



C.PCT 1093

21.1

January 22, 2007

Madam,  
Sir,

1. This Circular is addressed to your Office in its capacity as receiving, designated and/or elected Office under the Patent Cooperation Treaty (PCT). It concerns the restoration of the right of priority and, in particular, PCT Rules 26*bis*.3 and 49*ter*. These Rules will enter into force on April 1, 2007, as adopted by the PCT Union Assembly at its thirty-fourth (15<sup>th</sup> ordinary) session held from September 26 to October 5, 2005.
2. The purpose of this Circular is to request receiving, designated and elected Offices to inform the International Bureau about the criteria in accordance with which restoration of the right of priority of the applicant will be granted (see PCT Rules 26*bis*.3(i) and 49*ter*.2(g)), as well as any necessary information relating to a request for restoration (such as amounts of applicable fees, information concerning declarations or other evidence which may be required, etc.). For that purpose, a questionnaire has been prepared and is annexed to this Circular.
3. Reference is made to the possible notification of incompatibility with the national law applied by receiving Offices under Rule 26*bis*.3(j) and by designated Offices under Rules 49*ter*.1(g) and 49*ter*.2(h). It is recalled that, according to these Rules and prior to April 5, 2006, receiving Offices and designated Offices had the possibility of informing the International Bureau that these Rules were not compatible with the national law applied by them. Consequently, paragraphs (a) to (i) of Rule 26*bis*.3 will not apply in respect of receiving Offices of the following States and intergovernmental organization which so notified the International Bureau for as long as they continue not to be compatible with that law: Algeria, Belgium, Brazil, Colombia, Cuba, Czech Republic, European Patent Organisation, France, Germany, Greece, Hungary, India, Indonesia, Italy, Japan, Norway, Philippines, Portugal, Republic of Korea, Singapore and Spain. Consequently also, paragraphs (a) to (f) of Rule 49*ter*.1 and paragraphs (a) to (g) of Rule 49*ter*.2 do not apply in

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respect of designated and elected Offices of the following States and intergovernmental organization which notified the International Bureau accordingly, for as long as they continue not to be compatible with that law: Algeria, Brazil, Canada, China, Colombia, Cuba, Czech Republic, European Patent Organisation, Germany, Hungary, India, Indonesia, Japan, Lithuania, Mexico, Norway, Philippines, Portugal, Republic of Korea, Singapore, Spain, Sweden, Turkey and United States of America.

4. Reference is also made to Circular C.PCT 887, dated December 19, 2002, which was sent to Offices following a request by the Working Group on Reform of the PCT at its third session for information concerning the application of the criteria of “due care” and “unintentionality”, in the context of the restoration of the right of priority, under the various national laws and practices of all national and regional Offices of, or acting for, a State party to the PCT. Responses to Circular C.PCT 887 have been the subject of document PCT/R/WG/4/1 Add.1  
./ (enclosed for ease of reference).

5. Finally, reference is made to Annex IV of document PCT/A/34/6 (report adopted by the PCT Union Assembly at its thirty-fourth session) concerning the “Understandings relating to certain provisions”, especially to paragraphs 3-4 for receiving Offices and paragraphs 6-9 for designated Offices.

6. Your Office is requested to inform the International Bureau of the criteria applied (in accordance with PCT Rules 26*bis*.3(i) and 49*ter*.2(g)), as well as to notify any particular condition for filing a request for restoration of the right of priority (see paragraph 2), which information will be published in the *PCT Applicant's Guide*.

7. The International Bureau would appreciate receiving completed copies of the questionnaire annexed to this Circular preferably by fax to (+41-22) 338 71 50 or by e-mail to Pct.OfficeSupport@wipo.int by February 1, 2007. Note that where your Office already replied to Circular C.PCT 887 cited above, you can, if applicable, simply indicate a reference to your previous responses in reply to questions 3 to 7 of the attached questionnaire.

Yours sincerely,



Francis Gurry  
Deputy Director General

Annexes: Questionnaire Relating to Restoration of the Right of Priority of the Applicant with Respect to an International Application  
Circular C.PCT 887 and document PCT/R/WG/4/1 Add.1

**Questionnaire Relating to Restoration of the Right of Priority of the Applicant with Respect to an International Application**

Name of Office/Intergovernmental Organization:

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Person completing this Questionnaire:

Last name: \_\_\_\_\_

First Name: \_\_\_\_\_

Title: \_\_\_\_\_

Contact details: \_\_\_\_\_

1. Under which conditions, according to PCT Rule 26bis.3, does your receiving Office restore the right of priority?

(i) In accordance with PCT Rule 26bis.3(a), the applicant must state in his request for restoration of the right of priority that:

any delay in meeting the applicable time limit was unintentional

the failure to meet the applicable time limit occurred in spite of due care

Each RO shall apply at least one of those criteria and may apply both of them (PCT Rule 26bis.3(a))

(ii) Does your Office require the applicant to comply with any of the following further conditions in accordance with PCT Rule 26bis.3(d) or (f)?

payment of a fee in respect of the request (*if yes, please specify currency, amount and time limit within which this fee would need to be paid*)

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- furnishing of a declaration or other evidence in support of the request *(if yes, please specify what needs to be furnished and within which time limit)*

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- none of the conditions mentioned above are provided for under the national law

(iii) Pursuant to PCT Rule 26bis.3(g), what is the procedure under which your Office gives the applicant the opportunity to make observations on the intended refusal of a request for restoration of the right of priority? *(Please specify details, such as whether the applicant will receive a notification of the intended refusal and what time limit will be given to the applicant to make observations.)*

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2. Under which conditions, according to PCT Rule 49ter.2, does your designated Office restore the right of priority?

- (i) In accordance with PCT Rule 49ter.2(a), the applicant must state in his request for restoration of right of priority that:

- any delay in meeting the applicable time limit was unintentional
- the failure to meet the applicable time limit occurred in spite of due care

Each DO shall apply at least one of those criteria and may apply both of them (PCT Rule 49ter.2(a))

(ii) Does your Office require the applicant to comply with any of the following further conditions in accordance with Rule 49<sup>ter</sup>.2(d) or (c)?

payment of a fee in respect of the request *(if yes, please specify currency, amount and time limit within which this fee would need to be paid)*

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furnishing of a declaration or other evidence in support of the request *(if yes, please specify what needs to be furnished and within which time limit)*

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none of the conditions mentioned above are provided for under the national law

(iii) Pursuant to PCT Rule 49<sup>ter</sup>.2(e), what is the procedure under which your Office gives the applicant the opportunity to make observations on the intended refusal of a request for restoration of the right of priority? *(Please specify details, such as whether the applicant will receive a notification of the intended refusal and what time limit will be given to the applicant to make observations.)*

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5. Do guidelines exist which further define the two criteria and explain how to apply them? If so, please reproduce the guidelines here or attach a copy to this questionnaire.

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6. What are the main problems, if any, with regard to the application of the two criteria?

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7. Other comments you may find useful:

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C. PCT 887  
- 21.1

December 19, 2002

Madam,  
Sir,

*Questionnaire: Application of the Criteria of “Due Care” and  
“Unintentionality” in Cases of Restoration of Rights*

1. This Circular is addressed to your Office in its capacity as a national or regional Office of or acting for a State party to the Patent Cooperation Treaty (PCT). It concerns proposals for amendment of the Regulations under the PCT which would include provisions for restoration of the right of priority similar to those under the Patent Law Treaty (PLT).

2. At its third session, held in Geneva from November 18 to 22, 2002, the Working Group on Reform of the PCT considered proposals for amendment of the Regulations under the PCT relating to the restoration of the right of priority. Noting that there was no general agreement in the Working Group as to which of the two criteria for restoration provided for in the PLT, namely, “due care” and “unintentionality,” should apply under the PCT in the case of determinations by a receiving Office, it was agreed that the International Bureau should send a questionnaire to all PCT Offices and Authorities requesting information as to the application of such criteria under the various national laws and practices. As stated in the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 20 and 27:

“20. Several delegations suggested that guidance should be provided in the context of the PCT as to the application of the two criteria, noting that no such guidance was provided in the context of the provisions concerning the matter in the PLT and that little information was available as to the present practices of the various Offices. One delegation suggested that it would be useful to conduct a survey of present practices by sending a questionnaire to all PCT Offices and Authorities.

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That survey should seek information as to the application of the criteria of “due care” and “unintentionality” in general, that is, not restricted to cases where restoration of the right of priority was sought, but also in cases, for example, of late payment of annuities, in order to obtain guidance as to the differences between the two criteria and to assist in the establishment of guidelines. The questionnaire should also seek information as to the proof required.

[...]

“27. It was also agreed that the International Bureau should send a questionnaire to all PCT Offices and Authorities requesting information as to the application of such criteria under the various national laws and practices.”

3. In order to obtain more information about the experience of national Offices and Authorities concerning the application of the criteria of “due care” and “unintentionality” under the various national laws and practices, in particular, as to the differences between the two criteria, and to assist in the establishment of guidelines, you are kindly requested to complete the attached questionnaire. The International Bureau would appreciate receiving your reply by January 24, 2003, preferably by e-mail sent to [pct.reform@wipo.int](mailto:pct.reform@wipo.int) or by fax sent to (+41-22) 338 8780.

Sincerely yours,



Francis Gurry  
Assistant Director General

Enclosure: Questionnaire concerning the application of the criteria of “due care” and “unintentionality” in cases of restoration of rights

QUESTIONNAIRE:\*

APPLICATION OF THE CRITERIA OF “DUE CARE” AND  
“UNINTENTIONALITY” IN CASES OF RESTORATION OF RIGHTS

Name of Office: .....  
Country: .....

*Person completing this Questionnaire:*

Name: .....  
Title: .....  
Dep./Section: .....  
Tel.: .....  
Fax: .....  
E-mail: .....

*Application of the criteria of “due care” and “unintentionality” under the applicable national law and practice*

*Question 1:* Does the national law and/or practice applicable by your Office in cases of restoration of rights (that is, not restricted to cases where restoration of the right of priority is sought, and not restricted to the patent procedure) provide for the application of the criteria of “due care” and/or “unintentionality”? If so, in which context?

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\* You are kindly requested to complete this Questionnaire and to return it to the International Bureau by January 24, 2003, preferably by e-mail sent to [pct.reform@wipo.int](mailto:pct.reform@wipo.int) or by fax sent to (+41-22) 338 8780. If you wish to receive this Questionnaire by e-mail (and return it by the same means), or for any further information, please contact Claus C. Matthes, Head, PCT Reform Section, Patent Policy Department, World Intellectual Property Organization; tel.: (+41-22) 338 98 09; fax.: (+41-22) 338 8780; e-mail: [claus.matthes@wipo.int](mailto:claus.matthes@wipo.int)



*Question 5 (only applicable if the answer to question 1 is “yes”):* What are the main problems, if any, with regard to the application of the two criteria?

