

WIPO



PCT/R/WG/4/1
ORIGINAL:English
DATE:March25,2003

E

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)

Fourth Session
Geneva, May 19 to 23, 2003

OPTIONS FOR RESTORATION OF THE RIGHT OF PRIORITY:

“UNINTENTIONALITY” CRITERION; “DUE CARE” CRITERION;
RETAIN PRIORITY CLAIM FOR INTERNATIONAL PHASE LEAVING
RESTORATION FOR NATIONAL PHASE

Document prepared by the International Bureau

BACKGROUND

1. At its first and second sessions, the Working Group considered proposals for amendment of the Regulations under the PCT¹ relating, as recommended by the Committee on Reform of the PCT (“the Committee”), to changes necessary or desirable to bring the requirements under the PCT into line with the letter and spirit of the Patent Law Treaty (PLT) (see the report of the first session of the Committee, document PCT/R/26, paragraphs 72 to 74).

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.

2. TherewaswideagreementatthefirstsessionoftheWorkingGrouponthegeneral approachtotaken(see documentPCT/R/WG/1/9, paragraph21). Amongthematters agreedwasthat(see paragraph21(v)):

“priorityshouldbegivenbytheWorkingGrouptothosematterswhichwouldresultin thegreatestandmostimmediatepracticalbenefitsforusers, havingregardalsotothe degreeofcomplexityinvolvedandtoworkloadimplicationsforOfficesand Authorities;forexample, prioritymightbegiventothefollowing:

– provisionsforrestorationofthepriorityrightincertaincircumstances;

....”

3. TheproposalspreparedbytheInternationalBureauforconsiderationatthefirstsession oftheWorkingGroupincludedprovisionsforrestorationoftherightofprioritysimilar tothoseinthePLT(see documentPCT/R/WG/1/5, AnnexIII). TheWorkingGroup’s discussionsareoutlinedindocumentPCT/R/WG/1/9, paragraphs22and23:

“22. DiscussionswerebasedondocumentPCT/R/WG/1/5, andin particularon proposednewRule26 *bis*.3, containedinAnnexIIItothatdocument, whichwould provideforrestorationofthepriorityrightforuptotwomonthsbeyondtheusual 12-monthpriorityperiod. Thecommentsandconcernsexpressedbyvarious delegationsincludedthefollowing:

(i) therewasgeneralagreementwiththeideaofprovidingforameansof restorationofpriorityrights, consistentlywithcorrespondingprovisionsofthePLT, duringtheinternationalphaseofthePCTprocedure;

(ii) notingthattheadministrationofthoseprovisionsinthenationalphase wouldbeamatterforROs[receivingOffices], theimportanceofasinglestandard, orat leastconsistentpractice, amongthevariousROswasemphasizedbyseveral delegations;

(iii) delegationsdifferedintheirviewsastotheappropriatecriterionwhich shouldapplyinthecontextofthePCT(underRule26 *bis*.3(a)(iii))incaseswherethe applicantfailedtofiletheinternationalapplicationwithinthe12-monthpriorityperiod, notingthatthePLTprovidedforContractingPartiestochoosebetweentwocriteria:

– mostdelegationsfavoredadoptingthemoreliberalcriterionof “unintentional”failureinthecontextofthePCT;

– certaindelegationsfavoredadoptingthemorestrictcriterionof“duecare”;

– certaindelegationsfavoredgivingROsachoiceastowhichofthetwo criteriatoapply, aswouldbethecaseforContractingPartiestothePLT;

(iv) itwasrecognizedbytheWorkingGroupthatprovisionforrestorationofthe priorityrightintheinternationalphaseimpliedthattheRO’sdecisionwouldneedto haveeffectforthepurposesofthenationalphase;

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

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

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

– “procedural” in the sense that certain important time limits under the PCT were recalculated by reference to the priority date;

– “substantive” in the sense that it was at the priority date that it would be determined whether the invention satisfied the requirements of novelty and inventive step (non-obviousness);

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

(ix) the fact that a considerable number of countries' national laws did not presently provide for restoration of priority rights, at least according to PLT criteria, suggested that transitional reservations would need to be allowed for if restoration provisions were to be introduced under the PCT.

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

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

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

4. Revised proposals relating to the reinstatement of right of priority were prepared by the International Bureau for consideration by the Working Group at its second session (see document PCT/R/WG/2/3). The Working Group's discussions are outlined in document PCT/R/WG/2/12, paragraphs 54 to 56:

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

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

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

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

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

[...]

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

5. Further revised proposals relating to the reinstatement of right of priority were prepared by the International Bureau for consideration by the Committee at its second session (see document PCT/R/2/5). The Committee's discussions are outlined in document PCT/R/2/9, paragraphs 111 to 123 and 125:

“111. Discussion was based on the proposals by the International Bureau set out in document PCT/R/2/5.

[...]

“Restoration of Priority Claims

“117. The Delegation of Canada, supported by the Delegations of Australia and the United States of America, stated that, while it supported in principle the concept of providing relief where the 12-month priority period was not complied with, it was concerned that the restoration of a priority claim as proposed in Rule 26bis.3 could be considered to be a matter of substance. Noting that the PLT and the PCT operated in different contexts, the Delegations suggested that such relief might, instead, be provided by amendment of Rules 4.10 and 26bis.1.

