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*mutandis, the designated office cannot modify the filing date, without first giving the applicant the chance to comment on this matter within a reasonable period [see § IV.15.4.2].*

### **Case of missing part**

*If a part of the description or of the claims or drawings was missing, one of R20.5(b) PCT or R20.5(c) PCT is applicable. As a consequence, in the designated offices having incompatibility, the filing date will usually change to the date of receipt of these late filed missing parts by the RO in the International phase according to R20.5(c) PCT.*

*Furthermore, by application of R82ter.1(c) PCT mutatis mutandis, the designated office cannot modify the filing date without first giving the applicant a reasonable time to comment on this matter and/or request the withdrawal of the missing part or drawings under R82ter.1(d) PCT. If such a request for withdrawal is made the original filing date is then re-instated [because the application is treated as though it had not been corrected according to R82ter.1(d) PCT].*

### **Procedure at elected offices**

R76.5 PCT R20.8(c) PCT also applies to elected offices.

R82ter.1 PCT This rule refers to both designated and elected offices.

*Consequently, the above procedures also apply equally at the elected offices [which may also have the above mentioned incompatibilities and deal with them in the same way as designated offices].*

### **I.7.4. Review by, and additional requirements of designated or elected offices**

*Once the application enters the national or regional phase, the designated or elected offices concerned may review an earlier decision of the RO concerning the accordancy of a filing date. This review may also address the issue of incorporation of description, claim/s or of parts thereof or drawings by reference. This review is carried out under R82ter.1(b) PCT.*

*For more information on this topic, see § IV.15.4.2.*

### **I.7.5. Correction of missing documents or parts thereof under R91 PCT**

R91.1(g)(i) PCT A mistake shall not be rectifiable under this Rule if the mistake lies in the omission of one or more entire elements of the international application referred to in Art.3(2) PCT\* or one or more entire sheets of the international application.

\*Art.3(2) PCT These parts are:

- Request
- Description
- Claim(s)
- Drawing(s)
- Abstract

*The above exclusion exists, because the correction of missing description and/or claims can be corrected under R20.3 PCT (with or without change in filing date) and missing parts thereof as well as missing drawings can be corrected under R20.5 PCT (again with or without change in filing date). The request and abstract can be corrected under Art.14(1)(b) PCT [see § I.9.3].*

G2/95 The same applies to European applications. In particular a first application cannot be replaced as a whole by a second application, where the first application was originally filed erroneously instead of the second.

*Since the above decision was issued, it has become possible according to the EPC-2000 revision to file a European application by reference to an earlier filed application, provided a copy is provided of the earlier application (and a translation if necessary - Art.80 EPC and R40 EPC). It is now also possible to file missing parts of a European application after the filing date and it is also possible to base these on the claimed priority and so avoid a change in the filing date (R56 EPC). However, neither of these procedures provides for replacing one erroneously filed application with another application which should have been filed. Consequently, the above decision still applies under EPC-2000.*

### **I.8. Priority right under the PCT**

#### **I.8.1. Priority claim**

##### **Legal basis of priority claim**

Art.8(1) PCT Priority can be claimed from one or more applications made in or for Paris Convention countries according to the regulations.