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[End of Annex and of Circular]

# WIPO



PCT/R/WG/4/1 Add.1

ORIGINAL:English

DATE:March17,2003

**WORLD INTELLECTUAL PROPERTY ORGANIZATION**

GENEVA

**INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)**

**WORKING GROUP ON REF ORMOFTHEPATENT  
COOPERATION TREATY( PCT)**

**Fourth Session**

**Geneva, May 19 to 23, 2003**

**APPLICATION OF THE CRITERIA OF "DUE CARE" AND "UNINTENTIONALITY"  
UNDER NATIONAL PRACTICE IN CASES OF RESTORATION OF RIGHTS:**

**REPLIES RECEIVED IN RESPONSE TO QUESTIONNAIRE**

*Document prepared by the International Bureau*

## BACKGROUND

1. At its third session, held in Geneva from November 18 to 22, 2002, the Working Group considered proposals for amendment of the Regulations under the PCT relating to the restoration of the right of priority. Noting that there was no general agreement in the Working Group as to which of the two criteria for restoration provided for in the PLT, namely, "due care" and "unintentionality," should apply under the PCT in the case of determinations by a receiving Office, it was agreed that the International Bureau should send a questionnaire to all PCT Offices and Authorities requesting information as to the application of such criteria under the various national laws and practices. As stated in the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 20 and 27:

"20. Several delegations suggested that guidance should be provided in the context of the PCT as to the application of the two criteria, noting that no such guidance was provided in the context of the provisions concerning the matter in the PLT and that little information was available as to the present practices of the various Offices. One delegation suggested that it would be useful to conduct a survey of present practices by sending a questionnaire to all PCT Offices and Authorities. That survey should seek

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information as to the application of the criteria of “due care” and “unintentionality” in general, that is, not restricted to cases where restoration of the right of priority was sought, but also in cases, for example, of late payment of annuities, in order to obtain guidance as to the differences between the two criteria and to assist in the establishment of guidelines. The questionnaire should also seek information as to the proof required.

[...]

“27. It was also agreed that the International Bureau should send a questionnaire to all PCT Offices and Authorities requesting information as to the application of such criteria under the various national laws and practices.”

2. Revised proposals for the amendment of the Regulations, setting out different options for consideration by the Working Group, are contained in document PCT/R/WG/4/1.

3. By way of Circular C.PCT/887, dated December 19, 2002, the International Bureau sent a questionnaire concerning the application of the criteria of “due care” and “unintentionality” under the various national laws and practices to all national and regional Offices of or acting for a State party to the PCT. The Annex to this document contains the responses received by the date of this document.

4. *The Working Group is invited to take note of the content of the Annex.*

[Annex follows]

## ANNEX

APPLICATION OF THE CRITERIA OF "DUE CARE" AND "UNINTENTIONALITY"  
UNDER NATIONAL PRACTICE IN CASES OF RESTORATION OF RIGHTS:

## REPLIES RECEIVED IN RESPONSE TO QUESTIONNAIRE

*Question 1:* Does the national law and/or practice applicable by your Office in cases of restoration of rights (that is, not restricted to cases where restoration of the right of priority is sought, and not restricted to the patent procedure) provide for the application of the criteria of "due care" and/or "unintentionality"? If so, in which context?

*Response by Armenia:* "The national law and practice applicable by your office does not provide for the application of the criteria of "due care" and/or "unintentionality".

*Response by Australia:* "The Australian Patents Act 1990 and the Patent Regulations contain provisions for extension of time under section 223 and regulation 22.11 (copies attached). These provisions effectively allow for a restoration of rights when a relevant act has not been done within time. These provisions allow the Commissioner of Patents to extend the time for doing an act where the failure to do the act was because of: (i) an error or omission by the person concerned or his or her agent or attorney (section 223(2)(a)); (ii) circumstances beyond the control of the person concerned (section 223(2)(b)); or (iii) despite the person concerned taking due care, as required in the circumstances, to ensure the doing of the act within that time, the relevant act is not done within time. (Section 223(2A)). Section 223(2A) was introduced in 2002 to bring the Patents Act into compliance with Article 12 of the PLT. In practice, there may be significant overlap between these three provisions. Because of the broad nature of (i), the majority of extensions are granted under this provision. Some guiding principles used include: -- the statutory provision to extend time is beneficial in nature, and should be applied beneficially; -- while the applicant has the burden of placing before the Commissioner the circumstances which it claims will justify the grant of an extension of time, that does not amount to a burden of proof and it is not appropriate that it should be so described; -- there must be a casual relationship or connection between the error or omission and the relevant act that is required to be done within the stipulated time. In addition, the applicants for an extension must demonstrate that they had an intention to do the relevant required act, and that an error or omission on their, or their agent's behalf, reasonably could be said to have caused the failure to complete the relevant act in the time prescribed. These provisions are available for almost any action that is required to be done within a certain time. Some exceptions where the provisions are not available are, for example, requests to file a first-in-time application, (as opposed to claiming priority); requests in respect of matters where the Commissioner has become *functus officio* (such as a request filed after grant to extend the time for filing a notice of opposition (for pre-grant opposition))."

*Response by Austria:* "The Austrian Patent Law applicable by the Austrian Patent Office in cases of restoration of rights provides for the application of the criterion of "due care". There are a limited number of cases where the restoration of rights is not possible. The most important ones are there in statement in the time limit for a petition for reinstatement and the reinstatement into the time limit under Article 4 of the Paris Convention. Section 129(2) of the Austrian Patent Law indicates all cases where restoration of rights is not possible".

*Response by Belarus:* “The national law and practice applicable by this office in cases of restoration of rights does not provide for the application of the criteria of “due care” and “unintentionality.”

*Response by Belgium:* “The Belgian law on patents of 28 March 1984, published in the *Moniteur Belge* issued on 9 March 1985, provides in Article 41 -1 the possibility for the patent applicant or patent owner to have his rights being restored if he has an “excuse légitime” for the non-payment of the annual fee on time. If the Office agrees to restore the right, such restoration is effective only after the rightholder has paid the annual fee within a time limit of one month from the date of the decision on the restoration of the right (Article 41 -2.2)). The Intellectual Property Office of Belgium considers that such provision does not fall within the scope of the criteria of “due care” and “unintentionality”. Besides, there is neither a provision in the Belgian law on patents nor in the practice before our Office providing for the use of such criteria. Therefore, the answer to the question is negative.”

*Response by Bulgaria:* “Restoration of rights may be requested only in cases when the delay in meeting of time limits occurs because of special unforeseen circumstances (Art. 49 BPL), that means in spite of all due care reasonably required by the circumstances.”

*Response by Canada:* “No, Canadian national law and/or Canadian Patent Office practice does not currently provide for the application of the criteria of “due care” and/or “unintentionality” in cases of restoration of rights.”

*Response by China:* “The Article 29 in our patent law is dealing with priority. There is no provision in our law dealing with the restoration of right of priority. There is a general provision in our regulation to deal with restoration of rights: Rule 7. Article 29: “Where, within twelve months from the date on which any applicant first filed in a foreign country an application for a patent for invention or utility model, or within six months from the date on which any applicant first filed in a foreign country an application for a patent for design, he or it files in China an application for a patent for the same subject matter, he or it may, in accordance with any agreement concluded between the said foreign country and China, or in accordance with any international treaty to which both countries are party, or on the basis of the principle of mutual recognition of the right of priority, enjoy a right of priority. Where, within twelve months from the date on which any applicant first filed in China an application for a patent for invention or utility model, he or it files with the Patent Administration Department Under the State Council an application for a patent for the same subject matter, he or it may enjoy a right of priority.” Rule 7: “Where a time limit prescribed in the Patent Law or these Implementing Regulations or specified by the Patent Administration Department under the State Council is not observed by a party concerned because of force majeure, resulting in loss of his or its rights, he or it may, within two months from the date on which the impediment is removed, at the latest within two years immediately following the expiration of that time limit, state the reasons, together with relevant supporting documents, and request the Patent Administration Department under the State Council to restore his or its rights. Where a time limit prescribed in the Patent Law or these Implementing Regulations or specified by the Patent Administration Department under the State Council is not observed by a party concerned because of any justified reason, resulting in loss of his or its rights, he or it may, within two months from the date of receipt of a notification from the Patent Administration Department under the State Council, state the reasons and request the Patent Administration Department under the State Council to restore his or its rights. Where the party concerned makes a request for an extension of a time limit specified by the Patent Administration Department under the State Council, he or it shall, before the time limit



expires, state the reasons to the Patent Administration Department under the State Council and go through the relevant formalities. The provisions of paragraphs one and two of this Rule shall not be applicable to the time limit referred to in Articles 24, 29, 42 and 62 of the Patent Law.”

*Response by the Czech Republic:* “The current Czech Patent Law No. 527/1990 Coll., as amended, contains provision regarding to the Excusing failure to comply with a time limit (Section 65, (1)): “The Office may excuse failure to comply with a time limit on legitimate grounds (*including “force majeure” circumstances*) if a party to the procedure so requests within two months of the day on which the reason for failure to comply has ceased to exist, provided that the omitted act has been performed within that period and that the administrative fee in accordance with the relevant statutory provisions has been paid.” The Czech practice under Section 65 is relatively generous towards the applicants and the owners. We have no problems with regard to the application of this criteria. The failure to comply with a time limit may be excused at the latest by one year as from the expiration of the period within which the act should have been performed.”

*Response by Denmark:* “We only apply the criteria of due care. We apply the criteria of due care in the context of non-observance of a time limit. We further apply the criteria on the entry into national phase. We do not have an instrument of restoration for reestablishment of priority right, but will have the instrument implemented in our national law within a few months.”

*Response by Estonia:* “There are no provisions in Estonian law concerning the restoration of the right of priority. Therefore the Republic of Estonia has also no practice in a forenamed matter. The provisions concerning the restoration of the right of priority will be included in our amended Patent Act which we expect to come into force in April 1, 2003.”

*Response by the Eurasian Patent Office:* “Yes, the Eurasian Patent Law provides for the application of the criteria of “due care” and “unintentionality” in cases of restoration of rights. According to new Rule 39 of the Patent Regulations under the Eurasian Patent Convention, which is in force as from 01 March, 2002, “rights relating to a Eurasian application or Eurasian patent which have lapsed as a result of the failure to respect the time limits prescribed for performing a particular procedural act may be restored on an appropriate request by the applicant or patent owner where the Eurasian Office considers that the failure to respect the time limit has occurred despite all the measures taken by the applicant or patent owner, which were suitable in the given circumstances, and that the delay was unintentional.” Those provisions are applicable for majority procedures under the Eurasian Patent Law excluding the following time limits: -- filing request for restoration of rights; -- claiming priority right; -- filing certified copy of a previous application; -- payment of the prescribed additional fee for a six-month period of grace for payment annual fee for maintenance of the Eurasian Patent; -- filing a notice of opposition under the administrative revocation of the Eurasian Patent.”

*Response by the European Patent Office:* “The EPC does not, in any of its regulations, refer to the criterion “unintentionality.” For *restitutio in integrum* (re-establishment of rights) under Article 122 EPC “all due care” is required.”