“118. The Delegation of Japan stated that, although it supported the proposed restoration of priority claims in principle, it was concerned that, in some cases, such restoration could leave insufficient time for the transmittal of the record copy and translation within 13 months as required by Rule 22.1. The Delegation of Kenya also referred to the need to avoid problems of meeting time limits that might arise where a priority claim was restored.

“119. The Delegation of Austria, supported by the Delegations of Spain, Germany, Ireland, France, Sweden, Portugal, Denmark, the Netherlands and Greece and the Representative of the EPO, suggested that the criterion for restoration under proposed new Rule 26bis.3(a)(iii) should be changed from “unintentional” to “due care.” The

Delegation of the United Kingdom emphasized a preference for retaining a single criterion; otherwise, there was a possibility that applicants who had missed the 12-month priority period might shop around for receiving Offices with the most liberal criterion. The suggested change was opposed by the Delegation of Australia, supported by the Delegations of the United States of America and Canada, on the grounds that the “unintentional” criterion was broader and therefore more applicant -friendly.

“120. The Committee agreed that the words “or the International Bureau, as the case maybe,” in proposed new Rule 26 *bis*.3(e) were unnecessary.

“121. The Delegation of the United Kingdom and the Representative of the EPO suggested, in connection with proposed Rule 26 *bis*.3(g), that express provisions should be made, where the receiving Office refused a request for restoration of priority claim, for a designated Office to review that decision, noting that Articles 24 and 25 would not appear to be applicable in such a case. The Committee agreed that the revised proposal should contain such a provision. The Delegation of the United Kingdom also questioned whether the review by a designated Office should be based on its own criterion or that used by the receiving Office.

“122. In response to a comment by the Delegation of China, the International Bureau explained that the transitional reservations provided for in proposed Rule 26 *bis*.3(h) were intended to apply only to the provisions of Rule 26 *bis*.3 and not to Rules 26 *bis*.1 and 26 *bis*.2, since the latter provisions were already in force and were not subject to reservations. So as to clarify the matter, the Committee agreed that the words “this Rule” should be replaced by “paragraphs (a) to (g).”

“123. Having regard to the number of outstanding issues connected with the proposed provisions relating to restoration of priority claims, and noting that the proposal had not been extensively considered by the Working Group, the Committee felt that they were not yet ripe to proceed to the Assembly.

[...]

“Further Consideration

“125. The Committee agreed to recommend to the Assembly that the proposed amendments of Rules 4.10, 26 *bis*.3 and 48.2 set out in Annex II to document PCT/R/2/5 should be revised by the International Bureau, taking into account the comments and concerns expressed at the Committee’s session, and submitted to the Working Group [...] for discussion at its next session.”

6. The Assembly, at its 31st (18th extraordinary) session, held in Geneva from September 23 to October 1, 2002, unanimously approved the Committee’s recommendation concerning the proposed amendments of certain Rules relating to the restoration of the right of priority (see document PCT/A/31/10, paragraph 44(i)).

7. Further revised proposals relating to the reinstatement of the right of priority were prepared by the International Bureau for consideration by the Working Group at its third session (see document PCT/R/WG/3/2). The Working Group’s discussions are outlined in document PCT/R/WG/3/5, paragraphs 13 to 27:

“RESTORATION OF THE RIGHT OF PRIORITY

“13. Discussions were based on documents PCT/R/WG/3/2 and 2 Add.1.

“14. There was little support for the proposal by the International Bureau in document PCT/R/WG/3/2 that the criterion for restoration of the right of priority should, at the choice of the applicant, be either “due care” or “unintentionality,” with a higher fee being payable where the applicant chooses to request the receiving Office to apply the “unintentionality” criterion.

“15. Several delegations and representatives of users emphasized the importance of enabling restoration of the right of priority, noting that unintentional errors and unforeseen difficulties in meeting the priority deadline were a fact of life for applicants and their representatives, notwithstanding their keen desire to respect it. Although a number of delegations expressed the desire for a single criterion to be established in connection with the restoration of the right of priority by receiving Offices in the international phase, there was no agreement as to what that criterion should be.

“16. A considerable number of delegations and representatives of users were of the opinion that the criterion to be applied by receiving Offices in the international phase should be “unintentionality,” stating that such an approach would be more user-friendly and also simpler for receiving and designated Offices to apply, and that it would bring about more uniformity among Offices. Several other delegations and one representative favored the adoption of the more stringent criterion of “due care,” on the understanding that any designated Office would be free to apply a more liberal criterion (such as “unintentionality”) to the application when it entered the national phase.

“17. It was noted that, under the proposal for a “due care” criterion as just outlined, where the receiving Office refused a request for restoration, the dates for international publication and national phase entry would expire up to 14 months later than would have been the case if the request had been allowed. A subsequent request for restoration before a designated Office in the national phase on the basis of “unintentionality” would be difficult to sustain since, if it were to be allowed, the “proper” dates for international publication and national phase entry would, in retrospect, be up to 14 months earlier than had in fact been the case. The applicant may therefore be obliged to request international publication and to enter the national phase early, on the basis of times calculated from the earlier priority dates sought, in the mere hope that the request for restoration would be allowed by the designated Office.

