

WIPO



PCT/R/WG/7/3
ORIGINAL:English
DATE:April5,2005

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REF ORM OF THE PATENT
COOPERATION TREATY (PCT)

Seventh Session
Geneva, May 25 to 31, 2005

RESTORATION OF THE RIGHT OF PRIORITY

Document prepared by the International Bureau

SUMMARY

1. This document contains further revised proposals for amendment of the Regulations under the PCT¹ to provide for the restoration of the right of priority where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, consistently with the provisions for such restoration under the Patent Law Treaty (PLT).

2. Earlier proposals, discussed at the sixth session of the Working Group, have been revised taking into account the discussions, and the agreement reached, at that session and the comments received on preliminary draft documents made available since then. The main differences in comparison with the proposals considered at the sixth session concern the

¹ References in this document to "Articles" and "Rules" are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT ("the Regulations"), or to such provisions as proposed to be amended or added, as the case may be. References to "national laws", "national applications", "the national phase", etc., include reference to regional laws, regional applications, the regional phase, etc. References to "PLT Articles" and "PLT Rules" are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT.

following: (i) the time limits for requesting restoration of the right of priority; (ii) the circumstances in which a decision of a receiving Office can be reviewed by a national authority; and (iii) the addition of a definition of the term “priority period” and clarification that Rule 80.5 applies to this period *mutatis mutandis*.

BACKGROUND

3. The Committee on Reform of the PCT (“the Committee”), at its first and second sessions, and the Working Group, at its first, second, third, fourth, fifth and sixth sessions, considered proposals for amendment of the Regulations under the PCT relating to the restoration of the right of priority. The reports of these sessions of the Committee and the summaries by the Chair of these sessions of the Working Group set out the status of the matters discussed by the Committee and the Working Group, respectively, noting the range of views expressed and areas where agreement had been reached, and identifying what future work needed to be undertaken (see documents PCT/R/1/26, paragraphs 72 to 76; PCT/R/2/9, paragraphs 111 to 123 and 125; PCT/R/WG/1/9, paragraphs 22 and 23; PCT/R/WG/2/12, paragraphs 54 to 56; PCT/R/WG/3/5, paragraphs 13 to 27; PCT/R/WG/4/14, paragraphs 35 to 44; PCT/R/WG/5/13, paragraphs 28 to 62; PCT/R/WG/6/12, paragraphs 7 to 42).

4. The Working Group’s discussions at its last (sixth) session (see document PCT/R/WG/6/12, paragraphs 7 to 42) are outlined in the following paragraphs:

“7. Discussions were based on document PCT/R/WG/6/1.

“8. Several delegations referred to the discussions in previous sessions of the Working Group and expressed their concern that, while they were in favor of the principle of allowing for restoration of priority rights in the case of applications under the PCT consistently with the provisions for such restoration under the Patent Law Treaty (PLT), the procedure would represent such a fundamental change to the system that it ought to be addressed in the Articles of the Treaty itself rather than in the Regulations. Some of those delegations indicated that they would not wish to block a consensus should the Assembly decide to adopt amendments of the Regulations providing for restoration of the right of priority but that they would make use of the proposed transitional reservation provisions, at least until such time as the matter could be addressed directly under their national laws. Others felt that the possibility for transitional reservations would not be sufficient to address their concerns and stressed the need for amendment of the Treaty itself.

“9. One delegation expressed the view that Article 58(1) would not provide a sufficient basis for this matter to be dealt with in the Regulations only. It stated that Article 58(1)(iii) provided a basis only for Rules concerning details useful in the implementation of the provisions of the Treaty but not for Rules concerning matters which were not dealt with by provisions of the Treaty in the first place. The delegation also expressed its concern that a restoration of the right of priority would, in effect, extend the term of a granted patent by up to two months and, in general, questioned whether aligning the PCT requirements to those of the PLT should indeed be one of the objectives of PCT reform, noting that the PLT had not yet entered into force and, in light of differing views on the PLT, may not be ratified by many PCT Contracting States in the near future.

“10. Other delegations were of the opinion that, while provisions concerning restoration of the right of priority would not be in conflict with the Paris Convention itself, inclusion of such provisions in the Regulations providing, in effect, for a 14-month priority period in certain cases would be inconsistent with Articles 8(2)(a) and 2(xi) of the PCT, which referred to the Paris Convention with regard to the conditions for, and the effect of, any priority claim contained in an international application, and thus to the 12-month priority period under Article 4C(1) of the Paris Convention.

“11. A number of delegations and representatives of users welcomed the general approach taken in the document, noting the importance of provisions for the restoration of the right of priority as a safeguard for applicants. The proposed provisions would not enable an automatic extension of the priority period to 14 months but would be applicable only in particular circumstances after a check by the Office concerned. Referring to the extensive discussion that took place in the context of the adoption of the PLT, those delegations and representatives of users expressed the view that provisions for the restoration of the right of priority were in compliance with the provisions of the Paris Convention, which only provided for a minimum standard with regard to the length of the priority period and thus left room for member States of the Paris Convention to grant longer periods of priority if they so wished. They were of the opinion that the Working Group should proceed with developing proposed amendments to the Regulations unless it was convinced that those amendments would clearly be inconsistent with provisions of the Treaty, which they felt not to be the case.

“12. Noting the divergence of views as to whether the inclusion in the PCT of provisions relating to the restoration of the right of priority needed to be addressed in the Articles of the Treaty itself rather than in the Regulations, the Secretariat referred to earlier discussions in the Working Group concerning a possible revision of the Treaty and the apparent difficulties noted by the Working Group in that context, namely, the difficulty of defining the scope of any revision and the need to avoid the existence of two parallel systems during a prolonged period where some Contracting States had ratified a new version of the Treaty and others had not. The Secretariat pointed out that there were, however, precedents in WIPO for making changes to the effect of treaties in advance of their formal ratification, or which were not in strict agreement with their literal wording, where there was a consensus to do so. For example, the WIPO Assemblies in 1989, 1991 and 1993 had considered radical changes to the system of contributions by Member States under the WIPO Convention and the six other treaties administered by WIPO that provided for contributions to be paid by Contracting States. In consequence, in 1993, a unitary contributions system with revised contribution classes was introduced by consensus. The formal changes to the relevant treaties were only adopted in 2003, after it was agreed that the system had been shown to work, and the system was continuing even though those changes had not yet entered into force. Similarly, in the International Union for the Protection of New Varieties of Plants (UPOV), after the conclusion of the 1991 Act, it was agreed that the 1978 Act should remain open to accession by developing countries even beyond the dates of closing of the 1978 Act which had been set in the 1991 Act. The Secretariat suggested that Contracting States should consider the possibility of a revision of the PCT having a limited scope and whether a way could be found to voluntarily accelerate the effective entry into force of new provisions.

“13. After some discussion, the Chair concluded that, while differing views had been expressed as to whether the inclusion in the PCT of provisions relating to the restoration of the right of priority ought to be addressed in the Articles of the Treaty itself rather than in the Regulations, a majority of delegations had expressed the view that, as had been decided by the Assembly, it would be desirable for the PCT to be aligned in that regard to the PLT. The question at hand was thus not whether such restorations should be provided for in the context of the PCT but rather how best to address the concerns expressed by those delegations who saw a need for amending the Treaty itself. On the one hand, the possibility for transitional reservations provided one possible way for Contracting States not to apply the provisions concerned until such time as the position might be solved under their national laws. On the other hand, the suggestion by the Secretariat outlined in paragraph 12, above, merited further consideration.

