



Mastering priority claims in PCT applications

WIPO PCT Webinar Series

Session 4

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What we will cover....

- What priority claims can be made and how
- Legal basis and background
- Correction and addition of priority claims
- Furnishing of priority documents

Poll questions



Claiming priority (PCT Article 8, Rule 4.10)

- The international application may contain a declaration claiming the priority of one or more earlier applications
 - filed in or, by way of a regional or international application, for any country party to the Paris Convention and/or
 - filed in any Member of the World Trade Organization (WTO) that is not party to the Paris Convention

Contents of priority claims (Rule 4.10)

- Filing date
- Application number
- Country or regional/receiving Office

PRIORITY CLAIMS

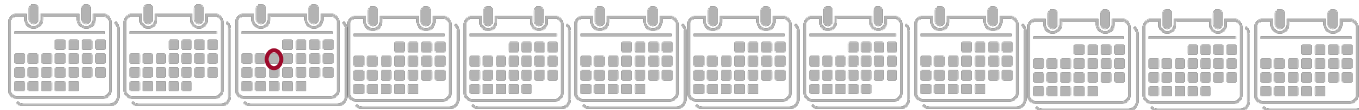
Add

Type *	▼	Option(s) for providing the priority document to the IB * <input type="radio"/> Receiving Office to prepare and transmit to the International Bureau <input checked="" type="radio"/> To be provided by the applicant <input type="radio"/> An electronic copy of the priority document (certified by the issuing Office) will be submitted with this data package at the time of filing <input type="radio"/> International Bureau to obtain from a digital library (DAS) <input type="checkbox"/> The receiving Office is requested to restore the right of priority for this earlier application.
National		
Country/Office *	▼	
Filing Date *	📅	
Application number		

Cancel OK

The right of priority (1)

(Article 4 of the Paris Convention)



The right of priority (2)

(Article 4 of the Paris Convention)

- For prior art purposes, the effective date of the later applications = filing date of the first application
- The right of priority can be based only on the first filed application on the subject matter (see Paris Convention Art.4C(4) for exception)
- The later applications must concern the same subject matter
- Withdrawal, abandonment or rejection of the first application does not destroy its capacity to serve as a basis for priority
- Multiple and partial priorities possible

Priority date for computing time limits (PCT Article 2(xi))

- One priority claim → the filing date of the priority application
- Several priority claims → the filing date of the earliest priority application
- No priority claim → the international filing date

Loss of priority claim

- Withdrawal by applicant
- Declaration by RO or IB that priority claim is considered not to have been made (“considered void”)
- Decision by DO/EO:
 - for procedural reasons (e.g. no priority document)
 - for substantive reasons (e.g. not the same subject matter, no right to claim priority)

Correction/addition of priority claims affecting the priority date (Rule 26*bis*) (1)

■ Cases concerned:

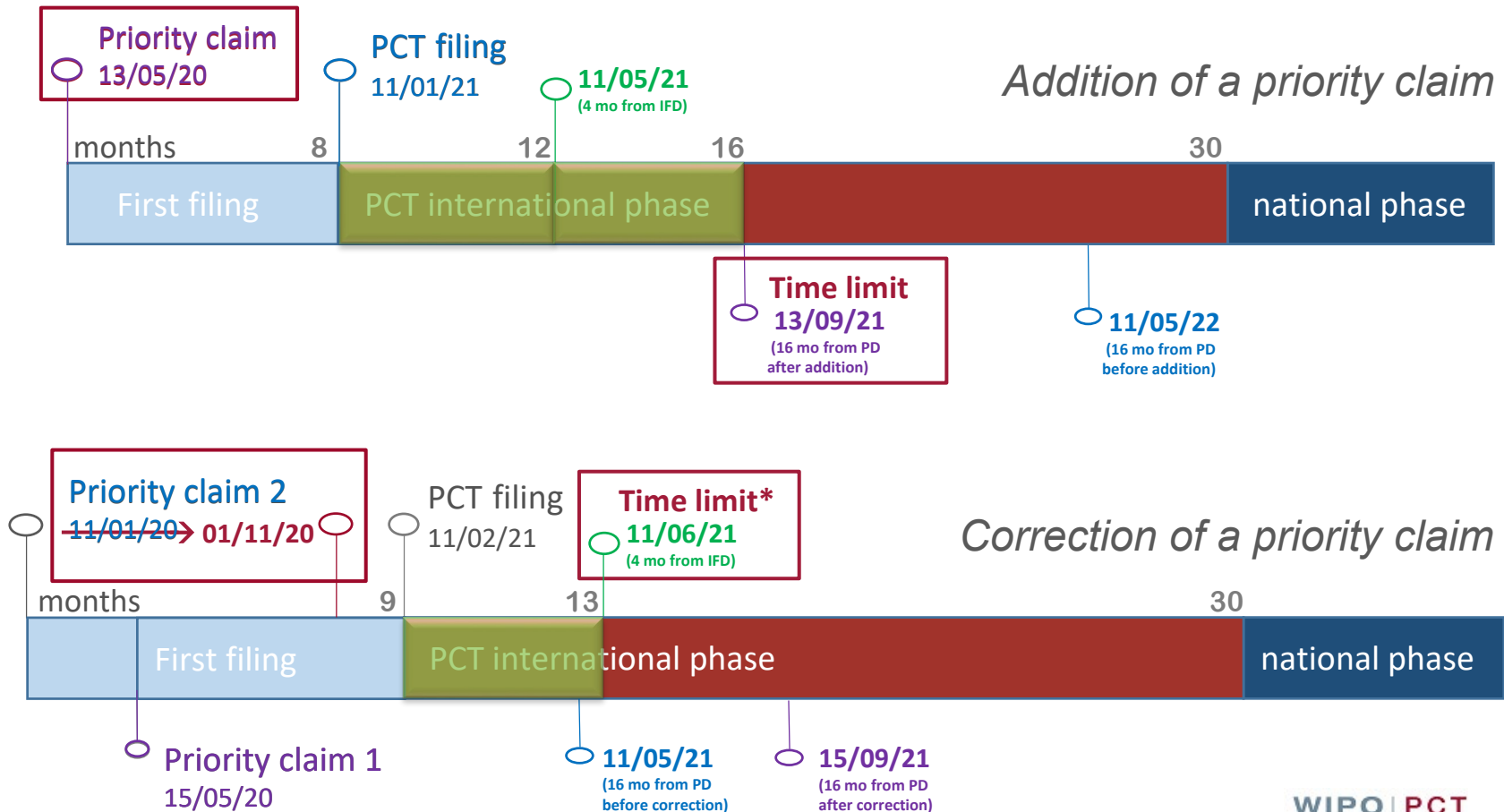
- adding a priority claim with an earlier filing date than any priority claim present in the application
- correction of the filing date of the earliest priority claim

Correction/addition of priority claims affecting the priority date (Rule 26bis) (2)

■ Applicable time limit:

- ❑ 4 months from the international filing date; or
- ❑ later if the earlier of the following two time limits expires after the 4-month time limit:
 - 16 months from the priority date before the correction or addition
 - 16 months from the priority date after the correction or addition
- ❑ any correction received before the RO or IB has declared the priority claim void and not later than one month after the expiration of the above time limit, will be considered as timely received (Rule 26bis.2(b))

Correction/addition of priority claims affecting the priority date (Rule 26bis) (3)



* +1 mo for correction

Correction/addition of priority claims not affecting the priority date (Rule 26*bis*) (1)

■ Cases concerned:

- corrections which do not affect the filing date of the priority claim
- adding a priority claim with a later filing date than the earliest priority claim present in the application (e.g., second priority claim)
- corrections of the filing date of a priority claim which is not the earliest one

Correction/addition of priority claims not affecting the priority date (Rule 26*bis*) (2)