“18. The proposal by the EPO in document PCT/R/WG/3/2 Add.1 would enable the applicant to request restoration on the ground of “unintentionality” in the national phase if a request based on “due care” had been refused in the international phase. While some delegations supported the proposal, it was noted that it would obligate the applicant to request restoration during the international phase on the ground of “due care” even in cases where that criterion was clearly not complied with, simply in order to be able to pursue the matter further in the national phase on the ground of “unintentionality”. Some delegations and representatives of users pointed to the desirability of enabling the applicant to place on file, before the publication date, a statement of intention to request restoration later in the national phase and evidence in support of that request.

“19. One delegation said that one of its user groups had suggested that a possible approach could be to automatically retain in the international application any priority claim which was based on an earlier application with a filing date earlier than 12 months, but not more than 14 months, from the international filing date, leaving the possibility of restoration to be governed by the national law and decided separately by each designated Office. Several delegations and representatives of users expressed the concern that such an approach, while in compliance with the requirements of the PLT, would lead to a diversity of practices among designated Offices and require the applicant to engage in a multitude of parallel procedures in which essentially the same issue was at stake.

“20. Several delegations suggested that guidance should be provided in the context of the PCT as to the application of the two criteria, noting that no such guidance was provided in the context of the provisions concerning the matter in the PLT and that little information was available as to the present practices of the various Offices. One delegation suggested that it would be useful to conduct a survey of present practices by sending a questionnaire to all PCT Offices and Authorities. That survey should seek information as to the application of the criteria of “due care” and “unintentionality” in general, that is, not restricted to cases where restoration of the right of priority was sought, but also in cases, for example, of late payment of annuities, in order to obtain guidance as to the differences between the two criteria and to assist in the establishment of guidelines. The questionnaire should also seek information as to the proof required.

“21. Certain delegations suggested that provisions for restoration of the right of priority should not be proceeded with until a majority of PCT Contracting States provided for such restoration under their national law, which would be in compliance with the PLT. However, a majority expressed the view that as a solution to this question of principle should not be delayed, noting that the inclusion in the Regulations of provisions dealing with restoration of the right of priority would, in the long term and notwithstanding the likelihood that a number of Contracting States would make transitional reservations, encourage national laws to provide for the matter in a harmonized way.

“22. Several delegations expressed concern as to whether the draft provisions as proposed by the International Bureau were compatible with the provisions of Article 8(2)(a), which referred to the Paris Convention with regard to the conditions for, and the effect of, priority claims, and Article 27(5), which stated that nothing in the Treaty and the Regulations was intended to be construed as prescribing anything that would limit the freedom of each Contracting State to prescribe such substantive conditions of patentability as it desired. In the latter connection, it was pointed out that the inclusion of provisions in the PLT for restoration of the right of priority suggested that the procedure was not regarded as a substantive matter in the context of the PLT. One delegation commented that the distinction between procedural and substantive aspects of the proposal was unclear and should be further explored.

“23. In connection with review during the national phase of a receiving Office’s decision on a request for restoration of the right of priority, some delegations questioned whether there was a need, in proposed Rule 26bis.3(j), to distinguish between the “designated Office” on the one hand and the “designated State” on the other, and suggested that the provision might better refer to what was permitted or required in the national law. One delegation suggested that designated Offices should be able to

review any decision by the receiving Office on the grounds that it was erroneous. Doubt was expressed by another delegation as to how far the Regulations could restrict the circumstances in which a decision of the receiving Office could be reviewed by a court in the national phase.

“24. One delegation suggested that a provision similar to proposed Rule 26bis.3(k) should be included to enable receiving Offices, as well as designated Offices, to make transitional reservations in relation to proposed Rule 26bis.3(a) to (j).

“25. In the light of the discussions, the Working Group agreed that:

(i) the proposal to leave the choice of criterion to the applicant, as proposed in document PCT/R/WG/3/3, was not supported;

(ii) there was no general agreement as to which of the two criteria for restoration provided for in the PLT, namely “due care” or “unintentionality,” should apply in the case of determinations by a receiving Office;

(iii) it would be preferable to continue to seek a solution under which a decision of the receiving Office to restore the right of priority would be given proper effect by designated Offices, rather than to leave the matter to be determined separately by each designated Office under a variety of national laws;

(iv) it was necessary to ensure that any provision concerning restoration of the right of priority was compatible with Articles 8 and 27(5), although it was noted that, under the PLT, the restoration of the right of priority was not considered to be a matter of substance;

(v) practical problems and confusion would arise if receiving Offices were obliged to apply one criterion as a receiving Office and a different criterion as a designated Office or national Office;

(vi) whatever solution, if any, were to be found, there would be a need for guidance, preferably in the PCT Receiving Office Guidelines, on the practice to be followed.

“26. It was agreed that the International Bureau should prepare a revised proposal presenting three options for further consideration by the Working Group providing, respectively, for the criterion of “due care,” for the criterion of “unintentionality,” and for the automatic retention of the priority date for the purposes of the international phase, leaving the question whether its restoration was allowable to the national phase. The revised proposal would also provide, under any of those options, for an indication of the intention or request for restoration and for supporting evidence to be filed in the international phase and to be included in the international publication.