“14. The Working Group agreed that, while there was no agreement as to whether the proposals could be implemented without amending the Articles of the Treaty itself, the approach taken in the proposals should be further developed, and the Working Group invited the Secretariat to prepare revised proposals for consideration at its next session, taking into account the matters noted above and the comments and suggestions as to particular provisions noted in the following paragraphs.

Rule 4.10(a)(i)

“15. One delegation suggested, noting particularly the proposed deletion of the words “, being a date falling within the period of 12 months preceding the international filing date”, that the term “priority period”, as used in proposed Rule 26bis.2(a)(i) and elsewhere, should be defined in the Regulations, either in Rule 26bis.2 or in Rule 2. Another delegation noted that the definition should take into account non-working days under Article 4C(3) of the Paris Convention. Another delegation considered that the definitions should also make clear that the provisions of Rule 80.5 (concerning expiration of time limit on a non-working day or official holiday) should apply to the priority period.

Rule 26bis.2(a)

“16. One delegation suggested that a receiving Office which had made a transitional reservation under proposed Rule 26bis.3(h) should not be required to notify the applicant of the possibility of submitting the request for the restoration of the right of priority in accordance with Rule 26bis.3, and that the proposed amendments of the Regulations should be further amended accordingly.

Rule 26bis.2(b)

“17. In response to questions by one delegation and a representative of users, the Secretariat explained that, as defined in proposed Rule 26bis.2(b), a priority claim which was “considered void” was, for the purposes of the Treaty, considered not to have been made *ab initio*. The definition had been introduced as a mere drafting change to simplify the wording of the proposed text and not to change the substance of the present provision. One delegation noted that consequential changes in terminology concerning priority claims “considered not to have been made” should be considered elsewhere, for example, in Rule 82ter.

“18. One delegation suggested that the Regulations should be further amended so as to provide that, as already provided under the Receiving Office Guidelines, a notice received after the expiration of the time limit under Rule 26bis.1(a) should be considered to have been received in time if it was received before the receiving Office had declared that the priority claim was considered not to have been made.

Rule 26bis.2(c)

“19. It was suggested and agreed that the words “the contents of” should be deleted in Rule 26bis.2(c)(ii).

Rule 26bis.2(d)

“20. One delegation suggested that the Administrative Instructions should be modified to ensure that the information to be published under Rule 26bis.2(d) contains a clear indication as to whether a priority claim has been considered void under Rule 26bis.2(b) or whether a priority claim has not been considered void under Rule 26bis.2(c).

Rules 26bis.3(a) and (b)

“21. One delegation pointed to the need for clarification of the relationship between Rules 26bis.3(b) and 26bis.2, noting that the present draft would appear to permit an applicant to request the restoration of the right of priority much later than two months following the expiration of the priority period, for example, in the case where the applicant added a priority claim under Rule 26bis.1 and received a notification by the receiving Office under Rule 26bis.3(b), which would appear to afford a further period of one month in the time limit for requesting restoration of that priority claim.

“22. One delegation suggested that it should be made clear that Rule 80.5 (concerning expiration of time limit on a non-working day or official holiday) applied to the time limit under this Rule.

Rule 26bis.3(c)

“23. One delegation sought clarification as to the evidence which could be required by a receiving Office, and in particular as to whether Offices could require particular forms of evidence (for example sworn statements) and whether they could require further evidence if the evidence originally filed was considered to be insufficient to decide the matter. It was felt that the draft as proposed would permit such flexibility, without having to include express provision to that effect, thus allowing each receiving Office to establish its own requirements, as had been previously agreed by the Working Group (see paragraph 49 of document PCT/R/WG/5/13). Such an understanding could, if desired, be reflected in the report of the Assembly in the event that it adopted amendments of the Regulations along the lines of the proposals.

“24. A number of delegations were concerned that leaving the necessary evidence to be decided by the receiving Office meant that a decision by a receiving Office which had very flexible requirements could result in the restoration of a right of priority on the basis of evidence which might not have been acceptable to a designated Office in a different

Contracting State having regard to the latter's national law, even if restoration of the right of priority were permitted under ostensibly the same criteria (due care or unintentionality).

“25. Other delegations and a representative of users, referring to one of the basic principles of international cooperation under the PCT, namely, trust in the work and decisions taken by other Offices during the international phase, considered that it was essential that the decisions of receiving Offices should be binding on designated Offices in the circumstances provided for in Rules 49ter.1(a) and (b), except in very limited circumstances where there was a particular doubt that a requirement had been complied with. Consistency in the standards to be applied was desirable and might be pursued through the Administrative Instructions, Receiving Office Guidelines and sharing of relevant decisions, with the result that consistency would be encouraged while enabling each receiving Office to deal with matters using procedures familiar to it.

“26. A representative of users was concerned that the term “reasonable in the circumstances” was not sufficiently certain as a time limit for filing a declaration or other supporting evidence. A minimum period of one month would be preferred. It was pointed out that Rule 14(6)(b)(i) of the PCT, on which this Rule was based, did not include a specific minimum time limit.

Rule 26bis.3(e)

“27. One delegation asked whether the requirement that the applicants should have the opportunity to make observations would enable a formal hearing to be conducted and whether it should be possible to appeal decisions to the national courts. Another delegation considered that since the receiving Office's negative decision can always be reviewed by the designated Office, there was no need to provide for an appeal. The Secretariat pointed out that the PCT was in general silent on these matters. The availability of hearings and appeals was neither required nor precluded by the Treaty; rather, the matter was left to national law.

Rule 26bis.3(h)

“28. Two delegations and one representative of users questioned the need for a transitional reservation provision under Rule 26bis.3(h), referring, in particular, to the wording of Article 10. However, other delegations pointed to the need for such a transitional reservation provision so as to afford time for the provisions of the applicable national law, such as those enabling the Office to require the payment of a fee for restoration of the right of priority, to be adapted to the new system.

“29. In response to a comment by one delegation that a three-month period may be insufficient for Contracting States wishing to make use of transitional reservation provisions, the Secretariat noted that this was the period that had usually been provided for in such transitional reservations when included in the Regulations in the past. Another delegation noted that such reservations would need to be made before entry into force of the provisions concerned.

Rule 48.2(a)(ix)

“30. In response to a query by one delegation, the International Bureau explained that, since the list of contents of the pamphlet under Rule 48.2 was comprehensive, information concerning a priority claim which had been considered void was included in Rule 48.2(a)(ix) even though such information was also referred to Rule 26 bis.2(d).

Rule 48.2(b)(v)

“31. The Chair noted that Rule 48.2(b)(v) should refer to Rule 26 bis.2(d) rather than Rule 26 bis.2(c).

Rule 49ter.1(a) and (b)

“32. Following a query by one delegation as to whether it was possible for a national law to provide for the restoration of the right of priority based on a criterion more favorable than the “unintentionality” criterion, as referred to in the Comment on Rule 49ter.1(b), another delegation suggested that, in practice, an Office would necessarily also accept, under such national law, decisions by a receiving Office based on the criterion of “unintentionality” and that the Comment was thus unnecessary. Another delegation suggested that a reference to more favorable requirements should be included in Rule 49ter.1(b) for consistency with Rule 49ter.2(e).