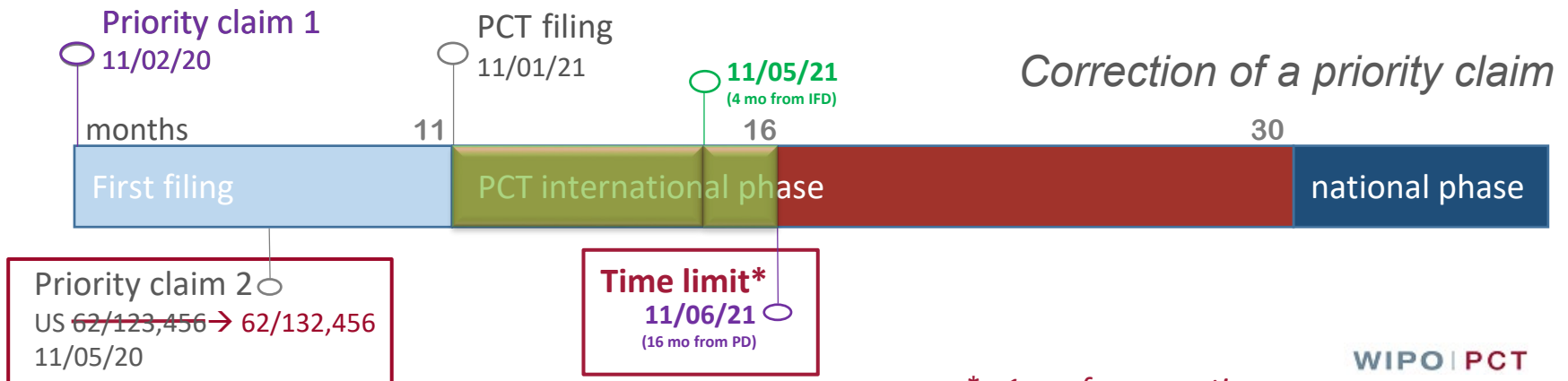
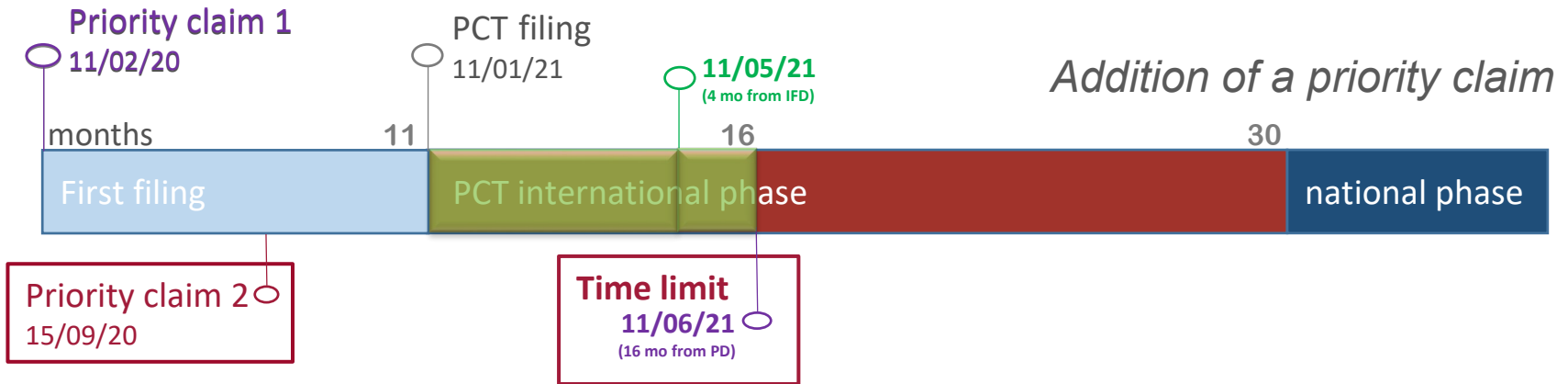
■ Applicable time limit:

- 4 months from the international filing date; or
- 16 months from the priority date, whichever time limit expires later
- any correction received before the RO or IB has declared the priority claim to be void and not later than one month after the expiration of the above time limit, will be considered as timely received (Rule 26*bis*.2(b))

NOTE: This does not apply to late additions of priority claims

- Rule 91: 26 months from the priority date

Correction/addition of priority claims not affecting the priority date (Rule 26bis)(3)



* +1 mo for correction

PCT Time Limit Calculator

The PCT Time Limit Calculator assists applicants in the computing of essential PCT Time Limits.

Main Time Limits	Correct / Add Priority	Amended Claims	Demand	Suppl. Int. Search	Withdrawal	Record Changes	Other
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To calculate the time limit for correcting or adding a priority claim, please enter the earliest priority date, the priority date as proposed to be changed and the international filing date.

