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RIGHT OF PRIORITY AND PRIORITY CLAIMS

Document prepared by the International Bureau

INTRODUCTION

1. At its first session, held from May 21 to 25, 2001, the Committee on Reform of the Patent Cooperation Treaty (PCT) agreed, inter alia, to recommend to the PCT Assembly that certain matters be referred to a working group for consideration and advice (see document PCT/R/1/26, paragraphs 67 and 68). The Assembly, at its thirtieth (13th ordinary) session, held from September 24 to October 3, 2001, unanimously approved the Committee's recommendations (see document PCT/A/30/7, paragraph 23).

2. The Director General accordingly convened the first session of the Working Group on Reform of the PCT, which was held from November 12 to 16, 2001, following which the second session of the Working Group was held from April 29 to May 3, 2002. As to the results of the work of the Working Group, see the summaries of the first and second sessions prepared by the Chair (documents PCT/R/WG/1/9 and PCT/R/WG/2/12, respectively) and document PCT/R/2/2, which reproduces these second sessions summary as an Annex.¹

¹ Working documents for sessions of the Assembly, the Committee and the Working Group are accessible via WIPO's Website at <http://www.wipo.int/pct/en/meetings>.

Reinstatement of priority claim where time limit missed; Correction and addition of priority claims; Availability of priority documents from digital libraries

3. At its first and second sessions, the Working Group considered proposals for amendment of the Regulations under the PCT² relating, as recommended by the Committee, to changes necessary or desirable to bring the requirements under the PCT into line with the letter and spirit of the Patent Law Treaty (PLT) (see the report of the first session of the Committee, document PCT/R/26, paragraphs 72 to 74).

4. There was wide agreement at the first session of the Working Group on the general approach to be taken (see document PCT/R/WG/1/9, paragraph 21). Among the matters agreed was that (see paragraph 21(v)):

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

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

....”

5. The proposals prepared by the International Bureau for consideration at the first session of the Working Group included provisions for reinstatement of priority similar to those in the PLT, as well as to the possibility, in line with the PLT, that priority documents may be available, in the future, from digital libraries (see document PCT/R/WG/1/5, Annex III). The Working Group's discussions are outlined in document PCT/R/WG/1/9, paragraphs 22 and 23:

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

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

(ii) noting that the administration of those provisions in the national phase would be a matter for ROs [receiving Offices], the importance of a single standard, or at

² References in this document to “Articles” and “Rules” are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case may be (the current texts are available on WIPO's Website at http://www.wipo.int/pct/en/access/legal_text.htm). Reference to “national laws,” “national applications,” “the national phase,” etc., include reference to regional laws, regional applications, the regional phase, etc. Reference to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT (see document PT/DC/47 on WIPO's Website at http://www.wipo.int/eng/document/pt_dc/index.htm).

least consistent practice, among the various ROs was emphasized by several delegations;

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

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

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

(v) most delegations believed that the RO’s decisions should be binding on DOs [designated Offices] (as under proposed Rule 26 *bis.3(f)*), but certain delegations believed that the RO’s decisions should be subject to review by DOs in at least some circumstances, although there was no agreement as to what circumstances should be relevant in this context;

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

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

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

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

(ix) the fact that a considerable number of countries’ national laws did not presently provide for restoration of priority rights, at least according to PLT criteria,

suggested that transitional reservations would need to be allowed for if restoration provisions were to be introduced under the PCT.

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

(i) provide for restoration of the priority right by the RO based on the “unintentional” criterion, but identifying alternatives in the related comments or explanation;

(ii) make it clear that it was the procedural effect of the priority right, rather than the substantive effect, that should be recognized for the purposes of the national phase.”

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

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

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

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

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

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

“55. It was agreed that proposed amended Rules 17.1 and 66.7, relating to the possibility, in line with the PLT, that priority documents may be available, in the future, from digital libraries, should proceed together with the proposed amendment of Rule 47.1 and related provisions (see paragraphs 24 and 25, above). Proposed amended Rules 26bis.1 and 26bis.2 and new Rule 80.8, relating to the correction and addition of priority claims, should similarly also proceed.

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

7. Article 13 and Rule 14 of the PLT are reproduced for ease of reference in Annex I. Revised proposals for amendments to the PCT Regulation to provide for the restoration of priority claims are included in Annex II (see Rules 4 and 48 as proposed to be amended and proposed new Rule 26 *bis.3*), as well as provisions relating to the possibility, in line with PLT requirements, that priority documents may be available, in the future, from digital libraries (see Rules 17.1 and 66.7 as proposed to be amended). Annex II also includes proposals to amend Rules 26 *bis.1* and 26 *bis.2* and to add new Rule 80.8 relating to the possibility for the applicant to correct or add priority claims. Some key issues arising in connection with the proposals are outlined in the following paragraphs.