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

REVISED PROPOSALS; REPLIES TO QUESTIONNAIRE

8. As agreed by the Working Group at its third session, Annexes I and II to this document contain revised proposals for amendment of the PCT Regulations to provide for the restoration of the right of priority, taking into account the discussion and conclusions reflected in the summary by the Chair.

9. Annex I contains proposals drafted on the basis that restoration would be by the receiving Office, the same criterion being applied by all receiving Offices, but with options as to whether that criterion would be “unintentionality” (option A) or “due care” (option B).

10. Annex II contains proposals (option C) drafted on the basis of retention of the priority claim for the purposes of the international phase, leaving the question whether the right of priority can be restored to be decided by the designated or elected Office in the national phase. Noting that the PLT has not yet entered into force, Annex II also contains a proposal to incorporate into the PCT Regulations a provision, with the same requirements as PLT Article 13(2) and PLT Rule 13(4) and (5), which would oblige designated and elected Offices to provide for the restoration of the right of priority where the date on which the earlier application was filed was not a date falling within the period of 12 months preceding the international filing date but was a date falling within the period of 14 months preceding the international filing date if the designated Office finds that the failure to file the international application within the period of 12 months from the date of filing of the earlier application occurred in spite of due care required by the circumstances having been taken or, at the option of the designated Office, was unintentional. A transitional reservation provision is also included, recognizing that some national laws will need to be amended to bring them in line with the PCT Regulations as proposed to be amended.

11. For an overview of the replies received in response to the questionnaire concerning the application of the criteria of “due care” and “unintentionality” under the various national laws and practices, see document PCT/R/WG/4/1 Add. 1.

12. Article 13 and Rule 14 of the PLT are reproduced for ease of reference in Annex III.

13. The Working Group is invited to consider the proposals contained in Annexes I and II to this document.

[Annex I follows]

ANNEXI

PROPOSED AMENDMENTS OF THE PCT REGULATIONS: ²

RESTORATION OF THE RIGHT OF PRIORITY

OPTION A:

RESTORATION BY RECEIVING OFFICE BASED ON "UNINTENTIONALITY" ³

OPTION B:

RESTORATION BY RECEIVING OFFICE BASED ON "DUE CARE" ³

TABLE OF CONTENTS

Rule 4 The Request (Contents)	2
4.1 to 4.9 [No change]	2
4.10 <i>Priority Claim</i>	2
4.11 to 4.18 [No change]	2
Rule 26 bis Correction or Addition of Priority Claim, <u>Restoration of Right of Priority</u>	3
26 bis.1 [No change]	3
26 bis.2 <i>Invitation to Correct Defects in Priority Claims</i>	3
<u>26 bis.3 Restoration of Right of Priority</u>	5
Rule 48 International Publication	12
48.1 [No change]	12
48.2 <i>Contents</i>	12
48.3 to 48.6 [No change]	14
Rule 76 Copy, Translation and Fee Under Article 39(1); Translation of Priority Document	15
76.1, 76.2 and 76.3 [Remain deleted]	15
76.4 [No change]	15
76.5 Application of <u>Certain Rules</u> 22.1(g), 47.1, 49, 49 bis and 51 bis	15
76.6 [Remains deleted]	15
Rule 80 Computation of Time Limits	16
80.1 to 80.7 [No change]	16
<u>80.8 Time limits Computed From the Priority Date</u>	16

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.

³ See Annex II for Option C: Retain Priority Claim for International Phase Leaving Restoration for National Phase.

Rule 4

The Request (Contents)

4.1 to 4.9 [No change]

4.10 *Priority Claim*

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

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

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

(ii) to (v) [No change]

(b) to (d) [No change]

4.11 to 4.18 [No change]

Rule 26 bis

Correction or Addition of Priority Claim ; Restoration of Right of Priority

26bis.1 [No change]

[COMMENT: Note, however, that the Working Group, at its third session, approved proposed amendments of Rule 26bis.1 with a view to their possible submission to the Assembly for adoption at its next session in September - October 2003; see document PCT/R/WG/3/2 and the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 28 and 29.]

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

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

(a) Where the receiving Office or, if the receiving Office fails to do so, the International

Bureau, finds that:

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

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

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

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

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

[COMMENT: There appears to be no need for an invitation to correct a priority claim where a request for restoration of that 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.]

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

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

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

(c) [No change]

26bis.3 Restoration of Right of Priority

(a) The receiving Office shall, subject to paragraphs (b) to (e), restore the right of priority where the date on which the earlier application was filed is not a date falling within the period of 12 months preceding the international filing date but is a date falling within a period of 14 months preceding the international filing date if the receiving Office finds that the failure to file the international application within the period of 12 months from the date of filing of the earlier application [OPTION A: was unintentional] [OPTION B: occurred in spite of due care required by the circumstances having been taken].