	DD	MM	YYYY
Earliest Priority Date	13	01	2021
Priority Date as Changed	15	05	2020
International Filing Date	13	01	2021

[Calculate](#) [Reset](#)

Time Limit
Time Limit for Correction or Addition of Priority Claim ([Rule 26bis](#)) 15 September 2021

[Summary \[Print\]](#)

Disclaimer	PCT Timelines [PDF]	Time Limits for Entering National/Regional Phase	PCT Reservations and Incompatibilities	Office Closed Dates
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Invitation to correct by RO or IB (1)

■ Forms:

- receiving Office: Form PCT/RO/110
- International Bureau: Form PCT/IB/316

■ Invitation (Rule 26*bis*.2(a)) is issued if:

- priority claim does not comply with requirements of Rule 4.10 (something is incorrect or missing)
- indication in the priority claim is inconsistent with the corresponding indication appearing in the priority document
- International filing date falls outside the priority period

Invitation to correct by RO or IB (2)

- Also alerts the applicant of the possibility to request restoration of the priority right (Rule 26*bis*.3) if the international filing date is within two months from the expiration of the priority period
- If the applicant does not correct the priority claim in response to the invitation, the priority claim concerned will be considered void, for the purposes of the procedure under the PCT (Rule 26*bis*.2(b))

Invitation to correct by RO or IB (3)

- However, a priority claim will not be considered void only because (Rule 26*bis*.2(c)) :
 - the indication of the number of the earlier application is missing; or
 - an indication in the priority claim is not the same as the corresponding indication appearing on the priority document; or
 - the international filing date is outside of the priority period but within two months from the expiration of the priority period

Publication related to priority claims (1)

- Information concerning a priority claim considered void or only not considered void because of Rule 26*bis*.2(c):
 - the International Bureau publishes such information, free of charge, together with any information furnished by the applicant concerning the priority claim (Rule 26*bis*.2(d))

Publication related to priority claims (2)

- Correction and addition of priority claims received after the time limit:
 - applicant may request the International Bureau (Rule 26*bis*.2(e)) to publish information concerning the priority claim concerned:
 - within 30 months from priority date; and
 - subject to the payment of a fee

Effect in the national phase

- Designated Offices can revive a priority claim considered void by the receiving Office
- Warning to third parties: different priority dates may apply in different designated States (Rules 26*bis*.2(d) and 48.2(a)(ix))

Furnishing of priority documents (Rule 17.1)

- The applicant must provide a priority document for each corresponding priority claim (a certified copy of the earlier application)
 - furnish directly to the receiving Office or the International Bureau (Rule 17.1(a)); or
 - request the receiving Office to prepare and transmit to the IB (Rule 17.1(b)), if the earlier application was filed with that Office; or
 - request the IB to obtain the priority document from a digital library (Rule 17.1(b-*bis*)) (only for Offices participating in the Digital Access Service (DAS))

Requesting DAS p-doc retrieval

PRIORITY CLAIMS

Add

Type *	National	▼	Option(s) for providing the priority document to the IB * <input type="radio"/> Receiving Office to prepare and transmit to the International Bureau <input type="radio"/> To be provided by the applicant <input type="radio"/> An electronic copy of the priority document (certified by the issuing Office) will be submitted with this data package at the time of filing <input checked="" type="radio"/> International Bureau to obtain from a digital library (DAS)
Country/Office *	US - United States of America	▼	
Filing Date *	29/10/2019	📅	
filing date does not match for US - 61/274654 in DAS.			DAS access code * 1234
Application number * 61/274654			<input type="checkbox"/> The receiving Office is requested to restore the right of priority for this earlier application.
format should be "08/999.999"			

Cancel OK

Time limit for the furnishing of priority documents (Rule 17.1)

- Direct submission by the applicant to the RO:
 - within 16 months from the priority date
- Direct submission by the applicant to the IB:
 - before international publication
- Request to the RO to prepare and transmit the priority document to the IB:
 - within 16 months from the priority date
- Submission via DAS to IB:
 - The priority document must be made available to the IB via DAS and the request to the IB to retrieve the priority document must be made before international publication

Poll answers



Questions?



PCT Resources

■ General questions about the PCT

□ Contact the PCT Information Service:

Telephone: +41 22 338 83 38

E-mail: pct.infoline@wipo.int

■ Questions about the ePCT

□ Contact PCT eServices Help Desk:

Telephone: +41 22 338 95 23

E-mail: pct.eservices@wipo.int

■ Subscribe to WIPO Newsletters

<https://www.wipo.int/newsletters>

Thank you!



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complete the
survey