“33. One delegation suggested that, with a view to avoiding the need for transitional reservations under Rule 49ter.1(f) by States which did not wish to introduce provisions relating to the restoration of the right of priority into their national law, and to avoid an inequality between the provisions of Rule 49ter.1(a) and (b), Rule 49ter.1(a) should be restricted to any designated State whose applicable law provided for restoration of the right of priority based on the criterion of “due care”; alternatively, the words “whose applicable law provided for restoration of the right of priority based on that criterion” in Rule 49ter.1(b) should be deleted. That suggestion was opposed by one delegation. The Secretariat noted that, for consistency with the PLT, the proposal had been based on the general rule that Offices should provide for restoration of a right of priority on either the “due care” or the “unintentionality” criterion, any exception to that general rule being provided by way of transitional reservations.

Rule 49ter.1(c)

“34. One delegation, supported by another, expressed the view that the reference in Rule 49ter.1(c) to the requirements applied under Rule 26 bis.3 should be clarified so as to refer expressly to those procedural and substantive requirements for the restoration of the right of priority under Rule 26 bis.3, non-compliance with which would have the consequences provided for in Rule 49ter.1(c). The delegations suggested that the relevant requirements were those set out in Rule 26 bis.2(a)(i) and (ii) and the criterion applied by the receiving Office (“due care” or “unintentionality”).

Rule 49ter.1(f)

“35. Following a query by a delegation as to the nature of the effect of a reservation made by a designated Office under Rule 49ter.1(f), the Secretariat explained that such a

reservation would have both procedural and substantive effects. For example, there would be consequences both in terms of calculating the time limit for national phase entry before the designated Office concerned and in terms of the assessment of novelty and inventive step during the national search and examination. The Secretariat agreed that a Comment to that effect should be added to better clarify the effects of reservations under Rule 49ter.1(f).

“36. Another delegation noted that the reference in Rule 49ter.1(f) to “the national law applied by the designated Office” did not appear to apply to “a court or any other competent organ” as in Rule 49ter.1(c). The Secretariat noted that the same national law would presumably be applied by the designated Office and the courts in the designated State, and that it might therefore be preferable in Rule 49ter.1(f) to refer to the national law applied by the “designated State.” A representative of users noted that, in any event, the reference should be expressed so as to be clearly applicable in the case of a designated Office which was a regional Office.

Rule 49ter.2

“37. The Secretariat noted that comments made in respect of certain provisions of Rules 26bis.3 and 49ter.1 might also be relevant to corresponding provisions of Rule 49ter.2.

“38. In response to a query by a delegation, the Secretariat explained that the purpose of Rule 49ter.2 was to enable an applicant to request restoration of the right of priority during the national phase in any of the following cases: where the applicant had not requested such restoration during the international phase; where the receiving Office had made a reservation under Rule 26bis.3(h) and thus the possibility of requesting restoration was not available during the international phase; where the receiving Office did not provide for restoration on the relevant criterion; or where the receiving Office had refused a request for restoration during the international phase.

“39. In response to a query by another delegation, the Secretariat confirmed that it was intended to provide for the addition of priority claims only during the international phase (under Rule 26bis) and not during the national phase (unless such additions were possible under the national law itself), and the wording of proposed Rule 49ter.2 should be reviewed so as to ensure that it did not imply that such additions were enabled under the latter Rule.

Rule 49ter.2(g)

“40. One delegation suggested that reservations under Rule 49ter.2(g) should apply to at least paragraph (f) in addition to paragraph (a).

“41. The Secretariat explained that, although it was likely that a designated Office which made a reservation under Rule 49ter.1(f) would in practice also make one under Rule 49ter.2(g), there were circumstances in which a designated Office may need to make a reservation under only one of those Rules, for example, where its national law provided for restoration of the right of priority by the Office during the national procedure but did not put in place procedures enabling such restoration by its a PCT receiving Office.

“42. In response to a query by one delegation, the Secretariat agreed that the proposed Rule 49^{ter}.2(g) should be reviewed with a view to clarifying the basis of the calculation of the time limit referred to in that Rule, that is, whether the calculation should be on the basis of the priority date before or after restoration of the right of priority.”

5. While, at the sixth session of the Working Group, there was no agreement as to whether the proposals could be implemented without amending the Articles of the Treaty itself, the Working Group nevertheless agreed that the approach taken in the proposals should be further developed and invited the Secretariat to prepare revised proposals for consideration at its next session (see the summary of the sixth session by the Chair, paragraph 14, reproduced in paragraph 4, above).

6. Revised proposals for amendment of the Regulations relating to the restoration of the right of priority, taking into account the suggestions made at the sixth session (see document PCT/R/WG/6/12, paragraphs 7 to 42, reproduced in paragraph 4, above) and comments received on preliminary draft documents for these seventh session of the Working Group which had been made available for comment on the WIPO website as PCT/R/WG/7 Paper No. 2 and Paper No. 2 Rev., have been prepared by the International Bureau accordingly. The further revised proposals are contained in Annex I to this document. Article 13 and Rule 14 of the PLT are reproduced, for ease of reference, in Annex II.