*Response by Finland:* “No, the office applies only the criteria of “due care.”

*Response by France:* “ The legal basis for restoration of rights in France is Articles L.512 -3 and R.512 -12 of the Code on Intellectual Property (CPI) for drawings and industrial designs, Articles L.712 -10 and R.712 -12 for trademarks, and Articles L.612- 16 (delay in meeting time limits), L.613 -22 (defect to payment of annual fee) and R.613 -52 for patents. Any right holder may apply for the restoration of rights in the event a time limit was not respected during the processing of the application at INPI. However, the restoration of the right of priority is currently not envisaged in French law (this will change after ratification of the PLT). While the wording of the different Articles on the restoration of rights is not homogenous, INPI and case law intend to apply identical substantive criteria for all IP rights. The restoration of rights in French law is subordinated to the proof of “impeachment” (“empêchement”) or “legitimate excuse” (“excuse légitime”), namely the rightholder must prove that the event which occurred is not due to his will, fault or negligence. The right holder applying for a “restitutio in integrum” must therefore demonstrate that the unfulfilment of the formality resulting on the loss of rights was not the result of his will but rather the result of circumstances which impeded him to accomplish the formality in spite of his due care (and some form of evidence must be submitted to the Office, such as a medical certificate, a letter between the rightholder and his agent etc.). French law applies therefore in a cumulative manner both criteria of due care and unintentionality. The criteria of unintentionality is not enough on its own.”

*Response by Germany:* “ Under German national law, applicable in procedures before the German Patent and Trade Mark Office, decisions on requests for reinstatement are based on the fault principle. The relevant provisions are contained in Sec. 123 Patent Law, Sec. 91 Trade Mark Law, Sec. 21(1) Utility Model Law, referring to Sec. 123 Patent Law, and in Sec. 10(6) Designs Law, referring to Sec. 123(1) to (5) and (7) Patent Law. Fault encompasses all negligent and intentional acts or omissions. Negligence must be examined according to the criterion of due care. For example, pursuant to Sec. 276(1), 2<sup>nd</sup> sentence, of the German Civil Code (*Bürgerliches Gesetzbuch*), a person acts negligently if he fails to observe the relevant required standards of care.”

*Response by Hungary:* “ The national law applicable by the Hungarian Patent Office in patent procedures and in other industrial property procedures provides for the criterion “without fault.” According to this criterion the request for restoration of rights must state the grounds of failure to comply with a time limit and the circumstances showing that the failure occurred without fault. In our view this criteria corresponds to the criterion “unintentionality.”

*Response by India:* “ As per our National law there is no provision for the restoration of right of priority. However, as a usual practice being followed in the Patent Office, India, under section 135 of the Patents Act, 1970, the restoration of priority is allowed if the same is made within 12 months from the date of filing of the basic application from which priority is claimed for the criteria “unintentionality” or “due care.”

*Response by Indonesia:* “ No, the national law and/or practice does not provide both criteria.”

*Response by Israel:* “ 1. Priority Right lost by failure to file application in priority period. 2. Priority Right lost by failure to file priority claim in time allowed. 3. Rights in international application lost by failure to enter national phase in time allowed. 4. Rights in application lost by failure to reply to Office Action and consequential refusal. 5. Rights in application lost by unauthorised withdrawal of application. 6. Patent Right lost by failure to renew patent in time.”

*Response by Japan:* “ There are some provisions in the Japanese patent law which contain the phrase “due to reasons outside control of the applicant or the owner of the right ” which is considered to be interpreted as similar to but deferent from “due care ” mentioned in your Question 1. Section 112bis(1) of Patent Law (“ Restoration of patent right by late payment of annual fees”): “Where the patent right is one which was deemed to have been extinguished under Section 112(4) or (5) or which was deemed never to have existed under Section 112(6) and the owner of the extinguished patent right is unable to pay an annual fee and surcharge belatedly within the time limit for late payment under Section 112(1) due to reasons outside his control, he may pay the annual fee and surcharge referred to in Section 112(4) to (6) within 14 days (where he is a resident abroad, within two months) from the date on which the reasons ceased to be applicable but not later than six months following the expiration of the said time limit. ” (Ref. “Outline of Industrial Property Systems; JAPAN Patent Law ” <http://www.jpo.go.jp/index.htm>). Section 121(2) of Patent Law (“ Trial against examiner’s decision of refusal”): “Where, due to reasons outside his control, a person is unable to demand a trial under the preceding subsection within the time limit prescribed therein, he may, notwithstanding that subsection, make the demand within 14 days (where he is a resident abroad, within two months) from the date when the reasons ceased to be applicable but not later than six months, following the expiration of the said time limit.” (Ref. “Outline of Industrial Property Systems; JAPAN Patent Law ” <http://www.jpo.go.jp/index.htm>). Section 173(2) of Patent Law (“ Time limit for demand for retrial”): “Where, due to reasons outside his control, a person is unable to demand a retrial within the time limit prescribed in the preceding subsection, he may, notwithstanding that subsection, make the demand within 14 days (where he is a resident abroad, within two months) from the date when the reasons ceased to be applicable but not later than six months following the expiration of the said time limit.” (Ref. “Outline of Industrial Property Systems ; JAPAN Patent Law ” <http://www.jpo.go.jp/index.htm>). Section 4 of the Patent Law Enforcement Order (Section 67bis(3) of Patent Law) (“ Registration of extension of term of patent right”): “ If the application could not be filed within 3 months following the rendered date of the disposition due to reason beyond control of the applicant, the application must be filed within 14 days (where he is a resident abroad, within 2 months) after the extinction of said reason (or within 9 months following the rendered date of the disposition, whichever period expires earlier).” (Ref. “Examination Information; Examination Guidelines for Patent and Utility Model in Japan; Part VI Patent Term Extension” <http://www.jpo.go.jp/index.htm>).”

*Response by the Republic of Korea:* “ Article 16 [Invalidation of Procedure]; (2) When a patent-related procedure has been invalidated under paragraph (1), if the delay of the time is deemed to have been caused by reasons not attributable to a person who received an invitation to amend, the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Tribunal may revoke a disposition of invalidation at the request of a person who received an invitation to amend within fourteen days from the date on which the reasons for the delay ceased to exist. However, this provision shall not apply where one year has elapsed after the designated period expires.” Article 17 [Subsequent Completion of Procedure]: “ If a person who initiated a patent -related procedure has failed to observe the time limit for requesting a retrial under Article 132ter, or the time limit for demanding a retrial under Article 180(1) for reasons not attributable to himself, he may subsequently complete the procedure that he failed to conduct within fourteen days after said reasons cease to exist. However, this provision shall not apply in a case where one year has elapsed after said period expires.” Article 81 bis [Recovery of a patent application or patent right by late payment of the patent fees]: “(1) If a patentee or any person wishing to register a patent right has failed to observe the time limit for late payment of the patent fees under Article 8(1) due to any cause

*not attributable to himself*, he may make late payments of the patent fees within fourteen days after said month has elapsed after said period expires under Article 81(1).”

*Response by the Kyrgyz Republic:* “The Kyrgyz Republic Law provides restoration of the right of priority and of patent procedure and determines different terms depending on particular cases. Particularly, term of restoration of the right of priority is two months since the date of missed term expiry. However, national law does not distinguish the criteria “due care” and “unintentionality” during restoration of applicant’s rights in general and restoration of the right of priority in particular.”

*Response by Latvia:* “Latvian Patent Law (as well as Trademark Law and Designs Law) does not contain such expressions as “due care” or “unintentionality.” Our Patent Law provides for a restoration of rights in cases when patent maintenance fee is not paid in due time or an applicant has not replied to some invitation of examiner or has not paid any procedural fee in due time. These provisions are Article 12(7) and 12(8) of the Patent Law: Art. 12(7): “...The annual maintenance fee must be paid before the beginning of the next year of payment. If the fee has not been paid within due time period, but the patent owner pays it, together with an additional fee, within the following six months, the patent shall be considered as maintained in force.” Art. 12(8): “The terms... may be renewed, if the request for the renewal has been received no later than six months after the expiration of the prescribed term and *there has been due cause for non-observance of the term*. An additional fee must be paid for...renewal of terms.” In practice it is sufficient if a patent owner or an applicant just gives some explanation of non-observance of the terms (for example, he/she has not received a letter from Patent Office, he/she has been in hospital, and the like).”

*Response by Lithuania:* “In practice of our Office, there were no cases for the application of these criteria.”

*Response by Madagascar:* “The expressions “due care” and “unintentionality” do not appear in the national legislation. However, the national legislation states that “any person who cannot respect legal time limits because of “*forcemajeure*” and who, as a result, loses a right related with a patent application or with a patent already granted may ask for the restoration of that right if evidence concerning the failure is furnished.” (Article 33.1 of Ordinance no 89-019 of 31/07/89). “The request for restoration shall be submitted to the Office in written form within a time limit of two months after the end of the “*forcemajeure*”. The request shall be justified and it shall clearly and precisely mention the “*forcemajeure*” which impeded the respect of a time limit under this decree.” (Article 58.1 and 2 of Decree no 92-993 of 02/12/92).”

*Response by Moldova:* “The Republic of Moldova legislation provides for the restoration of applicant/owner rights for every patent procedure (except for withdrawn applications), including for patent restoration in case of non-payment of the prescribed maintenance fee, within six months after the expiration of the failed time limit. This possibility of restoration is applied to every case without any restriction, regardless of the reason for the failure to comply with the time limit. After the expiration of this six month time limit, the national legislation provides the further reinstatement of rights for cases in which the loss of rights occurred in *forcemajeure* circumstances. Such provisions apply to: (a) every case of failure to comply with the time limit for a procedure in respect to an application; (b) in case of failure to comply with the time limit prescribed for payment of the maintenance fee; (c) in case of failure to claim a priority; (d) in case of failure to present a copy of the earlier application (where restoration of the right of priority is sought). As regards points (a) and (b), the

legislation provides the application of both criteria (“due care” and “unintentionality”), as for (c) and (d) - the criteria of “unintentionality.”

*Response by Monaco:* “ Monégasquelawno606onpatentsofinvention,datedJune20,1955, donotmentionthecriterionof“duecare”and“unintentionality”.Inpractice,theDivisionof IntellectualPropertyapplies the criteria of “legitimate excuse” (“excuse légitime”) in order to restore the rights of the owner, for instance in the case of a delay in the payment of annual fees.”