[COMMENT: It is proposed to use similar terminology to that used in Rule 4.10(a)(iii) (“... date on which the earlier application was filed, being a date falling within the period of 12 months preceding the international filing date”) rather than, as in previous drafts, terminology which may cause confusion with the term “priority period” as used in the Paris Convention (see the earlier draft of Rule 26bis.3(a) in document PCT/R/WG/3/2 (“... an earlier application has an international filing date which is later than the date on which the priority period referred to in paragraph (f) expired but is within two months from that date ...”).]

[Rule 26bis.3, continued]

(b) Restorations shall be made on the request of the applicants submitted to the receiving Office within a time limit of 14 months from the date on which the earlier application was filed, stating the reasons for the failure to file the international application within the period of 12 months from the date of filing of the earlier application.

[COMMENT: See the Comment on paragraph (a), above.]

(c) The request referred to in paragraph (b) may be subjected by the receiving Office to the payment to it, for its own benefit, of a fee for requesting restoration equal to 25% of the international filing fee referred to in item 1 of the Schedule of Fees, not taking into account any fee for each sheet of the international application in excess of 30 sheets.

[COMMENT: Paragraph (c) is modeled after Rule 12.3(e) as adopted by the PCT Assembly in October 2002.]

(d) The receiving Office:

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

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

[Rule 26bis.3, continued]

(e) Where the international application did not claim the priority of the earlier application, the request referred to in paragraph (b) shall be accompanied by a notice adding the priority claims so as to comply with the requirements of Rule 4.10.

(f) Where the receiving Office refuses a request for restoration of the right of priority under paragraph (b), the priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made and the receiving Office shall so declare and shall inform the applicant accordingly .

(g) Where the receiving Office has refused a request under paragraph (b) for restoration of the right of priority, or where such a request is pending at the time of the completion of the technical preparations for international publication:

(i) the International Bureau shall, upon request made by the applicant and received by the International Bureau prior to the completion of the technical preparations for international publication, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish, together with the international application, information concerning that request for restoration; a copy of the request under this item 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);

[Rule 26bis.3(g), continued]

(ii) the applicant may furnish to the International Bureau, and the International Bureau shall include in its files, a copy of any declaration or other evidence filed in support of the statement of reasons referred to in paragraph (b).

[COMMENT: This item has been included following suggestions made by some delegations and representatives of users during the third session of the Working Group (see summary of the session by the Chair, document PCT/R/WG/3/5, paragraph 18.)]

(h) Where the receiving Office has refused a request under paragraph (b) for restoration of the right of priority, a designated Office may, on the request of the applicant, review the decision by the receiving Office, provided that a copy of the international application (unless the communication provided for in Article 20 has already taken place) and the appropriate translation (as prescribed) have been furnished and the national fee (if any) has been paid within the time limit applicable under Article 22 that would apply if the right of priority were restored. The designated Office may require that a request for review shall be presented to it within the time limit applicable under Article 22 and may subject the making of the request to the payment to it of a fee for its own benefit.

(i) When reviewing the decision of the receiving Office in accordance with paragraph (h), the designated Office shall:

[Rule 26bis.3(i), continued]

(i) subject to item (ii), where the designated Office finds that the failure to file the international application within the period of 12 months from the date of filing of the earlier application [OPTION A: was unintentional] [OPTION B: occurred in spite of due care required by the circumstances having been taken], it shall restore the right of priority for the purposes of the designated State or States concerned;

(ii) 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 those provided for under this Rule, apply the requirements under the applicable national law instead of the requirements under this Rule.

[COMMENT: The text of new paragraphs (h) and (i) has been further revised, following agreement in the second session of the Committee that express provisions should be made, where the receiving Office refused a request for restoration, for a designated Office to review that decision, noting that Articles 24 and 25 would not appear to be applicable in such a case (see the report of the second session of the Committee, document PCT/R/2/9, paragraph 121).]

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

[Rule 26bis.3(j), continued]

[COMMENT: New paragraph (j) is proposed to be added with a view to striking an equitable balance between the interests of the applicant in not having the decision by the receiving Office to restore the right of priority routinely reviewed by designated Offices and the right of designated Offices to revoke an incorrectly restored right of priority. Designated Offices, during the national phase, would have to respect the decision taken by the receiving Office during the international phase unless they have good reason not to.]

(k) Where the receiving Office has restored a right of priority under paragraph (a), the designated Office in the case referred to in paragraph (j), the courts and any other competent organ of the designated State shall, when determining the right of priority:

(i) subject to item (ii), apply the requirements under this Rule and shall not disregard the right of priority only because the date on which the earlier application was filed is not a date falling within the period of 12 months preceding the international filing date, unless a requirement under this Rule was not complied with;

(ii) 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 this Rule, apply the requirements under the applicable national law instead of the requirements under this Rule.

[COMMENT: New paragraph (k) is proposed to be added so as to require the designated Office (when reviewing a decision by the receiving Office in the case referred to in paragraph (j)), the courts and any other competent organ of the designated State to apply the same criteria as the receiving Office under Rule 26bis.3 or, where the requirements under the national law are more favorable than the requirements under Rule 26bis.3, to apply those requirements.]