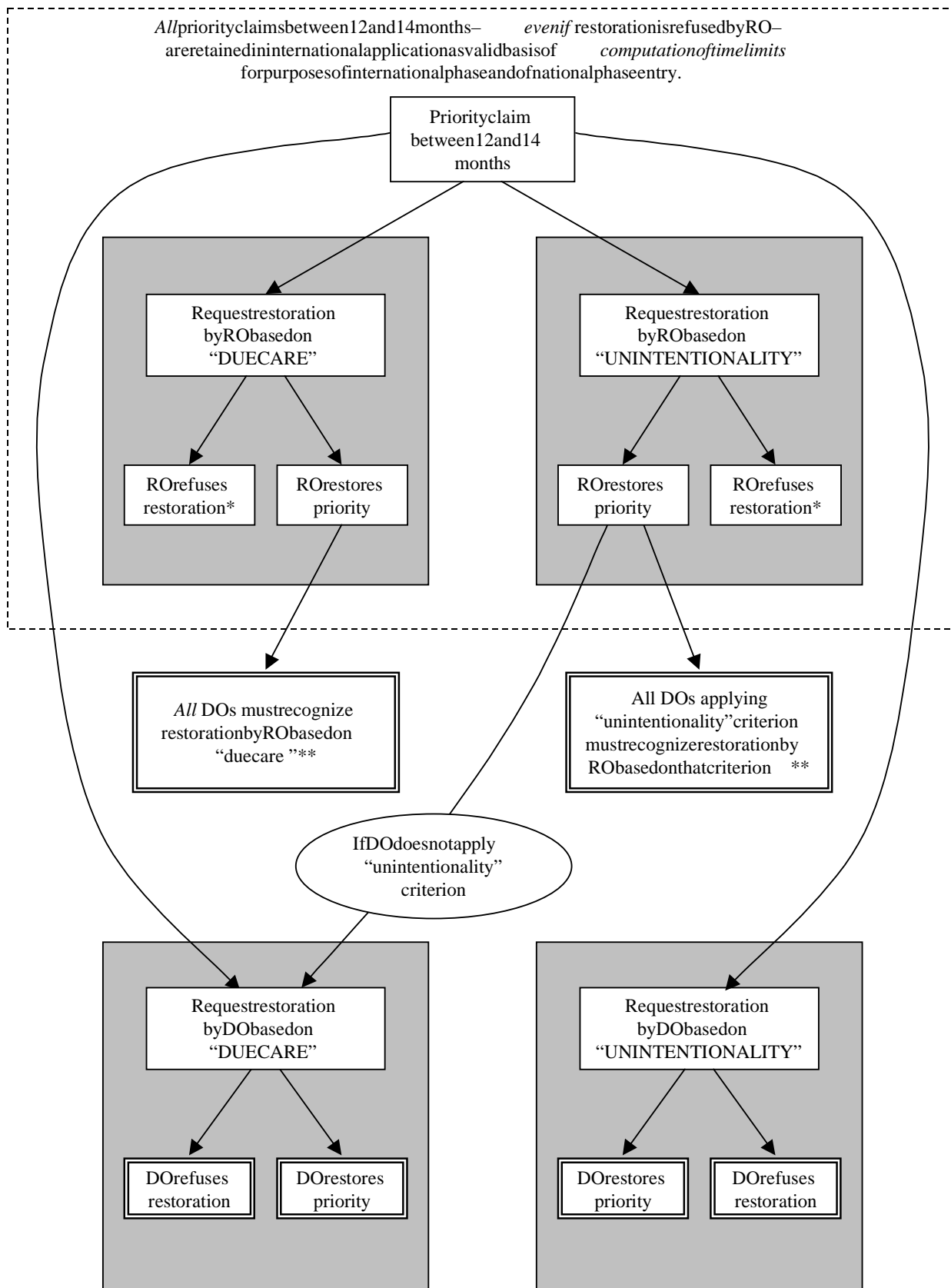
7. The main features of the revised proposals, which remain as outlined in document PCT/R/WG/6/12 and represented in the flow chart appearing on page 10, below, are outlined in the following paragraphs.

RESTORATION OF THE RIGHT OF PRIORITY

Automatic Retention of Priority Claim During International Phase

8. It is proposed to provide for the automatic retention, during the international phase, of a priority claim where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date. Such a priority claim would be retained irrespective of whether the applicant requests the receiving Office to restore the right of priority, and even where such a request is made but refused by the receiving Office. Such a priority claim would therefore be taken into account during the international phase for the purposes of international search and international preliminary examination, and for the purpose of the computation of time limits, including that for entry into the national phase. In other words, because of the automatic retention of the priority claim, the filing date of the earlier application whose priority is claimed would be the “priority date” under Article 2(xi) for the purpose of computing time limits, irrespective of whether or not the receiving Office restored the right of priority (provided, of course, that the priority claim in question is the only priority claim contained in the international application or, where several priority claims are contained in the application, provided that the priority claim in question relates to the earliest application whose priority is claimed). The effect of this would be that all limits under the Treaty and Regulations which are calculated on the basis of the priority date, including those for entry into the national phase under Articles 22(1) and 39(1)(b), would expire up to 14 months earlier than if the priority claim was considered not to have been made (“void”) (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 42).

RESTORATION OF RIGHT OF PRIORITY



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

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

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

9. As a general rule, and consistent with the PLT, any receiving Office would have to provide for the restoration of the right of priority during the international phase, any exception to that general rule being provided only by way of a transitional reservation by a receiving Office. The receiving Office, when deciding on a request for restoration, would be free to apply either the more strict criterion of “due care” or the less strict criterion of “unintentionality.” A receiving Office could also, if it wished, apply both criteria and leave the choice to the applicant as to which criterion is sought to be applied in a specific case. Furthermore, receiving Offices would also be free to apply, upon request of the applicant, first the “due care” criterion and, if the receiving Office finds that that criterion was not complied with, the “unintentionality” criterion. It is suggested that those understandings be expressed by the Assembly in amending the Regulations.

10. It would be advantageous for the applicant to obtain a positive finding by the receiving Office on the stricter criterion of “due care” since such a finding would be effective in all designated States, unlike a finding on the less strict “unintentionality” criterion (see paragraph 11, below).

Effect of Receiving Office Decision on Designated States

11. A decision by the receiving Office to restore a right of priority based on the criterion of “due care” would, as a general rule, be effective in all designated States. A decision by the receiving Office to restore a right of priority based on the criterion of “unintentionality” would be effective only in those designated States whose applicable national law provided for restoration of the right of priority based on that criterion or on a criterion which, from the viewpoint of applicants, was more favorable than that criterion.

12. However, a decision of a receiving Office to restore a right of priority would not be effective in a designated State in which the relevant provisions did not apply consequent to a notification that the provisions concerned were not compatible with its national law. It would also not be effective in a designated State if the designated Office, a court or any other competent organ found that a substantive requirement for restoration of the right of priority by the receiving Office had not been complied with. However, a decision of the receiving Office to restore a right of priority would not be ineffective in a designated State merely because a procedural requirement for such restoration had not been complied with, for example, because a required fee had not been paid.

Prior Art for the Purposes of International Search, the Establishment of the Written Opinion by the International Searching Authority and International Preliminary Examination

13. As explained in paragraph 8, above, under the proposals, the claimed priority date would be used throughout the international phase for the purpose of calculating time limits (for example, those for international publication and national phase entry), even if restoration of the right of priority was not requested by the applicant during the international phase or if restoration was requested but refused by the receiving Office, provided that the international application was filed within two months from the date on which the priority period expired.

14. At its fifth session, the Working Group noted that such retention of a priority claim did not affect the question of relevant prior art for the purposes of the international search under Rule 33, since the relevant date for the purposes of the international search was in any case the international filing date. In particular, it considered that no change to Rule 33.1(c) was needed since that Rule does not deal with the issue of written disclosures published earlier than the international filing date but later than the claimed priority date. Rather, that issue was covered by Section 507(d) of the Administrative Instructions (“Manner of Indicating Certain Special Categories of Documents Cited in the International Search Report”). With regard to international applications claiming the priority of an earlier application filed not within 12 months but within 14 months prior to the international filing date, consideration will be needed as to whether Section 507 should be modified so as to provide for a special code (say, letter “R” for “Restoration” (of the right of priority)) to identify, in the international search report (in addition to the letter “P” used in accordance with Section 507(d)), any document whose publication date occurred earlier than the international filing date of the international application but later than the priority date claimed in that application where that claimed priority date falls within the 2-month period between 12 months and 14 months prior to the international filing date.

15. At its fifth session, the Working Group also agreed to refer the question of relevant prior art for the purposes of the written opinion of the International Searching Authority (Rule 43bis.1) and the international preliminary examination (Rule 64) to the Meeting of International Authorities under the PCT (MIA) for consideration via its electronic forum, with a view to the development of a proposal for submission to the next session of the Working Group (see the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 35). Following consultation with the International Authorities via the MIA electronic forum, it is proposed to amend Rule 64.1(b) so as to clarify the “relevant date” for the purposes of Rule 64.1(a) where the international application claims the priority of an earlier application but has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date. By virtue of Rule 43bis.1(b), this date would also be the “relevant date” for the purposes of establishing the written opinion by the International Searching Authority.