*Response by Mongolia:* “Yes”

*Response by the Netherlands:* “Thenational law of the Netherlands provides only for the criterion of “due care,” but the criterion “due care” implies that the loss of right was not intended. (Intentionally not observing a time limit can never lead to restoration in the Netherlands). Article 23, paragraph 1 of the Patent Act of the Kingdom 1995, states that restoration of rights is only possible if a time limit is not observed “ *despitetakingallduecare requiredbythecircumstances* .” Art. 23 of the Patent Act of the Kingdom 1995, first paragraph reads: “1. If, *despitetakingallduecare* required by the circumstances, the applicant for or proprietor of a patent or the proprietor of a European patent has not been able to observe a time limit with respect to the Office or the office referred to in Article 99 [MvdB industrial property office in the Netherlands Antilles], he shall, at his request, have his rights re-established by the Office, if failure to observe the time limit pursuant to this Act has directly led to the loss of any right or means of redress.” Most frequently, restoration is requested because a patent annuity was (unintentionally) not paid in time, leading to the loss of the patent.”

*Response by New Zealand:* “The criterion of “unintentionality” is provided for in sections 35(1), 36(1) and 37(3) of the New Zealand Patents Act 1953. Section 35 deals with the restoration of lapsed patents, section 36 deals with the restoration of applications for patents that have not been sealed and section 37 deals with the restoration of applications that have not been accepted. The criterion of “unintentionality” is also provided for in our informal process for allowing late entry into national phase. This process is outlined in The Intellectual Property Office of New Zealand Information for Clients No. 8 issue *don* 29 September 1999. The Trade Marks Act, 1953 and Designs Act, 1953 do not contain the criteria of “due care” and/or “unintentionality”. The criterion of “due care” is not provided for in the New Zealand Patents Act 1953. However, the criterion of “ *duediligenceandprudence*” is present in section 93. This section allows the Commissioner of Patents to extend the time for filing a convention application or complete after provisional application provided the applicant has shown *duediligenceandprudence* in their attempt to have the application filed on time.”

*Response by Norway:* “With the exception of time limits for right of priority and the appeal procedure, the applicant for a patent who has failed to comply with a time limit prescribed in or pursuant to the Patent Act and who thereby has suffered loss of right shall, upon request, have his rights restored if he can prove that he or his representative has taken *allduecare* which may reasonably be required. This provision applies correspondingly *to* a patent holder who has not paid the annual fee within the prescribed time limit.”

*Response by the Philippines:* “Pertinent Philippine laws and regulations do not categorically provide for the criteria of “due care” in case of restoration of rights *relativetonationalpatent applications*. On the other hand, the term “unintentional” is mentioned in Rule 306.4 of the Rules and Regulations on Inventions, wherein a priority claim may be submitted even after

the filing of the application provided that it is accompanied by a declaration of the applicant that the delay in the submission was not intentional. Further, in practice, an application that is deemed abandoned and withdrawn may be revived if the reason for failure to prosecute on time is due to fraud, accident, mistake or excusable negligence (Rule 930 Rules and Regulations on Inventions).”

*Response by Poland:* “The new Industrial Property Law (in force since August 22, 2001) provides for two categories of cases of restoration of rights: (a) relief in respect of non-restorable time limits fixed by the statute itself, and (b) relief in respect of time limits fixed by the Patent Office in the course of protection granting proceedings. In respect of non-restorable time limits, the Law provides that in case of failure to observe the time limit, the respective right may be restored provided that relevant proof is furnished by the interested party in evidence that non-observance of the time limit concerned has been caused by an act of God (force majeure). This rule is applicable in particular in respect of the following rights: - for furnishing the original copy of the patent application transmitted by means of fax, which is required for preserving the priority right; - for submitting a request for the extension of the trademark registration for subsequent ten-year periods; - for the payment of the renewal fee for a subsequent protection period; - for submitting a request for restoration of the time limit for payment of the fee concerned. In this category of cases the criterion of “due care” prevails in practice. In respect of time limits fixed by the Patent Office in the course of protection granting proceedings, the respective rights are restorable in case of non-observance of the relevant time-limit, provided that a party provides a plausible explanation that non-observance has been without fault on its part. Although the applied criterion is not expressly named in the above presented provisions of the Polish IPL Law, the criterion that prevails in practice is close to “due care,” rather than to “unintentionality.”

*Response by Portugal:* “At the moment, the Portuguese law has only restoration of rights for late payment of annuities (article 281 -2). As from 1<sup>st</sup> July 2003 the new Portuguese law provides the restoration of rights (article 8) with the application of the criteria of “due care.” This provision doesn’t comprise the restoration of the right of priority.”

*Response by the Russian Federation:* “Our patent law in cases of restoration of rights provides for the application of the criteria of “reasons beyond the applicant’s control” (article 19(2)) and “valid (justifiable) reasons for the delay” (article 21(12)) which are similar to “due care” and “unintentionality” respectively. “For reasons beyond the applicant’s control” - where the applicant claiming Convention priority cannot for reasons beyond the applicant’s control, be filed within 12 months from the filing date of the prior application, the time limit may be extended. “Valid reasons for the delay” - is applied in many cases, for example, for the restoration of rights where the applicant has failed to furnish the additional materials required by the examiner, within the prescribed time limit.”

*Response by Saint Lucia:* “We are presently in the process of completing our Patents Regulations. We therefore have not had any experience in the area in question.”

*Response by Singapore:* “1a. Under our Patents Act and Rules for example, provision on restoration of patent rights are available. 1b. Although the criteria is not “due care”, the term “reasonable care” is applied for restoration of lapsed patent cases. 1c. Please find attached, an extract from our Patents Act and Rules containing our restoration provisions [Section 39, Rules 53 & 53A] and those on extensions of time provisions [Section 110, Rules 100, 108 & 109]. 1d. It would be noted that under our restoration provisions, rule 53A only has an “unintentional” requirement. Rule 53A applies only to a restricted number of cases, which

fell under our transitional provisions when we introduced the revised patents system in 1995. I.e. On extensions of time, there are varying levels of consideration. In general practice, one could say that the “unintentional” test applies, that is to say, the delay or omission was not deliberate. -- The first group of time periods is not extendible. [Rule 108(2)]. -- In the second group of time periods, extensions of time are sought in writing without use of a form or payment of fees. The decision to extend time in this group is discretionary. [Rule 108(1)]. -- The third group of time periods are extendible if extensions have not been granted previously, and that the request for extensions is made within the period for which extension is sought and that extensions sought does not exceed 3 months. Such extensions are granted as soon as the relevant forms and fees are paid. [Rule 108(3)]. -- The fourth group of time periods is related to the time periods mentioned in the third group. The fourth group applies when the conditions in the third group are not met. In such cases, the Registrar may ask the Applicants would to furnish a statutory declaration or affidavit to support this extension request, over and above the filing of the form and fees. The decision to extend time in this group is discretionary. [Rule 108(4) to (6)].”

*Response by the Slovak Republic* : “The Industrial Property Office of the Slovak Republic, in cases of restoration of the right of priority, applies only criteria “due care”. Act No. 435/2001 Coll. on Patents, Supplementary Protection Certificates and on Amendment of Some Acts (The Patent Law) explains application of the criteria “due care” in Article 36, paragraph 5.”

*Response by Slovenia*: “The criterion of “due care” is used in Article 68 of Industrial Property Act (Official Gazette RS, No. 45/01 and 96/02), hereinafter referred to as IPA on restitution in integrum. Paragraph (1) states that a party to the proceedings before the Office who, in spite of all due care required by the circumstances having been taken, was unable to observe any time limit set out for the obligations required by the Office in accordance with IPA and the executive regulations issued pursuant to IPA, may request, on the basis of justifiable reasons, to have his rights re-established if then non-observance had the consequence of causing the deeming of the application, or of any request, to have been withdrawn, or the rejection or refusal, or the loss of the right. The provisions of this Article follow the provisions of Article 122 of the European Patent Convention”.

*Response by Spain*: “Article 25 of the Law 17/2001, December, 7, on Trademarks, provides only for the application of the DUECARE criteria. This Article is also applicable to patents. Nevertheless, the right of priority is excluded of restoration of rights.”

*Response by Sweden*: “Yes, only due care. All due care required by the circumstances has to be observed by the patent holder or the applicant and by the agents involved.”

*Response by Turkey* : “Partially Yes, our national law provides non-payment of the yearly annuities for reasons of Force Majeure for the reinstatement of the rights under Article 134. “Article 134: Where a patent right terminates for non-payment of yearly annuities; with the holder of the patent bringing evidence of force majeure for reasons of which the said fee could not be paid, the patents shall be revalidated. The claim related to force majeure shall be put forward within six months as from the publication, in the bulletin, of the announcement pertaining to the termination of the patent right. The patentee’s claim related to force majeure is published in the bulletin. The parties interested may express their observations on the matter within one month as from the date of publication. The patents shall be revalidated upon the decision of the Institute. The revalidation of a patent shall not affect the acquired rights of third parties who have secured such rights as a result of the termination of the patent right. The rights of third parties and the scope of such rights shall be determined by the court.

Where a patent is revalidated, the holder of the patent shall be obliged to pay the fees he failed to pay and the additional fees.”

*Response by the United Kingdom:* “We do not apply the criteria of “due care” though we do apply the criteria of “reasonable care” in the cases of applications to restore patents which have ceased because of a failure to pay a renewal fee. Section 28(3) of the Patents Act 1977 provides: “If the comptroller is satisfied that the proprietor of the patent took reasonable care to see that any renewal fee was paid within the prescribed period or that that fee and any prescribed additional fee were paid within the six months immediately following the end of that period the comptroller shall by order restore the patent on payment of any unpaid renewal fee and any prescribed additional fee.” We have no specific provisions in our law which provides for the restoration of a patent application. However, rule 110(4) of the Patents Rules 1995 allows the Comptroller to extend certain times or periods prescribed in our patents rules for doing an act or taking any proceedings. Where an application has been treated as withdrawn because of a failure to meet such a time or period, and the Comptroller agrees to extend that time or period, the application will be reinstated provided the applicant completes the required action within the time or period so extended. Rule 110(4) allows the Comptroller to extend a time or period if she “thinks fit.” Therefore she has wide discretion to apply whatever criteria she wishes. In practice, when assessing extension requests under the rule it has been our policy to allow such requests if we are satisfied that the applicant had a “continuing underlying intention” to proceed with the application. This principle is based on precedent established in an Office decision on an earlier extension request and is similar to the criteria of “unintentionality.”

*Response by the United States of America:* “Yes. The national law and practice of the United States provides for the application of the criteria of “due care” and/or “unintentionality” in certain cases involving restoration of rights. U.S. statutory law expressly provides for the application of the criterion “unintentionality” with regard to the restoration of rights involving: A. *patent applications* that have become abandoned for failure to timely submit: 1) a proper reply to an outstanding Office action or notice (35 U.S.C. 41(a)(7)); 2) payment of the issue or publication fee (35 U.S.C. 41(a)(7)); 3) notification of a filing in a foreign country or under a multilateral international agreement subsequent to the submission of a non-publication request (35 U.S.C. 122(b)(2)(B)(iii)). B. *patents* that have expired for failure to timely pay the maintenance fee (35 U.S.C. 41(c)(1)). C. *reexamination proceedings* that were terminated for failure to timely file a proper response (35 U.S.C. 41(a)(9)). U.S. statutes also provide for restoration of rights caused by “unavoidable delay” in the cases identified above (with the exception of the failure to timely submit the notifications specified in A.3). 35 U.S.C. 41(c)(1), 133 and 151. Though the criterion of “due care” is not expressly identified in these statutes, a consideration of “due care” is relevant to the determination of whether a delay was “unavoidable” within the meaning of the statutes, as further explained in the Response to Question 2.”