[Rule 26bis.3, continued]

(l) If, on [date of adoption of these modifications by the PCT Assembly], any provision of paragraphs (j) and (k) is not compatible with the national law applied by the designated Office, that provision shall not apply in respect of that Office for as long as it continues not to become 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: If the “unintentionality” criterion were adopted under paragraph (a), a national law applied by a designated Office which provided for the “due care” criterion or any other criterion more stringent than the “unintentionality” criterion would not be compatible with the provisions of paragraphs (j) and (l). On the other hand, if the “due care” standard were adopted under paragraph (a), a national law applied by a designated Office which provided for a more stringent criterion than “due care” or did not provide for restoration at all would not be compatible with the provisions of paragraphs (j) and (l). In both cases, such a designated Office could make use of the transitional reservation provision provided for in paragraph (l). So as to achieve a uniform approach to the question of restoration of the right of priority at least during the international phase, it is not proposed to amend paragraph (l) further so as to permit receiving Offices to make a similar transitional reservation where the national law applied by the receiving Office is not compatible with the provisions of Rule 26bis.3, in particular, paragraph (a) (as was suggested by one delegation during the third session of the Working Group; see the summary of the Chair, document PCT/R/WG/3/5, paragraph 23).]

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

(a) The pamphlet shall contain:

(i) to (ix) [No change]

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

(xi) any information concerning a request for restoration of the right of priority, the publication of which is requested under Rule 26 *bis.3(g)(i)*.

[COMMENT: This item has been included following agreement at the third session of the Working Group to include, in the international publication, an indication of the intention of the applicant to request restoration where the request for restoration of the right of priority under Rule 26 *bis.3* has been refused by the receiving Office or is pending at the time of completion of technical preparations for international publication (see document PCT/R/WG/3/5, paragraph 26).]

[Rule 48.2, continued]

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

(i) to (iii) [No change]

(iv) an indication that the request contains 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) indications concerning any right of priority which has been restored under Rule 26bis.3(a);

[COMMENT: This item has been included following agreement at the second session of the Working Group to “the need for information concerning the fact that a priority claim had been restored to be communicated to designated Offices, for example, by the inclusion of indications on the front page of the published application (PCT pamphlet)” (see document PCT/R/WG/2/12, paragraph 54(iv)).]

(vi) an indication that the pamphlet contains information concerning a request for restoration of the right of priority, the publication of which is requested under Rule 26bis.3(g)(i);

[COMMENT: This item has been included following agreement at the third session of the Working Group to include, in the international publication, an indication of the intention of the applicant to request restoration where the request for restoration of the right of priority under Rule 26bis.3 has been refused by the receiving Office or is pending at the time of completion of technical preparations for international publication (see document PCT/R/WG/3/5, paragraph 26).]

[Rule 48.2(b), continued]

(vii) where the applicant has furnished copies of any declaration or other evidence referred to in Rule 26bis.3(g)(ii), an indication to that effect .

[COMMENT: This item has been included following agreement at the third session of the Working Group to include, in the international publication, an indication of the fact that the applicant has furnished to the International Bureau, for inclusion in its files, copies of any declaration or other evidence filed in support of the statement of reasons referred to in Rule 26bis.3(b).]

(c) to (i) [No change]

48.3 to 48.6 [No change]

Rule 76⁴

Copy, Translation and Fee Under Article 39(1);

Translation of Priority Document

76.1, 76.2 and 76.3 *[Remain deleted]*

76.4 [No change]

76.5 Application of Certain Rules ~~22.1(g), 47.1, 49, 49bis and 51bis~~

Rules 22.1(g), 26bis.3(h) to (l), 47.1, 49, 49bis and 51 bis shall apply, provided that:

(i) to (v) [No change]

[COMMENT: Proposed amendment of Rule 76.5 is consequential on the proposed amendment to Rule 26 bis.3.]

76.6 *[Remains deleted]*

⁴ The “present” text shown is that of Rule 76 as amended by the Assembly on October 1, 2002 (see document PCT/A/31/10) and due to enter into force on January 1, 2004.

Rule 80

Computation of Time Limits

80.1 to 80.7 [No change]

80.8 *Time limits Computed From the Priority Date*

(a) Where a change in the priority date is caused by:

(i) the correction or addition of a priority claim under Rule 26bis.1; or

(ii) the restoration of a right of priority under Rule 26bis.3;

any time limit which is computed from the previously applicable priority date and which has not already expired shall be computed from the priority date as so changed.

(b) For the purposes of computing any time limit which is computed from the priority date, if a priority claim does not comply with Rule 4.10(a)(i) because the date on which the earlier application was filed was not a date falling within the period of 12 months preceding the international filing date, that priority claim shall not be taken into account for the purposes of computing any such time limit except where the right of priority has been restored in accordance with Rule 26bis.3.

[Rule 80.8(b), continued]

[COMMENT: Note that the Working Group, in its third session, has already approved the proposed addition of new Rule 80.8, to the extent that it deals with the correction and addition of a priority claim under Rule 26bis.1, with a view to its possible submission to the Assembly for adoption at its next session in September - October 2003 (see the summary of the session by the Chair, document PCT/R/WG/3/5, paragraph 29). Consequential on the proposed addition of new Rule 26bis.3 (see above), it appears necessary to further amend Rule 80.8(b) so as to ensure that a priority claim which does not comply with Rule 4.10(a)(i) (because the date on which the earlier application was filed is not a date falling within the 12 months preceding the international filing date) is nevertheless taken into account for the purposes of computing time limits if the right of priority is restored under proposed new Rule 26bis.3(a).]