Procedural and substantive aspects of priority rights

8. Although PLT Article 13(2) refers to the restoration of the *right of priority*, it is proposed in the context of the PCT procedure to provide for the receiving Office to be able to restore the *priority claim* (see proposed Rule 26 *bis.3*).

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

10. It therefore appears to be necessary to ensure that, while a designated Office would always be free to *determine the validity of a priority right* for the purposes of the national phase in terms of compliance with the Paris Convention, it should be strictly limited in its freedom (during the national phase) to *review a decision by the receiving Office to restore a priority claim* (during the international phase). Proposed Rule 26 *bis.3(g)(i)* would accordingly restrict the circumstances in which a designated Office could decide to review such a decision, namely, to cases where there is a “reasonable doubt” on the part of the designated Office. If national law gives third parties the right to intervene, it would be open to a third party to persuade the designated Office that such a reasonable doubt existed.

11. In the absence of grounds to overturn the decision of the receiving Office, so far as a designated Office is concerned, proposed Rule 26 *bis.3(g)(ii)* would oblige the designated Office to give due effect to the receiving Office’s decision.

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

12. See document PCT/R/WG/1/9, paragraphs 22(ii) to (vi) and 23(i), quoted in paragraph 5, above. PLT Article 13(2)(iv) leaves it at the option of each PLT Contracting State to decide whether the Office requires the failure to file the subsequent application to have been “unintentional” or that it “occurred in spite of due care required by the circumstances having been taken”. At the first session of the Working Group, it was agreed that, in the context of the PCT, restoration of priority claims should be based on the more liberal requirement that the failure was “unintentional,” as favored by most delegations. However, certain delegations favored adopting the more restrictive criterion of “due care”. Certain other delegations favored giving receiving Offices a choice as to which of the two criteria to apply, as would be the case for Contracting Parties to the PLT.

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

14. While it is recognized that the Committee may wish to further discuss the matter, proposed Rule 26 *bis*.3(a)(iii) relies on the criterion of unintentionality in accordance with the conclusion of the first session of the Working Group.

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

15. It does not seem necessary or appropriate to attempt to regulate under the PCT itself the rights of third parties affected by the restoration of a priority right. Rather, any recognition of the rights of such third parties, including any prior user right and any right to request a designated Office to review a decision of the receiving Office to restore a priority claim, should be left to the applicable national law in the designated States. In the event that it were thought desirable to make that position clear in the Regulations, consideration would also need to be given to the rights of third parties whomight be affected in other ways under the PCT procedure, for example, by the correction or addition of a priority claim under Rule 26 *bis*.

Transitional reservation

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

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

[Annex I follows]

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

Article 13

Correction or Addition of Priority Claim; Restoration of Priority Right

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

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

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

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

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

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

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

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

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

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

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

Rule 14

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

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

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

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

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

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

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

(i) be signed by the applicant; and

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

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

(i) be signed by the applicant; and

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

(b) A Contracting Party may require that:

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

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

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

[Annex II follows]

PROPOSED AMENDMENTS OF THE PCT REGULATIONS: ¹

RIGHT OF PRIORITY AND PRIORITY CLAIMS

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

Rule 4

The Request (Contents)

4.1 to 4.9 [No change]

4.10 *Priority Claim*

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

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

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

(ii) to (v) [No change]

(b) to (d) [No change]

4.11 to 4.18 [No change]

Rule 17

The Priority Document

17.1 *Obligation to Submit Copy of Earlier National or International Application*

(a) Where the priority of an earlier national or international application is claimed under Article 8, a copy of that earlier application, certified by the authority with which it was filed (“the priority document”), shall, unless [that priority document has](#) already [been](#) filed with the receiving Office together with the international application in which the priority claim is made, and subject to paragraph [s\(b\)](#) [and \(b -bis\)](#), be submitted by the applicant to the International Bureau or to the receiving Office not later than 16 months after the priority date, provided that any copy of the said earlier application which is received by the International Bureau after the expiration of that time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the date of international publication of the international application.

[COMMENT: See proposed new paragraph [\(b -bis\)](#), below.]

(b) [No change]

[Rule 17.1, continued]

(b-bis) Where the priority document is, in accordance with the Administrative Instructions, available to the receiving Office or to the International Bureau from a digital library [or other repository], the applicant may, as the case may be, instead of submitting the priority document:

- (i) request the receiving Office to obtain the priority document from such digital library [or other repository] and transmit it to the International Bureau; or
- (ii) request the International Bureau to obtain the priority document from such digital library [or other repository].