Question 2: (only applicable if the answer to question 1 is “yes”): What does “due care” and/or “unintentionality” mean under the national law and/or practice applicable by your Office?

*Response by Australia:* “Section 223(2)(a) (“error or omission”) perhaps equates closest to “unintentionality” whereas section 223(2)(b) (“circumstances beyond the control of the person concerned”) and section 223(2A) (“due care”) possibly equate to “due care”. Deliberation or mistake in judgment fall within the scope of 223. An error or omission may



include a breakdown in procedure or a failure to exercise due diligence. Delays by post and courier constitute the major source of extensions under section 223(2)(b) (“circumstances beyond the control of the person concerned”). In some situations sickness or accidents satisfy the requirement of this paragraph, e.g. if an applicant prosecuting his or her own case becomes ill, the probability is that he or she would be entitled to an extension. On the other hand, if a technical assistant to a firm of Attorneys missed a time limit owing to an illness, it would be expected that the firm would have made arrangements accordingly, in anticipation of this kind of occurrence. If not, it would appear that where an error or omission might be involved, circumstances beyond control would not. In effect, section 223(2)(b) is a “*force majeure*” provision. A “*force majeure*” is outside the control of the person concerned and something that could not have been avoided by that person’s exercise of due care. A particular issue here is the effect of Bankruptcy. A sequestration order is made as the culmination of a sequence of events which the applicant could have avoided with the exercise of due care – consequently becoming bankrupt is not a circumstance beyond control within the meaning of section 223. Subsection 223(2A) (“due care”) brings the Patents Act into compliance with Article 12 of the PLT. This subsection provides that where, despite the due care of the person concerned, a relevant act is not done within time, and the person files an application for an extension of time within the prescribed period, the Commissioner must extend the time for doing the act. Unlike subsections 223(2)(a) or 2(b), there is no discretionary power to be exercised. Also the time for doing a relevant act can only be extended under subsection 223(2A) after the time period has expired. Subsection 223(2A) is only applicable in limited circumstances. It is of narrower scope than the provisions of subsection 223(2)(a). Extensions of time under subsection 223(2A) would only arise where the person concerned had appropriate systems in place and did everything that could reasonably be expected to ensure the relevant act was done and despite that, a relevant act was not done in time. A reasonable enquiry is whether the systems or mechanisms put in place were appropriate to ensure the relevant act was performed in time. If the person concerned did not have adequate systems in place or had not done everything reasonably possible to ensure the relevant act was done in time, an extension under section 223(2A) would not be appropriate. To date, there have been no applications for extensions under section 223(2A), and no judicial interpretation of the meaning of “due care” in this provision.”

*Response by Austria:* “Due care means that a person is prevented by an unforeseeable or unavoidable event from observing a time limit.”

*Response by Bulgaria:* “Under the national law and practice the Patent Office reinstates the rights of the applicant if he was unable to observe the time limit in spite of all due care reasonably required by the circumstances that were unforeseen and accidental. These circumstances have to be an obstacle that could be not foreseen by the applicant.”

*Response by Denmark:* “Due care: The non-observance of a time limit vis-à-vis the Patent Authority prescribed by or provided for in our law, that causes a loss of right to an applicant who has taken all due care reasonably required. The claim for restoration can normally only be accepted when it is well documented that full reliable office routines are set in place and these routines are being handled by qualified staff and a double checking system are set in place. Then non-observance of a time limit is caused by a human mistake in spite of the system set in place.”

*Response by the Eurasian Patent Office:* “In view of deficiency of practice for application of the two criteria the EAPO exercise “healthy commonsense” in determination whether or not the required care has been exercised and non-observance of a time limit was unintentional.

Now, in any case at filing request for restoration of right by the applicant, the EAPO requires to submit a proof that non-observance of a time limit was caused in spite of all measures taken by the applicant and/or indicate a cause of non-observance of a time limit in the case of application of criteria “unintentionality”. Where the EAPO finds that all measures taken by the applicant took place actually and/or the cause of non-observance of the time limit was not dependant on the applicant, the rights will be restored.”

*Response by the European Patent Office:* “it is believed that there is no difference between “due care” “all due care”. No definition of the criterion “all due care” is provided in the European Patent Convention or its Implementing Regulations. It follows that the interpretation of its criterion is based on board of appeal case law. The case law has established that all due care is considered to have been taken if non-compliance with the time limit results either from exceptional and unforeseen circumstances or from an isolated mistake within a normally satisfactory monitoring system. A mistake of law, particularly one regarding the provisions on notification and calculation of time limits, does not, as a general rule, constitute grounds for establishment of rights.”

*Response by France:* “ Unintentionality: The procedure of restoration of rights should not be considered as a right of repentance for the rightholder who intended to abandon his right and to recover it after the end of the required time limit. The unfulfilment of a formality within the required time limit by a rightholder resulting in the loss of his right cannot benefit from the procedure of restoration of rights when such an action was made on purpose. For instance, a firm holding a patent and assisted by a patent agent decides not to pay its annual fee because it cannot exploit that patent. That firm will not be in a position to apply for the restoration of its right because it could find a licensee after the end of the time limit for payment of the annual fee. The Office would always examine all elements of evidence submitted to it in order to turn down any possible unintentionality. When the Office is convinced that the rightholder did not want to abandon his right, it will then examine if he acted in due care so as to impede the loss of the right. Due care: The statement over the circumstances which resulted with the unaccomplishment of the time limit must prove that the rightholder has taken all necessary steps to rightly manage his right: --if the rightholder asks another person to manage his right, such a person should be a professional (patent agent, lawyer, industrial property unit of a firm) and the rightholder must have given that person the ability to properly fulfil his duties. The Office requires then some evidence concerning the profession of the person in charge of managing the right and who is alleged to be responsible for the default. That person should be able to present his comments on the matter. A default committed by an agent who is not professional or by an agent working for the rightholder when this one is a firm could not be considered by the Office as “excuse légitime” if there is not also proven that the said person had some competence in the field of industrial property. On the other hand, the Office could consider as an “excuse légitime” the fact that a patent agent committed a default when carrying on his tasks on the ground of internal reorganization. --if the rightholder manages himself her/his right, the Office would examine the particular circumstances of the case and would dismiss any evidence of undue care. For instance, the inventor who manages his right alone could invoke her/his health problems (submission of a medical or hospital certificate required) as an “excuse légitime.” On the contrary, the Office would dismiss the restoration of the right if the rightholder says she was on holidays or that she did not know about the time limit for payment of the annual fee. ”

*Response by Germany:* “The standard applied to the due care requirement is the customary diligence which a prudent party to the procedure would have exercised in the concrete individual case. In this context, the following must be considered: -- The nature of the

defaulting party (The degree of strictness of requirements depends on whether the party is an individual applicant, the patent department of a big company or an attorney. The degree of diligence required is based on the diligence that may objectively be expected from a comparable prudent person in the individual case.) -- All circumstances of the case. In this connection, the fault principle applies (as explained in respect of question 1). This means that the defaulting party must prove that the non-observance of the time limit occurred despite exercise of due care."

*Response by Hungary:* "The Hungarian national law does not define the criterion "without fault," so it depends on the discretion of the Office to judge in the particular case whether the failure occurred without fault. The criterion "without fault" means under the practice of the Hungarian Patent Office that if the grounds and circumstances stated in the request for restoration of rights are made likely and provided that these are considered to be justifiable, the request is admissible."

*Response by India:* "There is no specific provision. Applicant is required to prove that he has taken "due care" and the omission is unintentional."

*Response by Israel:* "The above terms as such do not appear in the Israel Patent Law. Each procedure for restoration of rights has its own criteria defined by law or practice (see Q.4 below)."

*Response by Japan:* "While the Japanese industrial property laws do not provide for either of those criteria as explained above, under them, the criterion of "reasons outside control of the applicant or the owner of the right" has been interpreted as follows. (a) Objective reasons such as natural disasters (e.g.: damage on a house/building due to a big earthquake, flood, heavy snow, or destructive storm; disconnected communication lines; and block on transportation). (b) The prescribed procedure was not carried out in spite of the due care provided by the party concerned who has a normal level of alertness (e.g. serious diseases; destruction of documents by fire; and unexpected errors in the mailing service)."

*Response by the Republic of Korea:* "The KIPO does not use the same terminology as "due care" or "unintentionality" to recover a patent right or a patent procedure. However, I think that the KIPO also applies a similar principle with "due care" as shown at Question 1 in cases of restoration of any patent-related procedure or rights. It will be set forth at Question 4 in detail."

*Response by the Republic of Moldova:* "The national legislation allows the possibility of restoration of the rights in *force majeure* situations as from August 2001, after the ratification by the Republic of Moldova of the PLT. For the time being, the legislation does not define the criteria of "due care" and "unintentionality," each case being examined and treated individually."

*Response by Monaco:* "The term "legitimate excuse" means any serious impediment, independent from the will of the patent owner, which impeded that owner to proceed with the required formalities ("force majeure", legal, financial or administrative obstacles, mistake by the agent, etc.)."

*Response by Mongolia:* "The criteria "due care" is used in accordance with Article 26(4) of the Patent Law of Mongolia."

*Response by the Netherlands*: “Due care” or more specific “despite taking all due care required by the circumstances” means that: --the patentee, or third persons deployed by him, keeps his own administration of time limits which have to be respected; --within this administration, time limits have to be cross-checked independently. This cross-check must be built in the administrative system, because even well educated, properly trained and accurately working personnel/staff can sometimes make a mistake; --the letters of the Office, reminding that a time limit is due, are legally treated as a non-binding, free service. It is not considered a valid argument if the patentee claims that the reminder of the Office did not reach him. These letters are sent by regular mail, so it is not 100% guaranteed that the letter arrives at the address of the patentee.”

*Response by New Zealand*: “Unintentionality not done or made or performed with purpose or intent. Due diligence and prudence –rightful, earnest and constant effort and caution with regard to practical matters.”

*Response by Norway*: “The interpretation of the conception “due care” is rather strict regarding the attention shown by the applicant and/or his representative.”

*Response by the Philippines*: “Since the rule does not define “unintentionality”, the same must be taken in its ordinary context. Hence, it contemplates that the delay is not willful or deliberate. The criteria of fraud, accident or excusable negligence under Rule 930 may be used to determine whether or not the delay is unintentional.”

*Response by Poland*: “Due care” means that in case of failure to observe a time limit the applicant is expected to show his not being at fault or that he has not acted negligently. In case of non-restorable time limits the applicant is supposed to produce evidence that non-observance of the time limit was caused by exceptional occurrences, which were unpredictable and unavoidable in the circumstances, and incapable of being remedied with any available means. In case of restorable time limits the applicant is not expected to provide any evidence showing his not being at fault, but only to make plausible the occurrence of the factors or circumstances that prevented him from observing the time limit. “Unintentionality” does not involve any need for the applicant to produce evidence or make the facts plausible. What suffices is his statement of his inability to observe the time limit.”