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

16. As a general rule, and consistent with the PLT, any designated Office would have to provide for the restoration of the right of priority in the national phase, any exception to that general rule being provided only by way of a notification of incompatibility by a designated Office. As under the PLT and the provisions applicable to the receiving Office mentioned above, the national law applicable by the designated Office would have to provide for the restoration of the right of priority either on the basis of the more restrictive criterion of “due care” or the less restrictive criterion of “unintentionality.” A designated Office could, if it wished, apply both criteria and leave the choice to the applicant as to which criterion is sought to be applied in a specific case. Furthermore, a designated Office would also be free to apply, upon request of the applicant, first the “due care” criterion and, if the receiving Office finds that that criterion was not complied with, the “unintentionality” criterion. It is suggested that those understandings be expressed by the Assembly in amending the Regulations.

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

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

[Annex I follows]

ANNEXI

PROPOSED AMENDMENTS OF THE PCT REGULATIONS: ²

RESTORATION OF THE RIGHT OF PRIORITY

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² Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

Rule 2

Interpretation of Certain Words

2.1 to 2.3 [No change]

2.4 “Priority Period”

(a) Whenever the term “priority period” is used in relation to a priority claim, it shall be construed as meaning the period of 12 months from the filing date of the earlier application whose priority is so claimed. The day of filing of the earlier application shall not be included in that period.

(b) Rule 80.5 shall apply *mutatis mutandis* to the priority period.

[COMMENT: As suggested at the sixth session of the Working Group, it is proposed to define the term “priority period” in the Regulations (see Article 4C(2) of the Paris Convention) and to clarify that Rule 80.5 applies *mutatis mutandis* to the priority period (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 15). Note that the proposed definition would apply to all priority claims contained in an international application, that is, international applications claiming the priority of one or more earlier applications filed either in or for any country party to the Paris Convention or in or for any Member of the World Trade Organization that is not party to the Paris Convention (see present Rule 4.10(a)(ii)).]

Rule 4

The Request (Contents)

4.1 *Mandatory and Optional Contents; Signature*

(a) and (b) [No change]

(c) The request may contain:

(i) and (ii) [No change]

(iii) declarations as provided in Rule 4.17 .

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

(d) [No change]

4.2 to 4.9 [No change]

4.10 *Priority Claim*

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

(i) the date on which the earlier application was filed ~~, being a date falling within the period of 12 months preceding the international filing date~~;

[COMMENT: It is proposed to amend item (i) of paragraph (a) so as only to require the applicant to indicate the filing date of the earlier application. The question of whether the international application has been filed within the Paris Convention priority period (only then the priority claim would be valid) would be dealt with in Rule 26bis.2(a) as proposed to be amended (see below). See also the definition of the term “priority period” in proposed new Rule 2.4, above.]

(ii) to (v) [No change]

(b) to (d) [No change]

4.11 to 4.18 [No change]

Rule 26 bis

Correction or Addition of Priority Claim

26bis.1 [No change]

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

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

- (i) that the international application has an international filing date which is later than the date on which the priority period expired and that a request for restoration of the right of priority under Rule 26bis.3 has not been submitted;
or

[COMMENT: It is proposed to amend Rule 4.10(a)(i) (see above) and Rule 26bis.2(a) so as to expressly provide that the applicant should be invited to correct the priority claim where the international application has an international filing date which is later than the date on which the priority period expired and a request for restoration has not (yet) been submitted by the applicant. There appears to be no need for an invitation to correct a priority claim where a request for restoration of that right of priority 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 right of priority restored under Rule 26 bis.3, below.]

- (ii) that the priority claim does not comply with the requirements of Rule 4.10~~;~~

or

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

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

[COMMENT: As agreed by the Working Group at its sixth session, item (iii) has been further amended by deleting the reference to “the contents of” the corresponding indication (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 19).]

the receiving Office or the International Bureau, as the case may be, shall invite the applicant

to correct the priority claim. In the case referred to in item (i), where the international filing

date is within two months from the date on which the priority period expired, the receiving

Office or the International Bureau, as the case may be, shall also notify the applicant of the

possibility of submitting a request for the restoration of the right of priority in accordance

with Rule 26bis.3, unless the receiving Office has notified the International Bureau under

Rule 26bis.3(i) of the incompatibility of Rule 26bis.3(a) to (h) with the national law applied

by that Office.

[COMMENT: A notification of the possibility of submitting a request for the restoration of the right of priority would, of course, only be sent to the applicant where such a request had not already been made (“in the case referred to in item (i)” of paragraph (a)). Where the receiving Office has made a reservation under proposed Rule 26bis.3(i), the receiving Office or the International Bureau, as the case may be, would not be required to notify the applicant of the possibility of submitting the request for the restoration of the right of priority.]

[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,~~ that priority claim shall, subject to paragraph (c), for the purposes of the procedure under the Treaty, be considered not to have been made (“considered void”) and the receiving Office or the International Bureau, as the case may be, shall so declare and shall inform the applicant accordingly . Any notice correcting the priority claim which is received before the receiving Office or the International Bureau, as the case may be, so declares and not later than one month after the expiration of that time limit shall be considered to have been received before the expiration of that time limit. ~~provided that a~~

[COMMENT: The proposed deletion of the reference to “an invitation under paragraph (a)” is to provide for the situation in which no invitation has been sent under paragraph (a) because no address for service has been provided. The proposed deletion of the reference to Rule 4.10 is consequential on the amendment of that Rule proposed above. It is also proposed to define the phrase “considered not to have been made” so as to avoid, in paragraph (c) (see below) the use of a double negative (“shall *not* be considered *not* to have been made”). See also paragraphs 17 and 18 of the summary of the sixth session by the Chair, document PCT/R/WG/6/12). Furthermore, as had been suggested at the sixth session of the Working Group (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 18), it is proposed to further amend Rule 26bis.2(a) so as to provide that a notice received after the expiration of the time limit under Rule 26bis.1(a) should be considered to have been received in time if it was received before the receiving Office or the International Bureau had declared that the priority claim was considered not to have been made. However, noting that a decision as to the validity of a priority claim must be obtained prior to international publication, it is proposed that any such notice must be received not later than one month from the expiration of the applicable time limit under Rule 26bis.1(a).]

[Rule 26bis.2, continued]

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

[COMMENT: See the Comment on paragraph (b) as proposed to be amended, above.]

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

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

[COMMENT: As agreed by the Working Group at its sixth session, item (ii) has been further amended by deleting the reference to “the contents of” the corresponding indication (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 19).]

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

[COMMENT: Pursuant to item (iii), a priority claim contained in an international application whose international filing date is later than the date on which the priority period expired but within the period of two months from that date would automatically be retained, even if restoration of the right of priority was not requested by the applicant during the international phase or if restoration was requested but refused by the receiving Office. Such a priority claim would therefore be used throughout the international phase for the purpose of calculating time limits (for example, those for international publication and national phase entry) as well as for the determination of prior art in the context of establishing the written opinion by the International Searching Authority and the international preliminary examination report by the International Preliminary Examining Authority under Chapter II (see Rule 64.1(b) as proposed to be amended, below).]