Such requests shall be made not later than 16 months after the priority date and may be subjected by the receiving Office or the International Bureau to the payment of a fee.

[COMMENT: See PLTR Rule 4(3). See also proposed new Rule 93bis in document PCT/R/2/6, Annex IV. The Committee may wish to consider adding the words “or other repository” (presently in square brackets) so as to address concerns raised in the second session of the Working Group concerning the use of the term “[intellectual property] digital library” in the context of communication by electronic means (see document PCT/R/WG/2/12, paragraph 25). The Administrative Instructions will prescribe the conditions that must be satisfied for an earlier application to be considered available to the receiving Office or the International Bureau for the purposes of this paragraph.]

[Rule 17.1, continued]

(c) If the requirements of ~~none~~ ~~neither~~ of the ~~three~~ ~~two~~ preceding paragraphs are complied with, any designated ~~Office~~ ~~State~~ may subject to paragraph (d), disregard the priority claim, provided that no designated Office shall disregard the priority claim before giving the applicant an opportunity to furnish the priority document within a time limit which shall be reasonable under the circumstances.

(d) No designated Office shall disregard the priority claim under paragraph (c) if the earlier application referred to in paragraph (a) was filed with it in its capacity as a national Office or if the priority document is, in accordance with the Administrative Instructions, available to it from a digital library [or other repository].

[COMMENT See PLTR Rule 4(3). See also proposed new Rule 93bis in document PCT/R/2/6, Annex IV. The Committee may wish to consider adding the words “or other repository” (presently in square brackets) so as to address concerns raised in the second session of the Working Group concerning the use of the term “[intellectual property] digital library” in the context of communication by electronic means (see document PCT/R/WG/2/12, paragraph 25). The Administrative Instructions will prescribe the conditions that must be satisfied for an earlier application to be considered available to the designated Office for the purposes of this paragraph.]

17.2 [No change]

Rule 26 bis

Correction, ~~or~~ Addition or Restoration of Priority Claim

26bis.1 Correction or Addition of Priority Claim

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

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

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

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

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

[Rule 26bis.1, continued]

(b) [No change]

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

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

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

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

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

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

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

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

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

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

[Rule 26bis.2, continued]

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

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

(c) [No change]

26bis.3 Restoration of Priority Claim

(a) The receiving Office shall, at the request of the applicant and subject to paragraphs (c) and (d), restore a priority claim where the international application has an international filing date which is later than the date on which the priority period referred to in paragraph (b) has expired, if:

[COMMENT: See PLT Article 13(2)]

(i) the international application has been accorded an international filing date which is within a time limit of two months from the date on which the priority period expired; and

[COMMENT: See PLT Article 13(2) and PLTR Rule 14(4)(a).]

(ii) the request for restoration of the priority claim is submitted to the receiving Office within a time limit of two months from the date on which the priority period expired; and

[COMMENT: See PLT Article 13(2)(ii) and PLTR Rule 14(4)(b).]

(iii) the receiving Office finds that the failure to file the international application within the priority period was unintentional.

[COMMENT: As to the criterion for restoration (“unintentionality” as against “due care”), see paragraphs 12 to 14 of the Introduction to this document.]

[Rule 26bis.3, continued]

(b) The priority period referred to in paragraph (a) shall be 12 months calculated from the priority date that would apply if the priority claim were restored.

(c) The request referred to in paragraph (a) shall:

(i) state the reasons for the failure to comply with the priority period; and

[COMMENT: See PLT Article 13(2)(iii).]

(ii) be accompanied, where the international application did not claim the priority of the earlier application, by a notice adding the priority claims so as to comply with the requirements of Rule 4.10.

[COMMENT: See PLTRule 14(5)(ii).]

[Rule 26bis.3, continued]

(d) The receiving Office:

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

[COMMENT: See PLT Article 13(4).]

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

[COMMENT: See PLT Article 13(5).]

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

[COMMENT: See PLT Article 13(6).]

(e) Where the receiving Office refuses a request for restoration of a priority claim under paragraph (a), that priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made and the receiving Office or the International Bureau, as the case may be, shall so declare and shall inform the applicant accordingly.

[Rule 26bis.3, continued]

(f) Where the receiving Office has refused a request under paragraph (a) for restoration of a priority claim, or where such a request is pending at the time of the completion of the technical preparations for international publication, the International Bureau shall, upon request made by the applicant and received by the International Bureau prior to the completion of the technical preparations for international publication, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish, together with the international application, information concerning that request for restoration. A copy of the request under this paragraph shall be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3).