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	<i>Under R4.10(a) PCT priority may now also be claimed from an application in or for any member of the World Trade Organisation, see below.</i>	Art.4C(2) PC	The 12 month period starts to run on the day after the day when the first application was filed and expires 12 months later on the day which has the same number as that on which the first application was filed.
Art.8(2)(a) PCT	The conditions and the effects of any priority claim under Art.8(1) PCT are as provided for in Art.4 of the Stockholm Act of the Paris Convention.	-	If that month has no day with that number, then the period expires on the last day of the month.
	<i>The IB (WIPO) which administers the PCT is not a "state" within the meaning defined in the charter of the United Nations. Consequently, the IB cannot adhere to the Paris Convention. For this reason the PCT sets up the same patent priority requirements as in the Paris Convention by referring in Art.8(2)(a) PCT to Art.4 of the Stockholm Act of the Paris Convention.</i>	R2.4(b) PCT	R80.5 PCT applies <i>mutatis mutandis</i> to the priority period.
	<i>A similar situation exists in the EPC, since the EPO cannot adhere to the Paris Convention either. In the case of the EPC the provisions governing priority of European patent applications are copied from Art.4 Paris Convention into Art.87 EPC (see the decision T301/87, reasons for the decision 7.5).</i>	Art.4C(3) PC R80.5 PCT	If the last day of the period is an official holiday, or a day when the International authority concerned is not open for the filing of applications, the period is extended until the first following day when that authority can receive the application.
	<b>Who may claim priority</b>		<i>For more information on extension of periods under R80.5 PCT, see § V.1.3.1.</i>
Art.4A(1) PC	The person who filed the earlier application or his successor in title has the right to claim priority from that earlier application.		<i>It is important to note that the priority period may only be extended under the provisions of R80.5 PCT, which is applicable as a "lex specialis" to the priority period by virtue of R2.4(b) PCT. Other PCT provisions for the extension of time limits under the PCT, e.g. R82 PCT (postal delays) and R82quater PCT [force majeure] are not applicable [Euro-PCT Guide 68].</i>
Euro-PCT Guide 130	Where the applicant for the priority is not the same as that for the PCT application, proof of entitlement at the PCT filing date [that the later applicant is the successor in title of the applicant for the priority and acquired this right before the PCT filing date] may be required by the EPO in the European phase.		<b>Re-establishment applies to priority period</b>
	<i>This means that an applicant may claim a priority from an earlier application filed by a different applicant only if he has acquired the right to do this. This also applies in the PCT. The Official PCT Request form contains a box where, if relevant, the applicant may indicate how he acquired the right to claim priority (e.g. by transfer, assignment, agreement, change of name). The event leading to the applicant acquiring the right to claim priority must have occurred before the International filing date.</i>		<i>Implicitly Art.4C(1) PC means that, if an International application is filed after expiry of the 12 month period, it may not enjoy priority from the earlier application. This is subject to the proviso that re-establishment (restoration) can be requested for failure to meet the 12 month time limit for filing the International application (see § I.8.7 and sub-sections). Furthermore, when an incorrect date exceeding the 12 months is given in the priority claim, correction of the date can be made under R26bis PCT [see § I.8.5]. This is, however, only possible if the correct priority date is no more than 12 months before the International application.</i>
	<b>The 12 month priority period</b>		<b>Priority from first filing only</b>
Art.4C(1) PC & R2.4(a) PCT	The period for claiming priority is 12 months from the date of filing of the first application. The day of filing of the earlier application is not included in the period.	Art.4C(4) PC	A subsequent application concerning the same subject as a previous first application within the meaning of Art.4C(2) PC, above, filed in the same country of the Paris Convention shall be considered as the first application, of which the filing date shall be the starting point of the period of priority, if, at the time of filing

the subsequent application, the said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.

*This provision is designed to prevent the applicant from filing a sequence of priority applications one after the other and each claiming the 12 month priority period from the previous application in the chain and abandoning each application in the chain before it is published. Such a situation, if not blocked by the above provision, would lead to the applicant being able to effectively obtain a limitless priority period and to obtain a "submarine patent" in all states of the Paris Convention.*

**Types of application used as priority**

Art.8(1) PCT Priority can be claimed from one or more applications.

*The Paris Convention, Art.4(A) PC, defines the conditions for claiming priority from patents, utility models, industrial designs and trademarks. The Paris Convention explicitly indicates that a utility model may serve as a priority for a patent and vice versa (Art.4E(2) PC), but it is silent about whether other forms of protection can serve as a priority for a patent application. However, Art.2(i) PCT indicates that the term "application" means an application for the protection of an INVENTION, and that the term "application" is construed as a reference to an application for:*

- patents for inventions
- inventors' certificates
- utility certificates
- utility models
- patents of addition
- certificates of addition
- inventors' certificates of addition
- utility certificates of addition

*It therefore appears that any of these forms of protection of **inventions** may give rise to a right of priority under Art.8(1) PCT. Note that industrial designs and trademarks are **not** in this list.*

J15/80 The EPO does not accept an application for an Industrial design as an application giving rise to a priority right.

**Priority from Paris Convention States**

Art.8(1) PCT The International application may claim priority from one or more applications filed in or for\* Paris Convention countries according to the regulations.

*\* An application filed "in" a state is a national application filed to obtain a national patent in that state.*

*\* An application made "for" a state is an application where the state in question is designated via the PCT or via a regional patent treaty (ARIPO, Eurasian Patent Convention, EPC, OAPI) or under bi- or multi-lateral agreements (e.g. Switzerland and Liechtenstein – OJ 1980, 407).*

**Priority from WTO members**

R4.10(a) PCT Priority can also be claimed from an application filed in a member of the World Trade Organisation (WTO) which is not a party to the Paris Convention.

*Careful reading of this rule reveals that the members of the WTO in which priority applications recognised under this rule may be filed need not be states as such.*

*However, all members of the WTO are states with the exception of The European Community and Taiwan. Taiwan is not recognised as a state by the UN and so cannot adhere to the Paris Convention, since it is currently considered by the UN to be a province of People's Republic of China. However, Taiwan is a member of the WTO.*

*Strictly speaking this rule (valid from 01.01.2000) is bending Art.8 PCT very far indeed, since this article only allows priorities to be claimed for applications deriving from members of the Paris Convention. In the end it is the article which should prevail over a contradictory rule (Art.58(5) PCT). For these reasons, such a regulatory provision could be seen as ultra vires, but this is, in any case irrelevant, if all PCT contracting states accept WTO priorities after the application passes into the various national and regional phases.*

**Reservations wrt WTO priorities**

R4.10(d) PCT Where the legislation of designated offices does not allow them to accept priority claims according to R4.10(a) PCT, these offices can apply the previous version of R4.10(a) PCT.