[Annex II follows]

ANNEXII

PROPOSED AMENDMENTS OF THE PCT REGULATIONS: ⁵

RESTORATION OF THE RIGHT OF PRIORITY

OPTION C:

RETAIN PRIORITY CLAIM FOR INTERNATIONAL PHASE
LEAVING RESTORATION FOR NATIONAL PHASE

TABLE OF CONTENTS

Rule 26 <i>bis</i> Correction or Addition of Priority Claim	2
26 <i>bis</i> .1 [No change]	2
26 <i>bis</i> .2 Invitation to Correct Defects in Priority Claims	2
Rule 48 International Publication	5
48.1 [No change]	5
48.2 <i>Contents</i>	5
48.3 to 48.6 [No change]	6
<u>Rule 49^{ter} Restoration of Right of Priority</u>	7
<u>49^{ter}.1 Restoration of Right of Priority</u>	7
Rule 76 Copy, Translation and Fee Under Article 39(1); Translation of Priority Document	10
76.1, 76.2 and 76.3 [<i>Remain deleted</i>]	10
76.4 [No change]	10
76.5 Application of <u>Certain Rules</u> 22.1(g), 47.1, 49, 49<i>bis</i> and 51<i>bis</i>	10
76.6 [<i>Remains deleted</i>]	10
Rule 80 Computation of Time Limits	11
80.1 to 80.7 [No change]	11
<u>80.8 <i>Time limits Computed From the Priority Date</i></u>	11

⁵

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 6bis

Correction or Addition of Priority Claim

26bis.1 [No change]

[COMMENT: Note, however, that the Working Group, at its third session, approved proposed amendments of Rule 26bis.1 with a view to their possible submission to the Assembly for adoption at its next session in September -October 2003; see document PCT/R/WG/3/2 and the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 28 and 29.]

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

(a) [No change]

(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 claims so as to comply with the requirements of Rule 4.10, that priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made and the receiving Office or the International Bureau, as the case may be, shall so declare and shall inform the applicant accordingly, provided that a priority claim shall not be considered not to have been made only because :

[COMMENT: As in Annex I to this document, it is proposed to delete the words “, in response to an invitation under paragraph (a),” which appear to be superfluous; whether or not the notice of correction is received as a result of an invitation would seem irrelevant.]

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

(i) the indication of the number of the earlier application referred to in

Rule 4.10(a)(ii) is missing ; ~~or~~

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

(iii) the date on which the earlier application was filed is not a date falling within the period of 12 months preceding the international filing date, provide d that the date on which the earlier application was filed is a date falling within the period of 14 months preceding the international filing date .

[COMMENT: Paragraph (b) is proposed to be amended so as to provide for the retention during the international phase of a priority claim where the earlier application the priority of which is claimed has a filing date which does not fall within the period of 12 months preceding the international filing date (see Rule 4.10(a)(i)) but falls within a period of 14 months preceding the international filing date (see the summary by the Chair of the third session of the Working Group, document PCT/R/WG/3/5, paragraphs 19 and 26). See proposed new Rule 49bis (below) with regard to the procedure before the designated Offices.]

(c) [No change]

[Rule 26bis.2, continued]

(d) In the case referred to in paragraph (b)(iii), 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, a statement by the applicant concerning the fact that the date on which the earlier application was filed is not a date falling within the period of 12 months preceding the international filing date but is a date falling within the period of 14 months preceding the international filing date. A copy of the statements 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: Paragraph (d) has been included following agreement at the third session of the Working Group to include, in the international publication, an indication of the intention of the applicant to request restoration of the right of priority in the national phase (see the summary by the Chair of the third session of the Working Group, document PCT/R/WG/3/5, paragraph 26).]

Rule 48

International Publication

48.1 [Nochange]

48.2 *Contents*

(a) The pamphlet shall contain:

(i) to (ix) [Nochange]

(x) any declaration referred to in Rule 4 .17(v), and any correction thereof under Rule 26 *ter.1*, which was received by the International Bureau before the expiration of the time limit under Rule 26 *ter.1*;

(xi) any statement referred to in Rule 26 *bis.2(d)*.

[COMMENT: See Comment on Rule 26 *bis.2(d)*, above.]

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

(i) to (iii) [Nochange]

[Rule 48.2(b), continued]

(iv) an indication that the request contains 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) an indication that the date on which the earlier application was filed is not a date falling within the period of 12 months preceding the international filing date but is a date falling within the period of 14 months preceding the international filing;

[COMMENT: The inclusion, on the front page of the pamphlet, of such indication appears useful.]

(vi) where the applicant has furnished a statement referred to in Rule 26bis.2(d), an indication to that effect .

[COMMENT: This item has been included following agreement at the third session of the Working Group to include, in the international publication, an indication of the intention of the applicant to request restoration of the right of priority in the national phase (see document PCT/R/WG/3/5, paragraph 26).]