[Rule 26bis.2, continued]

~~(d)~~ (e) Where the receiving Office or the International Bureau has made a declaration under paragraph (b) or where the priority claim has not been considered void only because paragraph (c) applies, the International Bureau shall ~~upon request made by the applicant and received by the International Bureau prior to the completion of the technical preparations for international publication, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions,~~ publish, together with the international application, information concerning the priority claim as prescribed by the Administrative Instructions which was considered not to have been made, as well as any information submitted by the applicant concerning such priority claim which is received by the International Bureau prior to the completion of the technical preparations for international publication. Such information ~~A copy of that request~~ shall be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3).

[COMMENT: See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 44. Under paragraph (d) as proposed to be amended, information concerning a priority claim which, in accordance with paragraph (b), is considered void would be published in all cases and not only upon request made by the applicant. Furthermore, information concerning a priority claim would also be published in all cases where the priority claim, in accordance with paragraph (c), was retained. The Administrative Instructions would have to be modified accordingly, taking into account a suggestion made at the sixth session of the Working Group that the information published under this paragraph should contain a clear indication as to whether a priority claim has been considered void under paragraph (b) or whether a priority claim has been retained under paragraph (c) (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 20). See also Rule 48.2 as proposed to be amended, below.]

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

(a) Where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the receiving Office shall, on the request of the applicant in accordance with paragraph (b), restore the right of priority if the Office finds that a criterion applied by it (“criterion for restoration”) is satisfied, namely, that the failure to file the international application within the priority period:

(i) occurred in spite of due care required by the circumstances having been taken;

or

(ii) was unintentional.

Each receiving Office shall apply at least one of those criteria and may apply both of them.

[COMMENT: See PLT Article 13(2) and PLTR Rule 14(4). See paragraph 9 in the main body of this document. Since it would not appear feasible to define or explain the terms “due care” and “unintentional” in the Regulations, it is proposed that, following adoption of the proposed amendments by the Assembly, the International Bureau should consider defining or explaining those terms in the Receiving Office Guidelines, taking into account any standards that are recurrently applied under the national laws applicable in Contracting States.]

[Rule 26bis.3, continued]

(b) A request under paragraph (a) shall:

(i) be filed with the receiving Office within the time limit applicable under paragraph (c);

(ii) state the reasons for the failure to file the international application within the priority period and preferably be accompanied by any declaration or other evidence required under paragraph (d);

[COMMENT: See PLT Article 13(2)(i) and (iii). See also proposed new paragraph (d), below.]

(iii) where a priority claim in respect of the earlier application is not contained in the international application, be accompanied by a notice under Rule 26bis.1(a) adding the priority claim; and

[COMMENT: See PLT Article 13(2)(i) and PLTR Rule 14(5)(ii).]

(iv) be accompanied by any fee for requesting restoration required under paragraph (e).

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

[Rule 26bis.3, continued]

(c) The time limit referred to in paragraph (b)(i) shall be two months from the date on which the priority period expired, provided that, where the applicant makes a request for early publication under Article 21(2)(b), any request under paragraph (a) or any notice referred to in paragraph (b)(iii) submitted, or any fee referred to in paragraph (b)(iv) paid, after the technical preparations for international publication have been completed shall be considered as not having been submitted or paid in time.

[COMMENT: See PLT Article 13(2)(ii) and PLTR Rule 14(4)(b). Upon further consideration, it is no longer proposed, as in previous drafts, that the time limit for furnishing a request for the restoration of the right of priority should be two months from the date on which the priority period expired or one month from the date of the notification under the last sentence of Rule 26bis.2(a), whichever expires later. As was noted at the sixth session of the Working Group (see summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 21), such a time limit would have allowed an applicant to request restoration of the right of priority much later than two months following the expiration of the priority period (example: the applicant, say, four months after the international filing date (the minimum time limit within which a priority may be added under Rule 26bis.1), adds a priority claim under Rule 26bis.1 with regard to an earlier application filed 14 months prior to the international filing date; the applicant is then notified under Rule 26bis.2(a) of the possibility of submitting a request for the restoration of the right of priority in accordance with Rule 26bis.3, triggering a time limit of one month from the date of that notification for requesting restoration of the right of priority). Rather, it is proposed to fix that time limit, as under PLTR Rule 14(4)(b), at simply “two months from the date on which the priority period expired” and to even shorten that time limit where the applicant requests early publication under Article 21(1)(b) (also as under PLTR Rule 14(4)(b)). Note that Rules 80.5 and 82 would apply to that time limit (see summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 22). The Administrative Instructions would have to be modified so as to require the International Bureau to notify the receiving Office of any request by the applicant for early publication and the (envisaged) date of completion of technical preparations for early international publication.]

[Rule 26bis.3, continued]

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

[COMMENT: See PLT Article 13(5). Note that the Working Group agreed at its fifth session that the question of what information or evidence each receiving Office was entitled to require in support of a request for restoration of the right of priority should be left to national law and practice (see the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 49). This agreement was affirmed by the Working Group at its sixth session. It was also noted that an understanding to that effect could, if desired, be reflected in a report of the Assembly in adopting the proposed amendment (see summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 23). In order to promote consistency of standards as regards declarations and evidence which would be acceptable under this paragraph, it is proposed that, following the adoption of the proposed amendments by the Assembly, the International Bureau should consider defining or explaining the term “a declaration or other evidence in support of the statement of reasons” in the Administrative Instructions and/or Receiving Office Guidelines and promoting the sharing of relevant decisions, taking into account any standards that are currently applied under the national laws applicable in Contracting States (see summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraphs 24 and 25).]

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

[COMMENT: See PLT Article 13(4). As noted by the Working Group at its fifth session, under Rule 26bis.3(c), an Office which provided for restoration on both the criterion of “unintentionality” and the criterion of “due care” would be free to charge different fees in respect of the two cases (see the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 48).]

[Rule 26bis.3, continued]

(f) The receiving Offices shall not refuse, totally or in part, a request under paragraph (a) without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances. Such notice of intended refusal by the receiving Office may be sent to the applicant together with any invitation to file a declaration or other evidence under paragraph (d).

[COMMENT: See PLT Article 13(6). Note that, since the PCT is generally silent on such matters, the availability of hearings and appeals in respect of decisions by the receiving Office under paragraph (f) is neither required nor precluded by the Treaty but is left to national law and practice (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 27).]

(g) The receiving Offices shall promptly:

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

(ii) make a decision upon the request;

(iii) notify the applicant and the International Bureau of its decision and the criterion for restoration upon which the decision was based.

(h) Each receiving Office shall inform the International Bureau of which of the criteria for restoration it applies. The International Bureau shall promptly publish such information in the Gazette.

[Rule 26bis.3, continued]

(i) If, on [date of adoption of these modifications by the PCT Assembly], paragraphs (a) to (h) are not compatible with the national law applied by the receiving Office, those paragraphs and the last sentence of Rule 26bis.2(a) shall not apply to that receiving Office for as long as paragraphs (a) to (h) continue 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: At the sixth session of the Working Group, a number of delegations confirmed that the need for a reservation provision applicable to receiving Offices as proposed in paragraph (i) so as to afford time for the provisions of the applicable national law, such as those enabling the Office to require the payment of a fee for restoration of the right of priority, to be adapted to the new system (see summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 28). Note, however, that a Contracting State could only take advantage of such provision if its national law contained provisions addressed to its national Office in its capacity as a PCT receiving Office (and not only in its capacity as a national Office, or as a designated or elected Office) which were not compatible with the proposed amendments of the PCT Regulations. For a reservation for national Offices in their capacities as designated or elected Offices, see Rule 49ter.1(f) and 49ter.2(g).]

