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EPO PROPOSAL ON THE CRITERIA FOR RESTORATION OF
RIGHT OF PRIORITY (PROPOSED NEW RULE 26 bis.3(a))

Proposals by the European Patent Office (EPO)

Comments

1. Under the proposal (see proposed Rule 26 bis.3(a) in document PCT/R /WG/3/2) the applicant may choose whether he requests restoration of the right of priority either because the failure to file the subsequent application in time was “unintentional,” or that it “occurred in spite of all due care required by the circumstance shaving been taken.” The EPO does not support this proposal. The PCT should contain one single criterion. Also the determination of a fee charged for the benefit of a receiving Office by the PCT Assembly and the inclusion of the amount of such fee in the Regulations is not customary. Finally, the procedures should be kept as simple and transparent as possible.

2. According to the European Patent Convention (EPC) and many national laws re- establishment of rights is only possible if the time limit was missed “in spite of all due care.” It should be avoided that patent offices would have to apply “unintentionality” as receiving Office under the PCT and “due care” as national office when receiving national patent applications, i.e. they would have to be more liberal as receiving Office than as a national office.

3. Moreover proposed Rule 26 *bis(j)* restricts the circumstances in which the designated Office could review a decision by the receiving Office to restore a priority claim during the international phase. This approach is in line with the principle that positive decisions taken in the international phase by the receiving Offices should bind the designated Office (e.g. in cases of corrections). But if the criterion applied by the receiving Office was the “unintentionality”, many designated Offices applying national laws, which have the more restrictive criterion “due care”, would have to accept restitution of priority right based on criteria that would be insufficient under their national law. On the contrary, if all receiving Offices would apply the sole and more restrictive “due care” criterion, a possibility for review of a negative decision taken in the international phase by the receiving Office could be made available before the designated Offices. Where the national law applied by the designated Office provides for requirements for the restoration of right of priority that are more favorable, that designated Office could apply these requirements (e.g. the criterion of “unintentionality”) to the international application concerned.

4. Taking into account that a considerable number of national laws do not currently provide for restoration of priority rights and the convenience of a single consistent practice in the international phase, it would be advisable to provide guidance to receiving Offices on how to apply the criterion of “due care.”

Proposals

5. It is proposed to draft Rule 26 *bis.3(a)* as follows:

“The receiving Offices shall [...] restore the right of priority where the international application which claims or could have claimed the priority of an earlier application has an international filing date which is later than the date on which the priority period referred to in paragraph (f) expired but is within two months from that date, if the receiving Office finds that the failure to comply with the priority period occurred in spite of due care required by the circumstances having been taken _____.”

6. It is furthermore proposed to include a paragraph in Rule 26 *bis.3* to the following effect:

Where the receiving Office has refused a request for the restoration of the right of priority, each designated Office may, where the national law applied by this Office provides for requirements for the restoration of the right of priority that are more favorable than those under Rule 26 *bis.3(a)*, apply those more favorable requirements where the applicant files a request for review under Rule 26 *bis.3(i)*.

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