(c) to (i) [No change]

48.3 to 48.6 [No change]

Rule 49 ter

Restoration of Right of Priority

49ter.1 Restoration of Right of Priority

(a) In the case referred to in Rule 26.2bis(b)(iii), the designated Office shall, subject to paragraphs (b) and (c), restore the right of priority where the date on which the earlier application was filed is not a date falling within the period of 12 months preceding the international filing date but is a date falling within the period of 14 months preceding the international filing if the designated Office finds that the failure to file the international application within the period of 12 months from the date of filing of the earlier application occurred in spite of due care required by the circumstances having been taken or, at the option of the designated Office, was unintentional.

(b) Restoration shall be made on the request of the applicants submitted to the designated Office within a time limit of two months from the date on which the requirements under Article 22 must be complied with, stating the reasons for the failure to comply with the priority period.

(c) The designated Office:

(i) may require that a fee be paid in respect of a request under paragraph (b);

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

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

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

(d) 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) to (c), the designated Office shall, when determining the right of priority, apply the requirements under the applicable national law instead of the requirements under paragraph (e).

(e) If, on [*date of adoption of these modifications by the PCT Assembly*], any of the provisions of paragraphs (a) to (c) is not compatible with the national law applied by the designated Office, that provision shall not apply in respect of that Office for as long as it continues not to be compatible with that law, provided that the said Office inform 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.

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

[COMMENT: Noting that the PLT has not yet entered into force, it is proposed to incorporate into the PCT Regulations a provision with the same requirements as under PLT Article 13(2) and PLT Rule 13(4) and (5) (the text of which is reproduced in Annex III) so as to oblige all designated and elected Offices to provide for the restoration of the right of priority where the earlier application the priority of which is claimed has a filing date which is not within the period of 12 months preceding the international filing date but falls within a period of 14 months preceding the international filing date if the designated Office finds that the failure to file the international application within the period of 12 months from the filing date of the earlier application occurred in spite of due care required by the circumstances having been taken or, at the option of the designated Office, was unintentional. A transitional reservation provision is included, recognizing that some national laws will need to be amended to bring them into line with the PCT Regulations as proposed to be amended.]

Rule76⁶

Copy, Translation and Fee Under Article 39(1);

Translation of Priority Document

76.1, 76.2 and 76.3 [Remain deleted]

76.4 [No change]

76.5 Application of Certain Rules ~~22.1(g), 47.1, 49, 49 bis and 51 bis~~

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

(i) to (v) [No change]

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

76.6 [Remains deleted]

⁶ The "present" text shown is that of Rule 76 as amended by the Assembly on October 1, 2002 (see document PCT/A/31/10) and due to enter into force on January 1, 2004.

Rule80

ComputationofTimeLimits

80.1to80.7 [Nochange]

80.8 TimelimitsComputedFromthePriorityDate

(a) Whereachangeintheprioritydateiscausedby thecorrectionor additionofa priorityclaimunderRule 26bis.1,anytimelimitwhichiscomputedfromthepreviously applicableprioritydateandwhichhasnotalreadyexpiredshallbecomputedfromthepriority dateassochanged.

(b) Forthepurposesofcomputingan ytimelimitwhichiscomputedfromthepriority date,ifapriorityclaimdoesnotcomplywithRule 4.10(a)(i)becausethedateonwhichthe earlierapplicationwasfiledwasnotadatefallingwithinaperiodof12 monthsprecedingthe internationalfilingdate,thatpriorityclaimshallnotbetakenintoaccountforthepurposesof computinganysuchtimelimitexceptwherethepriorityclaimisnotconsiderednottohave beenmadeinaccordancewithRule 26bis.2(b)(iii).

[COMMENT:NotthattheWorking Group,inthirdsession,hasalreadyapprovedthe proposedadditionofnewRule80.8,totheextentthatitdealswiththecorrectionandaddition ofapriorityclaimunderRule 26bis.1,withaviewtoitspossiblesubmissiontotheAssembly foradoptionatitsnextsessioninSeptember -October2003(seethesummaryofthesession bytheChair,documentPCT/R/WG/3/5,paragraph29).Consequentialonthe proposed amendmentofRule26 bis.2(seeabove),itappearstobeneccessarytofurthramendRule 80.8(b)so astoensurethatapriorityclaimwhichdoesnotcomplywithRule 4.10(a)(i)(becausethedate onwhichtheearlierapplicationwasfiledisnotadatefallingwithinthe12 monthspreceding theinternationalfilingdate)isneverthelessntakenintoaccountforthepurposesofcomputing timelimitsifthatpriorityclaimis,inaccordancewithRule26 bis.2(b)(iii),notconsiderednot tohavebeenmade(seeRule 26bis.2asproposedtobeamended,above).]

[AnnexIIIfollows]

ANNEX III

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

Article 13

Correction or Addition of Priority Claim; Restoration of Priority Right

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

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

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

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

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

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

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

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

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

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

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

Rule 14

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

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

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

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

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

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

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

(i) be signed by the applicant; and

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

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

(i) be signed by the applicant; and

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

(b) A Contracting Party may require that:

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

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

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

[End of Annex and of document]