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

(a) The pamphlet shall contain:

(i) to (viii) [No change]

(ix) any information concerning a prior ity claim referred to in Rule 26bis.2(d)
~~considered not to have been made under Rule 26bis.2(b), the publication of which is~~
~~requested under Rule 26bis.2(c),~~

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

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

[Rule 48.2, continued]

[COMMENT: Since the list of contents of the pamphlet under Rule 48.2 is comprehensive, information concerning a priority claim which had been considered void under Rule 26bis.2(b), or which had not been considered void because Rule 26bis.2(c) applied, is included in item (ix) even though such information was also referred to in Rule 26bis.2(d) (see summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 30).

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

(i) to (iii) [No change]

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

(v) where applicable, an indication that the pamphlet contains information under Rule 26bis.2(d).

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

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

(c) to (i) [No change]

[Rule 48.2, continued]

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

48.3 to 48.6 [No change]

Rule 49 ter

Effect of Restoration of Right of Priority by Receiving Office;

Restoration of Right of Priority by Designated Office

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

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

[COMMENT: See paragraph 11 of the Introduction to this document. Note that, for consistency with the PLT, the proposal is based on the general rule that Offices should provide for restoration of a right of priority on either the “due care” or the “unintentionality” criterion, any exception to that general rule being provided by way of reservations (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 33). As regards a reservation provision, see paragraph (f) and Rule 49ter.2(g), below.]

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

[COMMENT: See paragraph 11 of the Introduction to this document. The reference to a criterion which is more favorable than the “unintentionality” criterion has been included to clarify that restoration by the receiving Office would also be effective in any designated State

[Rule 49ter.1(b), continued]

whose applicable national law provided for the restoration of the right of priority based on a criterion more favorable than the “unintentionality” criterion (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 32). As regards a transitional reservation provision, see paragraph (f) and Rule 49ter.2(g), below.]

(c) A decision by the receiving Office to restore a right of priority under Rule 26bis.3 shall not be effective in a designated State where the designated Office, a court or any other competent organ of that designated State finds that a requirement of any of Rule 26bis.3(a) or (b)(i) or (iii) was not complied with, taking into account the reasons stated in the requests submitted to the receiving Office under Rule 26bis.3(a) and any declaration or other evidence filed with the receiving Office under Rule 26bis.3(b)(ii).

[COMMENT: See the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 34. It is proposed that a competent authority in the designated State should be permitted to consider a decision by a receiving Office to restore a right of priority to be not effective in that designated State only if it finds that there was non-compliance with a requirement of any of Rule 26bis.3(a) or (b)(i) or (iii). Accordingly, a competent authority could not consider a decision by the receiving Office to restore a right of priority to be not effective in that designated State on a finding that, for example, a fee required under Rule 26bis.3(e) was not paid. Note that a finding of non-compliance could not be made merely because the information or evidence required by the receiving Office was not the same kind of information or evidence as that required by the designated Office under its national law; instead, such a finding could only be made on the basis of the information or evidence as furnished to the receiving Office (see the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 54). The proposed wording “the designated Office, a court or any other competent organ of that designated State” is modeled on Article 27(4).]

[Rule 49ter.1, continued]

(d) A designated Office shall not review the decision of the receiving Office unless it may reasonably doubt that a requirement referred to in paragraph (c) was complied with, in which case the designated Office shall notify the applicant accordingly, indicating the reasons for those doubts and giving the applicant an opportunity to make observations within a reasonable time limit.

[COMMENT: Note that the requirement for reasonable doubt applies only to designated Offices in order not to fetter the courts or any other competent organs of the designated States in the exercise of their discretion under national law.]

(e) A non-designated State shall be bound by a decision of the receiving Office refusing a request under Rule 26bis.3 for restoration of the right of priority.

[COMMENT: See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 54.]

(f) Where the receiving Office has refused a request for the restoration of the right of priority, any designated Office may consider that request to be a request for restoration submitted to that designated Office under Rule 49ter.2(a) within the time limit under that Rule.

[COMMENT: See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 56. Note, however, that, in order for the request to be considered by the designated Office, it must comply with certain requirements (such as the furnishing of reasons, which the request filed during the international phase may not have complied with) and a fee may have to be paid to the designated Office (see Rule 49ter.2(a)(ii), below).]

[Rule 49ter.1, continued]

(g) If, on [date of adoption of these modifications by the PCT Assembly], paragraphs (a) to (d) are not compatible with the national law applied by the designated Office, those paragraphs shall not apply in respect of that Office for as long as they continue to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [three months from the date of adoption of these modifications by the PCT Assembly]. The information received shall be promptly published by the International Bureau in the Gazette.

[COMMENT: A designated Office whose applicable national law did not provide for the restoration of the right of priority at all or did provide for the restoration of the right of priority based on a more stringent criterion than the “due care” criterion would have to make use of the reservation provision under paragraph (g) and also of the reservation provision under Rule 49ter.2(g). In view of the definition of the term “national law” in Article 2(x) (“reference to “national law” shall be construed as reference to the national law of a Contracting State...”), and for consistency with the wording of other reservation provisions throughout the Regulations (all of which refer to the “national law applied by the designated Office”), it is not proposed, as had been suggested at the sixth session (see summary of the sixth session by the Chair in document PCT/R/WG/6/12, paragraph 36), to refer to the “national law of a designated State” instead of the “national law applied by the designated Office.” Note that Article 2(x) also clarifies that, where a regional application or regional patent is involved, the reference to “national law” is construed as a reference to the treaty providing for the filing of regional applications or the granting of regional patents. Note further that a reservation under this paragraph would have both procedural and substantive effects; for example, there would be consequences both in terms of calculating the time limit for national phase entry before the designated Office concerned and in terms of the assessment of novelty and inventive step during the national search and examination (see summary of the sixth session by the Chair in document PCT/R/WG/6/12, paragraph 35).]

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

(a) Where the international application has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the designated Office shall, on the request of the applicant in accordance with paragraph (b), restore the right of priority if the Office finds that a criterion applied by it (“criterion for restoration”) is satisfied, namely, that the failure to file the international application within the priority period:

(i) occurred in spite of due care required by the circumstances having been taken;

or

(ii) was unintentional.

Each designated Office shall apply at least one of those criteria and may apply both of them.

[COMMENT: See paragraph 16 in the main body of this document.]

(b) A request under paragraph (a) shall:

(i) be filed with the designated Office within a time limit of one month from the applicable time limit under Article 22;

[Rule 49ter.2(b), continued]

(ii) state the reasons for the failure to file the international application within the priority period and preferably be accompanied by any declaration or other evidence required under paragraph (c); and

(iii) be accompanied by any fee for requesting restoration required under paragraph (d).

