

Patent Cooperation Treaty (PCT) Working Group

Eighth Session
Geneva, May 26 to 29, 2015

TRANSMITTAL TO THE INTERNATIONAL BUREAU OF COPIES OF DOCUMENTS
RECEIVED IN THE CONTEXT OF A REQUEST FOR RESTORATION OF THE RIGHT
OF PRIORITY

Document prepared by the International Bureau

SUMMARY

1. It is proposed to amend the PCT Regulations so as to require any receiving Office which has received a request for restoration of the right of priority under Rule 26*bis*.3 to transmit to the International Bureau copies of all documents submitted by the applicant relating to such a request (notably, copies of the request itself, of any statement of reasons and of any declaration or other evidence in support of such statement), unless the receiving Office finds that publication or public access to any such document would prejudice the personal or economic interests of any person and that there is no prevailing public interest to have access to such document. The International Bureau would publish any such document, which would enable designated Offices to undertake a meaningful review of the receiving Office's decision under Rule 49*ter*.1.

BACKGROUND

2. Rule 26*bis*.3 allows applicants to request the restoration of the right of priority if they failed to file the international application within the 12 month priority period. Such a request is to be submitted to the receiving Office, with the supporting documentation, including the statement of reasons, and any declaration or other evidence (Rule 26*bis*.3(b)).

3. At present, Rule 26*bis*.3 does not require receiving Offices to forward the statement of reasons, declarations or other evidence to the International Bureau. According to Rule 26*bis*.3(h), receiving Offices only have to notify the International Bureau of the receipt of such a request, of their decision and of the criterion applied. In addition, even though Rule 26*bis*.3(f) states that the applicant himself may submit a copy of any declaration or evidence to the International Bureau, at present, applicants submit the entire documentation with the restoration request only to the receiving Office; no such copies of such documents are submitted to the International Bureau.
4. Thus, under the current framework, unless the receiving Office decides, on its own initiative, to submit copies of these documents to the International Bureau, the International Bureau does not receive copies of such documents, and thus is not able to publish them, as required under Rule 48.2, to enable designated Offices to carry out the review of the decision by the receiving Office on the restoration of the right of priority referred to in Rule 49*ter*.1(d).
5. At its seventh session, held from June 10 to 13, 2014, the Working Group discussed a proposal to address this matter prepared by the International Bureau (document PCT/WG/7/17). Details of the discussions by the Working Group are set out in paragraphs 419 to 431 of the report of the session (document PCT/WG/7/30). While the proposal was generally supported by the Working Group, it requested the International Bureau to further consider the proposal, taking into account the comments made by delegations, and to present a revised proposal to the Working Group at its present session (paragraph 431 of the report).
6. During the discussions at the Working Group's seventh session, several delegations stated that their receiving Offices already submitted the entire file, including the statement of reasons, as well as any declarations and other evidence received by the applicant, to the International Bureau, as is encouraged by the Receiving Office Guidelines (paragraphs 166C and 166O).
7. Other delegations, however, expressed concerns about requiring receiving Offices to submit sensitive information to the International Bureau, as all documents submitted to the International Bureau under Rule 26*bis*.3 were included in the file of the International Bureau and thus subsequently made available to designated Offices. The concern was that designated Offices could make these documents publicly available even without the consent of the applicant. Those delegations therefore proposed that receiving Offices should retain the right not to furnish such information to the International Bureau. Designated Offices could nevertheless request this information directly from the applicant, if needed for the limited review of the decision by the receiving Office on the restoration of the right of priority referred to in Rule 49*ter*.1(d).
8. With regard to the concerns expressed about potentially making sensitive information available to designated Offices, it is to be noted that, at present, any information relating to a request for the restoration of the right of priority received by the International Bureau either by the applicant or by the receiving Office (notably, any statement of reasons and any declaration or other evidence furnished in support of such statement) is, in fact, published in accordance with Rule 48.2(a)(xi) and thus available to designated Offices. Those concerns could, however, be addressed as outlined in paragraph 9, below; furthermore, those concerns would also be addressed if the proposed Rule changes set out in document PCT/WG/8/12 were adopted, as those Rule changes would enable the International Bureau to omit sensitive information or documents, including any declarations or other evidence submitted under Rule 26*bis*.3, from international publication and public access.

PROPOSAL

9. It is proposed to amend Rule 26*bis*.3(h) so as to require receiving Offices to forward copies of all documents submitted by the applicant in the course of a restoration request (notably, copies of the request itself, of any statement of reasons referred to in Rule 26*bis*.3(b)(iii) and of any declaration or other evidence in support of such statement referred to in Rule 26*bis*.3(f)) to the International Bureau, unless the receiving Office finds that publication or public access to any such document would prejudice the personal or economic interests of any person and that there is no prevailing public interest to have access to such document. The International Bureau would publish any such document in accordance with Rule 48.2(a)(xi) (unless—if the proposed Rule changes set out in document PCT/WG/8/12 were to be adopted—the International Bureau itself would find that any such document contains sensitive information and would decide to omit it from international publication and public access).

10. Further guidance for receiving Offices on how to determine whether any particular document or information contained in a document might qualify for omission under Rule 26*bis*.3(h) would be provided in the Receiving Office Guidelines, following consultations with receiving Offices by way of PCT Circulars.

11. It is further proposed to amend Rule 26*bis*.3(f) and to delete Rule 48.2(b)(viii). As receiving Offices would be required, under Rule 26*bis*.3(h) as proposed to be amended, to forward all documents submitted by the applicant in support of a request for restoration to the International Bureau, it is proposed to amend Rule 26*bis*.3(f) by deleting the second sentence (permitting the applicant to furnish such documents directly to the International Bureau) and to delete Rule 48.2(b)(viii) accordingly.

12. *The Working Group is invited to consider the proposals set out in the Annex to this document.*

[Annex follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS¹

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¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

Rule 26bis

Correction or Addition of Priority Claim

26bis.1 and 26bis.2 [No change]

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

(a) to (e) [No change]

(f) The receiving Office may require that a declaration or other evidence in support of the statement of reasons referred to in paragraph ~~(b)(ii)(b)(iii)~~ 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: It is proposed to replace the erroneous reference to “paragraph (b)(iii)” with the correct reference to “paragraph (b)(ii)”.]

(g) [No change]

(h) The receiving Office shall promptly:

(i) [no change] notify the International Bureau of the receipt of a request under paragraph (a);

(ii) [no change] 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.;

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

(iv) transmit to the International Bureau copies of all documents submitted by the applicant relating to the request under paragraph (a) (including a copy of the request itself, any statement of reasons referred to in paragraph (b)(ii) and any declaration or other evidence referred to in paragraph (f)), unless the receiving Office finds that publication or public access to any such document would prejudice the personal or economic interests of any person and that there is no prevailing public interest to have access to such documents. Where the receiving Office decides not to transmit copies of such documents to the International Bureau, it shall notify the International Bureau accordingly.

(i) and (j) [No change]

Rule 48
International Publication

48.1 [No change]

48.2 Contents

(a) [No change]

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

(i) to (vi) [No change]

(vii) where applicable, an indication that the published international application contains information concerning a request under Rule 26*bis*.3 for restoration of the right of priority and the decision of the receiving Office upon such request;

~~(viii) [Deleted] where applicable, an indication that the applicant has, under Rule 26*bis*.3(f), furnished copies of any declaration or other evidence to the International Bureau.~~

(c) to (k) [No change]

48.3 to 48.6 [No change]

[End of Annex and of document]