*Response by the Russian Federation*: “for reasons beyond the applicant’s control:” - emergency, force majeure - natural disasters, hostilities, irregularities in the mail service etc. “valid reasons for the delay:” - various reasons such as an applicant’s disease, his business trip, loss of the documents, deficiency in the work of technical service etc.”

*Response by Singapore*: “2a. These terms “due care,” “reasonable care” and/or “unintentionality” are not specifically defined in our Patents Act and Rules. However, since the UK Patents Act also contains a similar requirement in its restoration provisions [UK Section 28], the law and practice in UK on the term “reasonable care,” would be persuasive but they are not binding. 2b. On “unintentionality,” one would refer to the ordinary meaning of the word in the absence of any express statutory definitions or precedents, i.e. not deliberate.”

*Response by the Slovak Republic*: “Under the national law the term “due care” means such action of the applicant whom (in spite of his effort) the impartial facts (such as illness, irregularities in the mail service, failure of electronic means and soon) avoided perform the act with the Office in prescribed time limit.”

*Response by Slovenia:* “The criterion of “due care” is considered in the light of each individual case of non-compliance with the time limit, taking into account specific circumstances of the case. A general definition of that term would be “an appropriate care that should be taken under circumstances of the case by a person who is on average reasonably capable applicant/owner or professional representative.”

*Response by Spain:* “ ‘Due care’ means that the applicant or the owner must act with the reasonable vigilance under the circumstances, and this is something that must be proved accurately.”

*Response by Sweden:* “All due care has been observed if the responsible person has made arrangements in good time to perform the omitted act at the Patent Office within the prescribed time limit. However, an unexpected event has prevented him from performing this act in time. An example of such an event is a sudden illness. An isolated mistake by a person at a patent agency with a well-functioning system can be accepted if this person is carefully trained and supervised by the agent.”

*Response by the United Kingdom:* “ *Reasonable Care* ” – This term is not defined in our patents legislation (i.e. The Patents Act 1977 and The Patents Rules 1995). In determining whether a patentee has taken reasonable care, the Office looks to key principles and precedents set in decisions on past cases, particularly decisions by the Patents Court on appeals against Office decisions, such decisions being binding on us. The following is a summary of the key precedents we rely on. (a) The words “reasonable care” do not need explanation. The standard is that required of the particular patentee acting reasonably in ensuring that the fee is paid. (b) A patent is a valuable item of property and a proprietor is, therefore, expected to set up a payments system which contains more safeguards than would be needed to ensure the payment of an ordinary commercial debt. (c) In delegating responsibility to an employee to pay renewal fees, a proprietor must ensure that that employee is properly trained and issued with clear instructions. Where a competent, experienced and reliable employee fails to pay a renewal fee the proprietor should not be held to have failed to have taken reasonable care. However, it has been held that a failure by a senior employee (the “directing mind”), with overall responsibility for maintaining patents in force, would constitute a failure to take reasonable care. (d) If a patentee places responsibility for paying renewal fees in the hands of a professional body such as a patent agency or an annuity paying agency, an error by that body, which resulted in a renewal fee not being paid, would not constitute a failure by the proprietor to take reasonable care, provided the proprietor did not contribute to the failure. (e) If a proprietor fails to receive a renewal reminder from his agent or this Office because he did not provide the agent or this Office with an up-to-date address then that would constitute a failure to take reasonable care on the part of the proprietor. (f) Where a proprietor is prevented from paying a renewal fee because of ill health then he would not be regarded as failing to take reasonable care though severe mental strain or being physically run down would not be a sufficient basis for allowing restoration. (g) If a proprietor took a conscious decision to abandon a patent and then changed his mind after it had ceased it would not be possible to claim that he took reasonable care to pay the renewal fee. (h) Lack of funds to pay a renewal fee would not necessarily preclude restoration so long as the proprietor could demonstrate that he intended to pay the fee, attempted to avoid impecuniosity, made diligent efforts to obtain financial assistance and was prevented from paying due to circumstances beyond his control. “ *Continuing Underlying Intention* ” – The precedent case, referred to above, is *Heatex Group Ltd’s Application*. A copy of the decision issued on that case is attached. Unlike decisions of the Courts, the views expressed by the Hearing Officer are not binding on the Office. Nevertheless, the Hearing Officer’s comment

that for discretion to be exercised in the applicant's favour there must have been a "continuing underlying intention" to proceed with his application is considered a forceful principle which has been applied in subsequent cases when determining whether to allow extension requests. In his decision the Hearing officer held that to allow an extension on the basis of a change of mind by the applicant would be a massive assault on public certainty which should be resisted. Moreover, if extensions were allowed, where there had been a change of mind, it would not be clear when it would be appropriate to exercise discretion against an applicant."

*Response by the United States of America:* "I. "unintentionality" "Unintentionality" is a criterion applied pursuant to U.S. statutes in determining whether the delay in submitting a required submission that resulted in abandonment of a patent application, expiration or lapse of a patent, or termination of a reexamination proceeding will be excused and rights restored. Delay resulting from a deliberately chosen course of action on the part of the applicant or patent owner is not an "unintentional" delay within the meaning of the statutes. See MPEP 711.03(c). Where, for example, an applicant deliberately permits an application to become abandoned (e.g., due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional." See *In re Application of G.*, 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989). Moreover, an intentional course of action is not rendered unintentional when, upon reconsideration, the applicant changes his or her mind as to the course of action that should have been taken. See *In re Maldague*, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988). Additionally, the entire delay must be unintentional. This requires not only that the delay in submitting the required submission that resulted in the abandonment, lapse or termination was unintentional, but also that the delay in filing the initial petition to restore the patent rights was unintentional and that any delay in filing a grantable petition was unintentional. See MPEP 711.03(C). II. "Due care". As indicated in the Response to question 1, "due care" is not an express requirement of U.S. statutes dealing with restoration of rights, but it is considered under U.S. national law and practice in determining whether a delay in submitting a required reply was "unavoidable" within the meaning of the statutes. The criterion of "due care" is also set forth in a U.S. regulation concerning acceptance of a late payment of the maintenance fee. (37 CFR 1.378(b)(3) requires, inter alia, "a showing that the delay was unavoidable since *reasonable care* was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patente was notified of, or otherwise became aware of, the expiration of the patent."). U.S. courts have adopted the "reasonably prudent person" standard in determining if a delay in submitting the required reply was unavoidable: *The word unavoidable.... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.* *In re Mattullath*, 38 App. D.C. 497, 514 -15 (1912) "Due care" is generally defined as "that care which an ordinary prudent person would have exercised under the same or similar circumstances". See *Black's Law Dictionary*, 6<sup>th</sup> Ed., 1990. In the light of *Mattullath*, "due care", for the purposes of establishing "unavoidable" delay under restorative patent statutes, means that degree of care that is generally used and observed by prudent and careful persons in relation to their most important business. Thus for example, a delay resulting from

an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that (A) the error was the cause of the delay; (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and (C) the employee was sufficiently trained and experienced with regard to the function and a routine for its performance that reliance upon such employee represented the exercise of due care. See In re Egbers, 6 USPQ2d 1869, 1872 (Comm'r Pat 1988), *rev'd on other grounds subnom.*, Theodor Groz & Sohne & Emst Bechert Nadelfabrik KG v. Quigg, 10 USPQ2d 1787 (D.D.C. 1988); In re Katrapat, 6 USPQ2d 1863, 1867-68 (Comm'r Pat. 1988). Or, for example, where an application becomes abandoned as a consequence of a change of correspondence address (the Office action being mailed to the old, incorrect address and failing to reach the applicant in sufficient time to permit a timely reply) an adequate showing of "unavoidable" delay will require a showing that due care was taken to adhere to the requirement for prompt notification in each concerned application of the change of address, and must include an adequate showing that a timely notification of the change of address was filed in the application concerned, and in a manner reasonably calculated to call attention to the fact that it was a notification of a change of address. See MPEP 711.03(c). Delay resulting from the lack of knowledge or improper application of the patent statutes, rules of practice or the MPEP, does not constitute "unavoidable" delay. See Haines, 673 F. Supp. at 317, 5 USPQ2d at 1132; Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

Question 3: (only applicable if the answer to question 1 is "yes"): If both criteria are being applied under the national law and/or practice applicable by your Office, what are the differences between the two criteria?

Response by Australia: "There is some overlap between the various provisions for extension of time. However, in many cases the circumstances fit one criterion and not the others. The "error or omission" or "unintentionality" criteria basically allow for an extension of time where there has been an error or omission affecting the carrying out of the parties' intentions. An error or omission includes a breakdown in procedure or a failure to exercise due diligence. For example, a party may have a diary or watching system in place to monitor due dates. That system may be inadequate or flawed, resulting in a failure to perform an action in the required time. An extension would be allowable as the result of an error or omission arising from the inadequate system, but the party could not be said to have exercised due care in implementing or using such a system. Similarly, it would not be circumstances beyond the person's control. The "error or omission" provisions also allow for extensions where there has been a failure to perform an act within time due to a lack of knowledge or unfamiliarity with the system. For example, infrequent users of the system may have the intention of doing the act but do not realise it has to be done within a certain time. Similarly, errors may arise where other countries have different provisions for doing an act. For example, under Australian law in relation to micro-organism deposits, the specification must include the name of the depository and accession number before the specification becomes open to public inspection. This is different to some other jurisdictions which sometimes result in errors. These errors are unlikely to satisfy the requirements for "circumstances beyond control" or "due care", but may be grounds for an extension under "error or omission". Sometimes, the circumstances leading to the original failure to do something may satisfy either the "error or omission" provisions or the "circumstances beyond control" or "due care" provisions.

However, where due care is exercised it would be expected that the problem would be discovered and remedied soon rather than later. Therefore, while either provision would lead to an extension being granted, the length of the extension allowable may be different depending on the provisions. The provisions of “circumstances beyond control” (section 223(2)(b)) and “due care” (section 223(2A)), although having significant overlap, also include significant differences. The “due care” provisions include time limits within which the extension must be applied for and limits on the length of the extension. The “due care” provisions may be used to extend time only after the time has expired, whereas the time may be extended either before or after the time has expired for the other provisions. Further, where the requirements for an extension under “due care” have been satisfied, an extension is mandatory, whereas under “error or omission” or “circumstances beyond control”, the Commissioner retains a discretion to grant an extension. Such a discretion would generally only be exercised adversely to the person if they had not taken steps to rectify the problem in a reasonable time frame, had not acted in good faith or some other public interest outweighed the reasons for granting the extension. In balancing the factors involved when exercising a discretion, the Commissioner proceeds on the basis that it is more important to consider the consequences of extending or refusing to extend time than to debate the reasons why the act was not done in time.”