[COMMENT: As had been suggested in the sixth session of the Working Group (see the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 39), proposed new Rule 49ter.2 has been reviewed with a view to whether its wording implies that it would be possible, based on that Rule, to add a priority claim in the national phase where that priority claim was not contained in the international application as filed and has not been added during the international phase under Rule 26bis. Upon review, however, that does not appear to be the case. As at present, it is a question of the national law applicable by the designated Office whether it is possible, in such a case, to add a priority claim and to request the designated Office to restore the right of priority with regard to that priority claim. As regards the computation of the time limit for entry into the national phase under Article 22(1), see paragraph 8 of the Introduction.]

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

(d) The submission of a request under paragraph (a) may be subjected by the designated Office to the payment to it, for its own benefit, of a fee for requesting restoration.

[Rule 49ter.2, continued]

(e) The designated Offices shall not refuse, totally or in part, a request under paragraph (a) without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances. Such notice of intended refusal may be sent by the designated Office to the applicant together with any invitation to file a declaration or other evidence under paragraph (d).

(f) Where the national law applicable by the designated Office provides, in respect of the restoration of the right of priority, for requirements which, from the viewpoint of applicants, are more favorable than the requirements provided for under paragraphs (a) and (b), the designated Office may, when determining the right of priority, apply the requirements under the applicable national law instead of the requirements under those paragraphs.

(g) Each designated Office shall inform the International Bureau of which of the criteria for restoration it applies and, where applicable, of the requirements of the national law applicable in accordance with paragraph (f). The International Bureau shall promptly publish such information in the Gazette.

[Rule 49ter.2, continued]

(h) If, on [date of adoption of these modifications by the PCT Assembly], paragraphs (a) to (g) are not compatible with the national law applied by the designated Office, those paragraphs shall not apply to that designated Office for as long as they continue 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: See the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraphs 40 and 41. Any designated Office whose national law provided for a criterion more stringent than the “due care” criterion or did not provide for restoration of the right of priority at all could make use of the reservation provision under proposed new paragraph (h). Designated Offices whose applicable national law provided for the restoration of the right of priority based on requirements similar but not identical to the requirements under Rule 49ter.2(a) and (b) would not need to make use of the reservation provision, provided the requirements under the applicable national law were, from the viewpoint of applicants, at least as favorable as the requirements under Rule 49ter.2(a) and (b). It is suggested that this understanding be expressed by the Assembly in amending the Regulations.]

Rule 64

Prior Art for International Preliminary Examination

64.1 *Prior Art*

(a) [No change]

(b) For the purposes of paragraph (a), the relevant date will be:

(i) subject to item s(ii) and (iii), the international filing date of the international application under international preliminary examination;

(ii) where the international application under international preliminary examination ~~validly~~ claims the priority of an earlier application and has an international filing date which is within the priority period, the filing date of such earlier application , unless the International Preliminary Examining Authority considers that the priority claim is not valid;

(iii) where the international application under international preliminary examination claims the priority of an earlier application and has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the filing date of such earlier application, unless the International Preliminary Examining Authority considers that the priority claim is not valid for reasons other than the fact that the international application has an international filing date which is later than the date on which the priority period expired.

[Rule 64.1(b), continued]

[COMMENT: See paragraph 15 of the Introduction to this document.]

64.2 and 64.3 [No change]

Rule 76

Translation of Priority Document;

Application of Certain Rules to Procedures Before Elected Offices

³

76.1, 76.2 and 76.3 [Remain deleted]

76.4 [No change]

76.5 *Application of Certain Rules to Procedures Before Elected Offices*

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

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

(i) to (v) [No change]

³ The present text of Rule 76 is as adopted by the Assembly on October 5, 2004, with effect from April 1, 2005.

Rule 82 *ter*

**Rectification of Errors Made by the
Receiving Office or by the International Bureau**

82ter.1 Errors Concerning the International Filing Date and the Priority Claim

If the applicant proves to the satisfaction of any designated or elected Office that the international filing date is incorrect due to an error made by the receiving Office or that the priority claim has been erroneously considered void by the receiving Office or the International Bureau ~~not to have been made~~, and if the error is an error such that, had it been made by the designated or elected Office itself, that Office would rectify it under the national law or national practice, the said Office shall rectify the error and shall treat the international application as if it had been accorded the rectified international filing date as if the priority claim had not been considered void ~~not to have been made~~.

[COMMENT: The proposed amendment of Rule 82 *ter.1* is consequential on the proposed amendment of Rule 26bis.2(b) (see above; see also the summary of the sixth session by the Chair, document PCT/R/WG/6/12, paragraph 17). Note that present Rule 82 *ter.1* is proposed to be further amended in the context of proposed amendments of the Regulations relating to the restoration of missing elements and parts of the international application (see PCT/R/WG/7/2).]

[Annex II follows]

ANNEXII

ARTICLE13ANDRULE14OFTHEPATENTLAWTREATY(PLT)

Article13

CorrectionorAdditionofPriorityClaim;RestorationofPriorityRight

(1) [*CorrectionorAdditionofPriorityClaim*] Exceptwhereotherwise prescribedin theRegulations,aContractingPartys shallprovideforthe correctionoradditionofapriority claimwithrespecttoanapplication(“thesubsequentapplication”),if:

- (i) arequesttothateffectismadetotheOfficeinaccordancewith the requirementsprescribedintheRegulations;
- (ii) therequestisfiledwithinthetimelimitprescribedintheRegulations;and
- (iii) thefilingdateofthesubsequentapplicationisnotlaterthanthedateofthe expirationofthepriorityperiod calculatedfromthefilingdateoftheearliestapplication whosepriorityisclaimed.

(2) [*DelayedFilingoftheSubsequentApplication*] Takingintoconsideration Article15,aContractingPartys shallprovidethat,whereanapplication(“thesubsequent application”)whichclaimsorcouldhaveclaimedthepriorityofanearlierapplicationhasa filingdatewhichislaterthanthedateonwhichthepriorityperiodexpired,butwithinthe timelimitprescribedintheRegulations,theOfficeshallrestore therightofpriority,if:

- (i) arequesttothateffectismadetotheOfficeinaccordancewiththe requirementsprescribedintheRegulations;
- (ii) therequestisfiledwithinthetimelimitprescribedintheRegulations;
- (iii) therequeststatest hereasonsforthefailuretocomplywiththepriority period;and
- (iv) theOfficefindsthatthefailuretofilethesubsequentapplicationwithinthe priorityperiodoccurredinspiteofduocarerequiredbythecircumstanceshavingbeentaken or,at theoptionoftheContractingParty,wasunintentional.

(3) [*FailuretoFileaCopyofEarlierApplication*] AContractingPartys shallprovide that,whereacopyofanearlierapplicationrequiredunderArticle6(5)isnotfiledwiththe Officewithinth etimelimitprescribedintheRegulationspursuanttoArticle6,theOffice shallrestorertherightofpriority,if:

- (i) arequesttothateffectismadetotheOfficeinaccordancewiththe requirementsprescribedintheRegulations;
- (ii) therequest isfiledwithinthetimelimitforfilingthecopyoftheearlier applicationprescribedintheRegulationspursuanttoArticle6(5);

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

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

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

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

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

Rule 14

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

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

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

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

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

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

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

(i) be signed by the applicant; and

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

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

(i) be signed by the applicant; and

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

(b) A Contracting Party may require that:

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

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

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

[End of Annex II and of document]