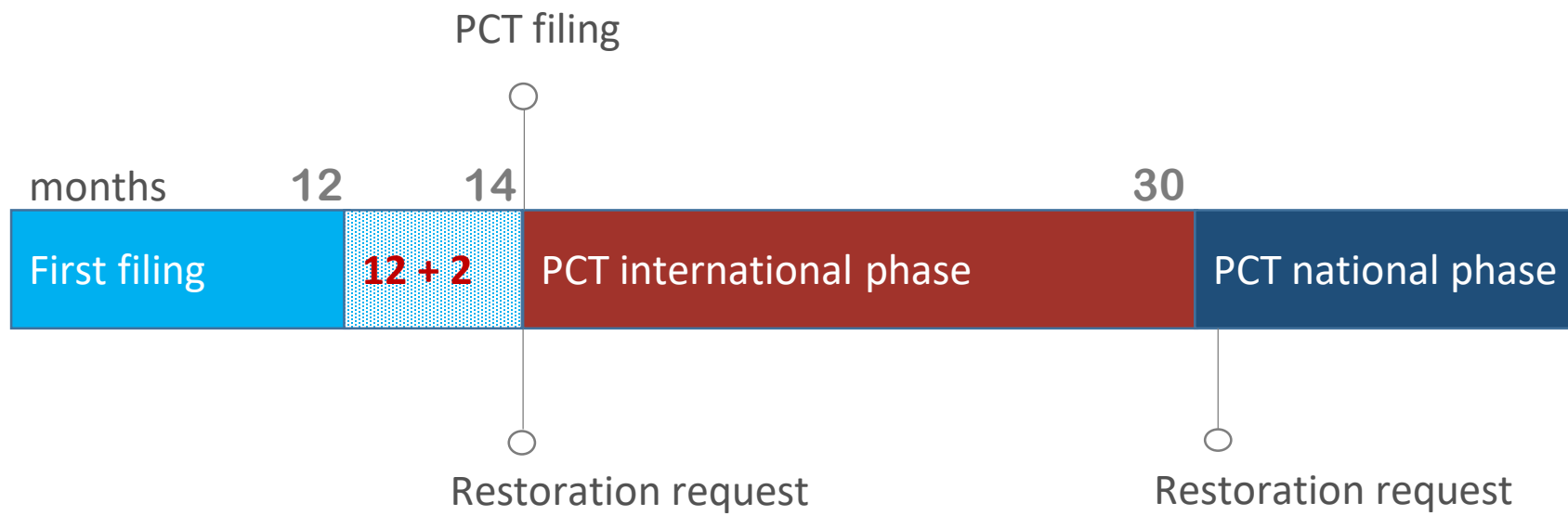
- a.** International phase
- b.** National phase
- c.** Both

2. Restoration granted under the unintentional standard will be accepted by all designated Offices

- a. Yes
- b. No
- c. I don't know

Restoration of the right of priority – Competent Authorities

- RO during the international phase
(Rule 26*bis*.3)
- DO during the national phase
(Rule 49*ter*.2)



Restoration by RO (Rule 26*bis*.3)

■ Conditions:

- request to restore must be filed with the RO
- time limit: within a period of 2 months from the date of the expiration of the priority period
- filing of statement of reasons for failure to comply with the time limit
- statement should preferably be accompanied by a declaration or other evidence to support such statement
- where applicable, payment of the required fee

Applicable criteria (Rules 26bis.3(a) and 49ter.2(a))

■ Two possible criteria for restoration:

- failure to file the application within the priority period occurred in spite of due care required by the circumstances having been taken
- failure to file the application within the priority period was unintentional

■ Offices must apply at least one of these criteria (may apply both); DOs may also apply a more favorable criterion in accordance with their national laws

<https://www.wipo.int/pct/en/texts/restoration.html>

Unintentional criterion

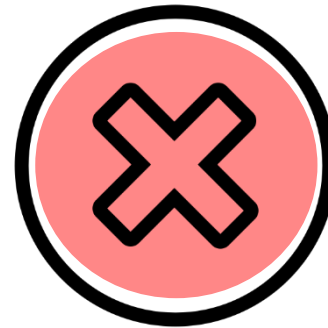
- When the priority period expired, applicant had a continuing underlying intention to file
 - did not deliberately refrain from filing

Unintentional criterion example

Applicant failed to obtain sufficient funds to pay the filing fee before the priority period expired. The request will likely be:



Granted



Refused

Due care criterion (1)

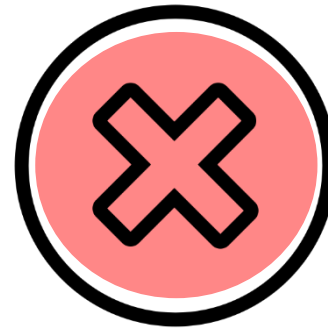
- Applicant took all measures a reasonably prudent applicant would have taken under the circumstances
 - analysis of the applicant's specific acts related to the filing of the international application up to the expiration of the priority period