*Response by the Eurasian Patent Office:* “The EAPO applies the two criteria. The differences between the criteria consist in the following: “*due care*” – In this case the applicant should submit a proof that he exercised all due care for observance of a time limit. For example, rights will be restored where error was caused by procedural mistake within a normally operated administrative system. “*unintentionality*” – The applicant should indicate a cause of non-observance of a time limit and the cause should not depend on the applicant. For example, irregularities in the mail service.”

*Response by France:* “Both criteria are cumulative in the French procedure for restoration of rights. The rightholder who had the will to keep his rights but who has not shown that he was vigilant enough will not obtain the restoration of his rights (e.g. the trademark owner who asked another person to do the renewal of the annual fee on his behalf will not be able to ask for the restoration of his rights on the sole ground that the person made a mistake or forgot about it). The lack of intentionality will not be enough.”

*Response by India:* “Due care should prove that the applicant has taken all possible care to claim priority and unintentionality should establish that without the priority claim the applicant will suffer hardship.”

*Response by Israel:* “The answers are numbered according to the answers to Question 1.  
1. Applicant must convince the Commissioner that the failure to file the application in time was due to circumstances which were beyond the control of the applicant or his agent, or were unpreventable (Law).  
2. Applicant must convince the Commissioner that the failure to file the priority claim in time was due to a bona fide mistake (Law).  
3. Applicant must convince the Commissioner that the failure to enter the national phase in time was due to circumstances that were beyond the control of the applicant or his agent, or were unpreventable (Practice based on law under item 1).  
4. Applicant must show that he did not intend to withdraw or abandon the application and that there was good reason for the failure to reply. (Practice).  
5. Applicant must show that the withdrawal was made illegally, e.g. without authorization. (Law).  
6. Applicant must convince the Commissioner that there was a reasonable cause for the failure to renew in time, that the applicant did not intend that the patents should lapse and that the application for restoration was made as soon as possible after the non-renewal was



discovered (Law). Items 1-3 are close to the criteria of “due care”, and the Commissioner may apply his discretion to interpret the law accordingly. Items 4-6 are close to “unintentionality.”

*Response by the Republic of Moldova:* “As the clear definitions of both criteria are not given in our legislation, the strict rules of application of one or other criteria do not exist too. However, the practices show that the principle “unintentionality” can be treated as having a larger meaning and can be more easily applied. In future we intend to confine to the criterion of “unintentionality,” because in this case the applicant/owners shall only provide evidence certifying the *forcemajeure* situation, while in case of application of “due care” criterion, it would be necessary to provide documents in support of the action taken by the applicant/owner to remove the reason of failure to comply with the time limit.”

*Response by the Netherlands:* “The criterion “unintentionally” is not used in the Netherlands. Therefore, the question does not apply to the situation in the Netherlands, although, “due care” implies that the loss of right was “unintentionally”.

*Response by New Zealand:* “Unintentionality describes the intent or lack thereof of the person concerned to perform a specific task. The intent of the person to perform the required action in the action under consideration, rather than the quality or manner in which the task itself was carried out. Due diligence and prudence on the other hand is a direct reference to the manner in which a task was carried out, and can be determined by consideration of the actions of the concerned party.”

*Response by Norway:* “In accordance with the Norwegian Patent Act, the possibility of restoration of right is restricted to cases of exceeded time limits in spite of all due care taken.”

*Response by the Russian Federation:* “For reasons beyond the applicant’s control” is applied only to cases mentioned in question 1 (convention priority). The office can demand a documentary evidence of such reasons; no fee is required. “Valid reasons for the delay” is applied in many cases; no documentary evidence is required, the applicants should pay a prescribed fee.”

*Response by Singapore:* “3a. One could consider the term “reasonable care” to require a higher degree of care to be taken as opposed to the term “unintentional” which requires a lower degree of care. 3b. On “unintentionality”, one needs only to show that the delay or omission to meet the deadline was not a deliberate act.”

*Response by the United Kingdom:* “The differences between the two criteria should be apparent from the answer to question 2. The standard of “reasonable care” is a stricter test than “continuing underlying intention.” This can be illustrated by taking the example where an applicant relies on reminders from his agent to pay patent renewal fees but fails to inform his agent of a change of address. As a consequence he does not receive the reminders and the fee remains unpaid and the patent lapses. In applying the criteria of reasonable care we would probably refuse to restore the patent on the grounds that the applicant failed to take reasonable care to ensure that his agent was provided with an up-to-date address. However, provided the applicant could show that, despite his failure to tell the agent that he had changed his address, he always intended maintaining his patent in force we would probably allow the request based on the criteria of “continuing underlying intention.” An example of when a request for an extension of time, using the “continuing underlying intention” criteria, is likely to be refused

is where there is clear evidence that the applicant took a conscious decision to abandon a patent but later decided to try and restore it after he realized that it may have commercial value. Also, where a considerable period of time has elapsed since the expiry of a prescribed time it is difficult for an applicant to prove that he had a continuing underlying intention to pursue the application. The fact that the “reasonable care” test is tougher than the “continual underlying intention” test is reflected in the fact that around 80% of the requests were received to restore patents, which is based on the “reasonable care” test, are allowed while over 95% of applications were received to extend time limits, which is based on “continuing underlying intention”, are allowed. It is also worth noting that in the case of restoring patents under section 28(3) of the Patents Act 1977, section 28A provides for protection against infringement action for third parties whom they may have taken steps to work the invention covered by a patent after the patent had been announced as ceased following a failure to pay a renewal fee. No such provision is included in the Act or the Rules to cover third parties in situations where an application for a patent has ceased due to a failure by the applicant to meet a time period. However, when reinstating such patents following the exercise of discretion to extend the time period it is the Office's practice to impose similar terms to those contained in section 28A to protect the interests of third parties.”

*Response by the United States of America:* “Unintentionality” is subjective, as it depends upon the state of mind of the person whose delay is relevant (e.g., the applicant or patent owner). “Due care,” on the other hand, is objective, as it is measured against care that would have been exercised by the “reasonably prudent person.” With regard to “unintentionality”, the Office will, in most cases, accept the relevant person’s statement that the entire delay was unintentional as sufficient, unless facts of record suggest otherwise. This is because the person presenting such a statement to the Office has a duty of candor and good faith, and is obligated to inquire into the underlying facts and circumstances before presenting such a statement to the Office. See CFR 10.18. In addition, providing an appropriate statement may have an adverse effect when attempting to enforce the patent. See Lumenyte Int’l Corp. v. Cable Lite Corp., Nos. 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 3839 27 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional). “Due care”, on the other hand, requires a showing that the care actually exercised rose to the level of care that would have been exercised by the reasonably prudent person. This showing requires the applicant or patent owner to produce greater evidence than is required in the case of “unintentionality”. Thus, for example, a showing of an unavoidable delay in the case of a docketing error will require, *inter alia*: (1) evidence concerning the procedures in place that should have avoided the error resulting in delay; (2) evidence concerning the training and experience of the persons responsible for the error; and (3) copies of any applicable docketing records to show that the error was in fact the cause of the delay. See MPEP § 711.03(c)(2). Or, for example, where an unavoidable delay in submitting the maintenance fee is alleged, MPEP 2590 instructs that “an adequate showing requires a statement by all persons with direct knowledge of the delay, setting forth the facts as they know them. Copies of all documentary evidence referred to in statements should be furnished as exhibits to the statement.

Question 4: (only applicable if the answer to question 1 is “yes”): Do guidelines exist which further define the two criteria and explain how to apply them? If so, please reproduce the guidelines here or attach a copy to this questionnaire.

*Response by Australia:* “Guidelines are set out in Part 26 of the Australian Patent Office Manual of Practice and Procedure, Volume 3.” These guidelines are currently being reviewed and updated.”

*Response by Austria:* “No guidelines exist which further define the criterion “due care.”

*Response by Bulgaria:* “There is no guidelines for definition of the criterion, the general principles of Civil Law are applied.”

*Response by Denmark:* “According to our guidelines there are two steps in the application procedure. 1. The application for restoration has to be sent to the patent office within two months after the patent owner has realized that the patent has lapsed. If the two months period has not been respected the application for restoration will not be examined and the restoration will be refused. 2. If that deadline is respected the application for restoration will be examined from the principle of due care.”

*Response by the European Patent Office:* “Some information regarding re-establishment of rights is provided in the Guidelines for Examination in the EPO (E - V 111, 2.2.1, Annex 1). Here, it is mentioned that the applicant or proprietor must supply evidence that the delay was caused by unforeseeable factors. The Guidelines further refer to decision D6/82 stating that errors of law do not constitute grounds for re-establishment of rights (see Question 2). The case law of the boards of appeal may be considered as guidelines in a broader sense, as the first instance bases its practice on this case law. No further guidelines on the application of Article 122 EPC are available.”

*Response by France:* “ Guidelines on the processing of patent applications made up of case law and administrative practice at INPI contain principles on the procedure of restoration of rights.”

*Response by Germany:* “There are no internal guidelines or provisions. The approach of the German Patent and Trade Mark Office is oriented on the legal provisions and extensive case law.”

*Response by India:* “No such guideline is available. Matter is decided on case to case basis.”

*Response by the Republic of Korea:* “The guideline for formality examination of a patent application prepared by the KIPO and written with Korean language defines that “reasons not imputable to a person who received an invitation to amend” include the situations like by a natural disaster or other unavoidable circumstances despite ordinary people’s due care. And it shows some examples such as the notification of invalidation transmitted to inappropriate persons are recoverable and an unawareness of public notification as an irrecoverable case.”

*Response by the Republic of Moldova:* “ As it was mentioned above, the legislation does not give any definition of the criteria thereof. However, the Regulations on the Application of the Law on Patents for Inventions contain provisions for reinstatement of rights, particularly in regard of presentation of reasons and proofs.”

*Response by Monaco:* “No guideline was ever prepared as to the definition and implementation of the criteria of “legitimate excuse.”

*Response by the Netherlands:* “At this moment, it is assumed that the guidelines under the old patent act of 1910 still apply. In these guidelines, based on jurisprudence of NIPO, the following requirements are laid down. Not only the patentee himself has to take “*all due care required by the circumstances*”, but also (internally) his own personnel, as well as (externally) his patent attorney and the personnel of the patent attorney and all other persons employed by the patentee or his patent attorney (like “CPI”, a company specialised in providing patent annuity services). The administrative personnel must be well trained and instructed. The administrative system must be set up in a way that it takes into account that even well educated, properly trained and accurate working personnel/staff can sometimes make a mistake. This implies that crucial time limits must be checked independently, so that accidental mistakes (of personnel) are discovered in time within the system. Mistakes, which are unforeseeable, e.g. due to a fatal combination of accidental events, are excusable. An isolated mistake in a properly working administrative system with sufficient cross-checking is excusable.”