[COMMENT: New paragraph (f) is proposed to be added as a safeguard for the applicant where his request for the restoration of a priority claim has been refused or has not been decided upon by the time the international application is to be published so as to enable him to pursue the matter further, after national phase entry, before the designated Offices concerned; see also Rule 26 bis.2(c), which has been used as a model for the wording of new paragraph (f). New Sections in the Administrative Instructions, similar to Sections 314 and 402 in respect of the correction and addition of priority claims, would also be required.]

[Rule 26bis.3, continued]

(g) Where the receiving Office has restored a priority claim under paragraph (a):

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

(ii) no designated Offices shall disregard the priority claim only because the international application has an international filing date which is later than the date on which the priority period referred to in Rule 26 bis.3(b) expired, unless it finds that a requirement under paragraph (a) was not complied with.

[COMMENT: As to the procedural aspects of priority claims as against the substantive aspects of priority rights, see paragraphs 8 to 11 of the Introduction to this document. New paragraph (g) is intended to strike an equitable balance between the interests of the applicant in not having the restoration of a priority claim routinely reviewed by designated Offices and the right of the designated Office to revoke an incorrectly restored priority claim (see document PCT/R/WG/2/12, paragraph 54(iv), quoted in the Introduction). As to the right of third parties to intervene in the matter of a request for the restoration of the priority claim, see paragraphs 10 and 15 of the Introduction.]

[Rule 26 bis.3, continued]

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

[COMMENT: As to prior rights of third parties and the right of third parties to intervene, see paragraphs 10 and 15 of the Introduction to this document.]

Rule48

InternationalPublication

48.1 [Nochange]

48.2 *Contents*

(a) Thepamphletshallcontain:

(i) to(ix) [Nochange]

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

(xi) indicationsconcerninganypriorityclaimhasbeenrestoredunder

Rule 26*bis*.3(a).

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

(b)to(i) [Nochange]

48.3to48.6 [Nochange]

[COMMENT:SeedocumentPCT/R/2/3forproposedamendmentsofRule48.3.]

Rule 66

Procedure Before the

International Preliminary Examining Authority

66.1 to 66.6 [No change]

66.7 Copy and Translation of Earlier Application Whose Priority is Claimed Document

(a) If the International Preliminary Examining Authority needs a copy of the earlier application whose priority is claimed in the international application, the International Bureau shall, on request, promptly furnish such copy. If that copy is not furnished to the International Preliminary Examining Authority because the applicant failed to comply with the requirements of Rule 17.1 , and if that earlier application was not filed with that Authority in its capacity as a national Office or the priority document is not available to that Authority from a digital library [or other repository] in accordance with the Administrative Instructions, the international preliminary examination report may be established as if the priority had not been claimed.

[COMMENT: See PLTR Rule 4(3). The Committee may wish to consider adding the words “or other repository” (presently in square brackets) so as to address concerns raised in the second session of the Working Group concerning the use of the term “[intellectual property] digital library” in the context of communication by electronic means (see document PCT/R/WG/2/12, paragraph 25). The Administrative Instructions will prescribe the conditions that must be satisfied for an earlier application to be considered available to the International Preliminary Examining Authority for the purposes of this paragraph. The Working Group agreed at its second session (see document PCT/R/WG/2/12, paragraph 55) that this change should proceed together with the proposed amendment of Rule 47.1 and related provisions (see proposed new Rule 93bis in see Annex IV of document PCT/R/2/6).]

(b) [No change]

66.8 and 66.9 [No change]

Rule80

ComputationofTimeLimits

80.1to80.7 [Nochange]

80.8 *TimelimitsComputedFromthePriorityDate*

(a) Whereachangeintheprioritydateiscausedby:

(i) thecorrectionoradditionofapriorityclaim;or

(ii) there storationofapriorityclaim;

anytimelimitwhichiscomputedfromthepreviouslyapplicableprioritydateandwhichhas

notalreadyexpiredshallbecomputedfromtheprioritydateassochanged.

[COMMENT:SeecommentonRule26 *bis*.1(c),above.Itis proposedtomovethecontentof currentRule26 *bis*.1(c)toproposednewRule 80.8(a)soastodealwithallmattersrelatingto timelimitscomputedfromtheprioritydate,includingarestoredpriorityclaim,inoneplace.]

[Rule 80.8, continued]

(b) For the purposes of computing time limits, if a priority claim does not comply with Rule 4.10(a)(i) because the date on which the earlier application was filed was not a date falling within the 12 months preceding the international filing date, that priority claim shall not, subject to paragraph (a)(ii), be taken into account for the purposes of determining the priority date.

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

[End of Annex II and of document]