Due care criterion: example 1

Applicant timely filed a PCT application wrongly believing that a corporation from the Channel Islands (Jersey) had the right to file. Applicant asserts that it was a result of understandable confusion. The request will likely be:



Granted



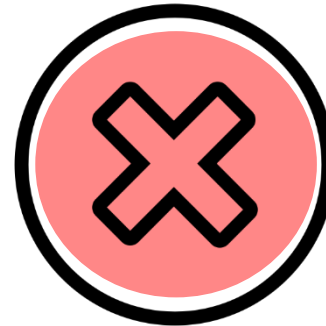
Refused

Due care criterion: example 2

Docking clerk made a priority date entry error. The clerk has docketed over 500 filings without similar mistakes in the past and participates in regular trainings. The clerk's work is regularly reviewed by an attorney. The request will likely be:



Granted



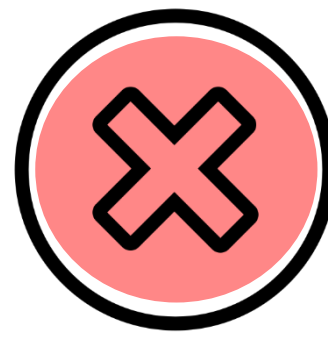
Refused

Due care criterion: example 3

Due to a dramatic increase in workload, the agent overlooked the priority period deadline. The agent has filed over 500 PCT applications without similar mistakes in the past and participates in regular PCT trainings. The agent's work is regularly reviewed by a senior attorney. The request will likely be:



Granted



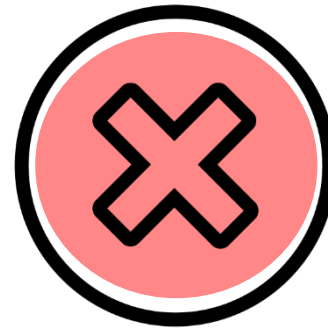
Refused

Due care criterion: example 4

Applicant was hospitalized starting one week prior to the expiry of the priority period for three week and could not timely instruct the agent to file the PCT application. The request will likely be:



Granted



Refused

Due care criterion (2)

■ Case-by-case factual analysis of each request

- Lack of knowledge
- Lack of financing
- Absence from office issues
- Human error by applicant/agent
- Human error by staff of applicant/agent
- Force majeure events
- Postal delivery issues
- Technical failures/IT issues
- Docketing system errors
- Miscommunications between agent and applicant

■ ROGL paragraphs 166J to M

<https://www.wipo.int/export/sites/www/pct/en/texts/pdf/ro.pdf>

Restoration by RO

Communication of documents to the IB

- General Rule: RO forwards to the IB all documents received from the applicant
- Exception: RO may not forward if:
 - it does not obviously serve the purpose of informing the public about the international application,
 - publication of or public access to such information would clearly prejudice the personal or economic interests of any person, and
 - there is no prevailing public interest to have access to that information
- The applicant may be required to submit replacement sheets

Effects of refusal to restore by RO (Rule 26bis.3)

- Any priority claim to an earlier application filed less than 14 months before the international filing date
 - will not be declared void even if priority is not restored by the RO (Rule 26bis.2(c)(iii))
 - will serve as a basis to calculate time limits during the international phase
- The validity of such a priority claim in the national phase is not assured

Effects of restoration in the national phase (Rule 49*ter*.1)

- RO restoration based on the “due care” criterion is effective in all DOs
- RO restoration based on the “unintentional” criterion is effective in those DOs which apply that criterion (or a more lenient one)
- RO restoration is not conclusively binding on DOs: limited review by DOs is possible
- RO refusal to restore is not binding on DOs

Notifications of incompatibility with national laws:

www.wipo.int/pct/en/texts/reservations/res_incomp.html

Reservations made by Offices

- Incompatibility as RO (Rule 26*bis*.3(j)):
BR, CO, CU, CZ, DE, DZ, GR, ID, IN, KR, PH
- Incompatibility of the effect of decision of RO on DO
(Rule 49*ter*.1(g)):
BR, ~~CA~~^{*}, CN, CO, CU, CZ, DE, DZ, ID, IN, KR, LT, MX, PH
*For applications filed on or after October 30, 2019
- Incompatibility as DO (Rule 49*ter*.2(h)):
BR, CA, CN, CO, CU, CZ, DE, DZ, ID, IN, KR, MX, PH

Notifications of incompatibility with national laws:

www.wipo.int/pct/en/texts/reservations/res_incomp.html

Poll answers



1. Restoration may be requested during:

- a. International phase
- b. National phase
- c. Both**

2. Restoration granted under the unintentional standard will be accepted by all designated Offices

- a.** Yes
- b.** No
- c.** I don't know

Questions?



PCT Resources

■ General questions about the PCT

□ Contact the PCT Information Service:

Telephone: +41 22 338 83 38

E-mail: pct.infoline@wipo.int

■ Questions about the ePCT

□ Contact PCT eServices Help Desk:

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