*Response by Norway:* “In the assessment as to whether due care is shown, it is required that the applicant or his representative has a system for monitoring time limits. If the failure to comply with that time limit occurs, in spite of the system, it will be assessed if the system seems to be well functioning under normal circumstances. If so, and the failure to comply with the time limit is due to a single, isolated procedural error, the condition for due care is considered fulfilled and the right will be restored. The assessment of circumstances related to exceeded time limits due to a failure done by office staff for by single, individual applicants is less strict than failures done by professional representatives. It is, however, necessary that the office in question can show that the staff is well instructed and trained by the responsible attorney. In addition, their work should be regularly spot-tested. Workloads, long-lasting illness or financial difficulties are not considered as sufficient grounds in cases of restoration of rights. Failures resulted from cases of force majeure will always be considered as fulfilling the condition of “due care.”

*Response by Singapore:* 4a. As mentioned above, the provisions on restoration in Singapore are similar to those found in UK. Hence, the case law and the practice in UK could serve as precedents (but they are not binding) when we consider the requirement of “reasonable care” in Singapore. 4b. On “unintentionality”, one would have to show that the delay or omission to meet the deadline was not a deliberate act.”

*Response by the Slovak Republic:* “No. The rights and duties of the applicant, in relation to restoration of the priority right, are clearly specified in the Act No. 435/2001 Coll. on Patents, Supplementary Protection Certificates and on Amendment of Some Acts (Patent Law) in its provisions.”

*Response by Slovenia:* “There are no national guidelines concerning those criteria. As a rule, the Office is following applicable national court decisions and the practice of Boards of Appeal of the European Patent Office.”

*Response by Spain:* “There are still no guidelines in this matter because that legal provision has been in force only since July 31 2002.”

*Response by the United Kingdom:* “Limited guidelines are contained in our Manual of Patent Practice, relevant extracts of which are attached as an annex A. In the case of “reasonable care”, the guidelines provide the references for the precedent cases to which we refer when assessing restoration requests. As the Hearing Office for section 28 restoration cases, I also give regular PowerPoint presentations in which I describe by example the factors taken into account when determining whether a patentee has taken “reasonable care”. Extracts from my speaking notes are attached as an annex B. Apart from the short reference in the Manual of Patent Practice, the only other guide to what is meant by a “continuing underlying intention” is the *Heatex Ltd* precedent case referred to above”

*Response by the United States of America:* “Guidelines are set forth in MPEP 711.03(3)(C)(111) and 2590.”

Question 5: (only applicable if the answer to question 1 is “yes”): What are the main problems, if any, with regard to the application of the two criteria?

*Response by Australia:* “A difficulty arises under the provisions of “due care” in identifying whether or not the party actually took due care. Different applicants/patentees and their agents have a myriad of systems in place. The lines between when a time limit was missed because of an absence of due care or because of some other reason can often be blurred. In some cases, there may be multiple layers of responsibility, such as the applicant/patentee, their in-house counsel, the foreign attorneys and the Australian attorneys. There may also be multiple levels of responsibility within each of these categories. It is sometimes difficult establishing where the relevant error actually occurred in such a case, although an intention to do the act may be readily apparent. The provisions of due care also do not lend themselves readily to infrequent users of the system, as they are unlikely to have sophisticated systems in place and often have an inadequate knowledge of the system. Therefore while there is a requirement for a causal relationship between the error and the failure to act, it is occasionally difficult to determine what the actual error was or how it occurred. This is particularly the case where there has been a change in the applicant/patentee and/or their attorney, or when the relevant person is no longer employed. In these cases it is necessary to look at the intention and the consequences of granting or refusing the extension. In other cases, the applicant may not have had the opportunity to form an intention, because some necessary precursor did not happen due to an error or omission. Some common deficiencies that occur in processing requests (in relation to the actual request and supporting evidence) are: -- The request is for the incorrect period -- particularly in respect of applications to enter the national phase; -- The request is in respect of the incorrect action -- particularly in respect of filing a divisional application; and in respect of correcting errors during the national phase that arise during the international phase of a PCT application; -- The request is in respect of a matter that cannot be extended (e.g. request to file a first instance application; requests in respect of matters where the Commissioner has become *functus officio* [such as a request filed after grant to extend the time for filing a notice of opposition.]) -- The declaration is of low evidentiary value by relying upon hearsay (“I declare that the [foreign] associate has told me that this client has told him that....”) -- particularly in situations where there is no apparent reason (other than mere inconvenience) why the person having the direct knowledge of the circumstances cannot provide a declaration. This is to be contrasted with the situation where “person X, formerly of our employ” committed an error, where hearsay evidence may be quite appropriate. -- Declarations that apparently provide ‘selective’ extracts of supporting documents whilst avoiding documents that may be less favourable to their case. (As a

particular subset of this situation - declarations which refer or allude to documents as supporting their case, but fail to provide copies of them.)”

*Response by Bulgaria:* “The main problems are connected with assessment of the evidences furnished by the applicant that support thereasons for the delay.”

*Response by Denmark:* “The problems that occur in relation to using the criteria all due care are that this criteria is very subjective and it is very difficult to have a common practice of importance is being put on the explanation given by the patent holder and there is a tendency that patent bureaus have a large advantage when giving the explanation because they are well aware of what the criteria are. The system therefore seems to give some advantage to the professional applicant at the expense of the private applicant.”

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*Response by the Eurasian Patent Office:* “One of the main problems in respect of application of the two criteria is deficiency of applicable practice and guidelines for definition of the criteria.”

*Response from the European Patent Office:* “As each individual case has to be examined on its own merits and since third party interests may be involved, the evaluation of all due care” requires careful consideration and may be time-consuming. Essential elements are fact-finding and evaluation of evidence provided by the party concerned. Where more than one person is involved it needs to be established who should have exercised “all due care” and to what extent. Further, it should be mentioned that the role of Article 122 EPC will change as soon as the Revision Act adopted on 29 November 2000 during the Diplomatic Conference of the EPC Contracting States, will enter into force. The new version of Article 121 EPC (further processing) broadens the scope of application of further processing and makes it the standard legal remedy in cases of failure to observe time limits in the European grant procedure. It takes account of current international legal trends and practical requirements, according to which further processing should, in the interest of procedural economy and legal certainty, be given priority over re-establishment of rights. It follows from the new version of Article 122 EPC that the scope of application is narrowed down in view of the new provisions governing further processing. Further processing is, however, excluded when the applicant has missed the priority period. Here, re-establishment of rights will be the only available remedy.”

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*Response by France:* “The rightholder may have some difficulties in certain circumstances to show evidence and to demonstrate the existence of both criteria. It may also be problematic for the Office to evaluate the quality of the evidence, which is being submitted. The Office therefore makes decisions on a case-by-case basis, in light of the circumstances of each case, and in general the rightholder would get his right restored if there is some doubt.”

*Response by Germany:* “The German Patent and Trade Mark Office does not encounter problems in applying the criterion of due care in practice. Sufficient terms of reference are provided, in particular, by the very extensive case law on this matter.”

*Response by India:* “There is no specific problem, these second criteria follow the first one.”

*Response by Israel:* “The items above which are close to “due care” require the Commission to exercise discretion, which is to some extent subjective. It is difficult to provide guidelines because the circumstances in each case are different and each case is determined according to its merits.”

*Response by Japan:* “ It does not seem to be any problem in applying the criterion of “due care”. As regards the criterion of “unintentionality”, however, it would be difficult to make a judgement because judgement on “unintentionality” greatly depends on the subjective element of the applicant.”

*Response by the Republic of Korea:* “The KIPO has not met any problems with regard to the application of the criteria.”

*Response by Republic of Moldova:* “ The main problem consists in the lack of a uniform and equivalent treatment by the Offices, caused by the absence of a clear definition of the situations to which can be applied these criteria.”

*Response by Monaco:* “The principal difficulty consists in the appreciation of the criteria of “legitimate excuse” according to the circumstances.”

*Response by the Netherlands:* “In the Netherlands, only the “due care” criterion applies. There are no problems with this criterion.

*Response by New Zealand:* “No problems with regard to the application of these criteria have been noted. The use of the Patents Act 1953 and Commissioners Decisions make this area relatively straightforward.”

*Response by Norway:* “Seen from the office’s point of view, the main problems regarding the use of the “due care” criterion is the time-consuming hearing of the cases. Furthermore, it will always be a possibility that professional attorneys, who know the office’s practice in these cases, is able to adjust the application of restoration accordingly.”

*Response by the Philippines:* “The lack of specific guidelines defining “unintentionality” makes such criterion broad and subject to abuse by the applicants and right holders.”

*Response by Poland:* \*The most difficult is to establish where “unintentionality” ends and “due care” starts (whether the applicant’s act or omission of acting may be considered just to be unintentional [undesigned, unmeant] or rather negligent and without due diligence) and what is the intensity of his willful being at fault.”

*Response by Singapore:* “5a. To show “reasonable care”, one would have to adduce evidence to show that a certain degree of care is already in place to prevent a delay or omission in meeting the deadline. One can foresee problems arising when it comes to collating such evidence that would satisfy the Patent Office. 5b. On “unintentionality”, one would have to show that the delay or omission to meet the deadline was not a deliberate act. This requirement is met when the person explains as such, in a sworn statement.”

*Response by the Slovak Republic:* “No. The rights and duties of the applicant, in relation to restoration of the priority right, are clearly specified in the Act No. 435/2001 Coll. on Patents, Supplementary Protection Certificates and on Amendment of Some Acts (Patent Law) in its provisions.”

*Response by Slovenia:* “The criterion of “due care” is used in connection with restitution in integrum cases. This institute is used for specific cases where two main conditions have to be fulfilled: 1. “due care” criterion and 2. justifiable reasons for non-compliance with the time limit. For applicants/owners or professional representatives it is especially difficult to meet

the criterion of “due care” since it is very difficult to prove that all the appropriate care has been taken under the circumstances of the case.”

*Response by Spain:* “We have had no problems with the application of restoration of rights.”

*Response by Sweden:* “The main problem is to decide the necessary standard for all due care since all circumstances must be taken into consideration in the specific case.”

*Response by the United Kingdom:* “One of the problems we encounter when assessing applications to restore patents based on the “reasonable care” test is the difficulty in obtaining evidence. For instance, it can be very difficult for an applicant to prove that he did not receive a reminder letter from his agent or this Office or that his health was such as to prevent him paying the fee. In the case of “continual underlying intention”, the problem can be the reverse in that it is difficult to disprove an applicant’s claim that that was his intention. Applicants who do not use professional agencies for the purposes of reminding and/or payment of renewal fees can occasionally find it difficult to present this Office with the evidence to show that their own “in house” systems are effective and robust to demonstrate that they have taken reasonable care.”

*Response by the United States of America:* “The main problem with the “due care” criterion is that it requires supporting evidence, which must be carefully considered. This presents a greater administrative burden upon the Office than in the case of “unintentionality”. In addition, the showing required by the applicant to establish “due care” is greater than in the case of “unintentionality.” Thus, the criterion of “due care” is less “applicant friendly” than the criterion of “unintentionality”.

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