*The old version of R4.10(a) PCT [valid until 31.12.1999] did not refer to the WTO.*

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*The EPO applied a reservation under R4.10(d) PCT before the entry into force of the EPC-2000 [Art.87 EPC\_1973 limited priority claims under the EPC\_1973 to Paris Convention states]. Under the revised EPC, EPC\_2000, this reservation no longer applies and priority can also be claimed from an application filed in a member of the WTO which is not a party to the Paris Convention.*

*The Japanese office also had a reservation under this rule, which has since been withdrawn.*

G2/02 & G3/02 These decisions of the EPO Enlarged Board of Appeal confirmed that under EPC\_1973 the EPO did not recognise priority from applications filed in respect of TRIPS/WTO members under the EPC\_1973, which are not also signatories to the Paris Convention.

*However, these decisions now only apply to European applications and International applications designating the EPO, which were filed before the coming into force of the amended EPC on 13.12.2007.*

*Currently there are no PCT states with a reservation under R4.10(d) PCT.*

### **Request and the priority claim**

R4.1(b)(i) PCT &

R4.10(a) PCT The priority claim must be in the Request.

### **Contents of priority claim**

*The indications in the priority claim are those necessary to uniquely identify the earlier application.*

R4.10(a) PCT The priority claim on the Request must indicate:

(i) The date of the priority filing

*Previously it was a requirement of this Rule that the priority claim indicated a priority date which pre-dated the PCT filing date by no more than 12 months. However, this requirement was removed, since it is now possible to request restoration of the priority period where the PCT application is filed up to two months after expiry of the priority period [R26bis.3(e) PCT]. Consequently, the applicant can claim on filing a priority date which pre-dates the PCT filing date by more than 12 months but no more than 14 months and request restoration of the priority period in the Request form under R4.1(c)(v) PCT. For more details see § I.8.7.*

(ii) The file number of the priority

(iii) If the priority is a national application the state of filing (where the Paris Convention applies) or the member of the WTO (where the Paris Convention does not apply).

(iv) If the priority is a regional application, the regional authority entrusted with granting regional patents under the relevant treaty (e.g. the EPO, ARIPO, OAPI, Eurasian Patent Office).

(v) If the priority is an earlier International application, the RO.

*For correction of deficiencies in the content of the priority claim see § I.8.5.*

### **Duplicated protection**

Art.8(2)(b) PCT The applicant can designate the same state as that in which or for which the priority was filed. However if:

- the International application claims at least one priority from a designated state, or,
- the International application claims the priority of a previous International application where only one state was designated,

then the conditions for and effect of the priority claim are governed by national law of that state.

*The EPC has a similar provision - Art.139(3) EPC, which states that where a European application or patent has the same filing or priority date as a national application or patent, then the issue of double patenting is dealt with by the national law of the state where the priority application was filed.*

### **Avoiding duplicated protection**

*In certain cases the applicant can avoid designating the state of the priority in order to avoid duplicating patent rights, see § I.4.3.*

### **Reply to EPO opinion on priority [PCT-direct]**

OJ 2015, A51 In cases where the application claimed as priority was searched by the EPO and where the EPO also produced a written opinion on that priority application, the applicant may include with the PCT application on filing, a reply to that written opinion [produced on the priority].

- This reply is then taken into account by the EPO when drafting the WO-ISA.

- This EPO service is called PCT-direct.

*For more details see § II.10.1.2.*

**I.8.2. Supplying the priority document**

*The exact amount of this fee can be found in the latest schedule of fees published in the EPO Official Journal.*

*The requirements below apply in respect of priority claims made according to Art.8 PCT, by the applicant in respect of his International application in the PCT.*

**Where to file the priority document**

R17.1(a) PCT The applicant must file a certified copy of the priority document (certified by the office where it was filed) to the IB or the RO.

RO-GL 187 Where the applicant makes the request to the RO for forwarding of a copy of the priority document to the IB, but does not pay the necessary fee (where this is required by the RO), the RO will invite him to pay it within the 16 month time limit of R17.1(b) PCT [*if this has not yet expired*].

RO-GL 181 Where the priority document is filed at the RO, this office will forward it to the IB.

RO-GL 188 Where the applicant does not pay this fee within the 16 month time limit, then the request for inclusion of the priority document is considered not to have been made. The applicant is notified.

**Time limit**

R17.1(a) PCT The applicant must file the certified copy of the priority document at the IB or the RO within 16 months of the earliest priority claimed, but if the document is supplied to the IB before International publication, it is considered filed on time.

A.I. 323(b) Confirms that, if a request to transmit the priority is filed, but the fee is not paid, then the RO invites the applicant to pay the fee within 16 months of the priority.

*Effectively the time limit for filing the priority document is up to the publication of the International application (18 months after the earliest claimed priority - Art.21(2)(a) PCT).*

A.I. 323(d) Where the request under R17.1(b) PCT is deemed not to have been filed, the RO informs the IB of this fact.

*However, note that this only applies if the IB receives a copy of the priority before publication. If the applicant supplies the priority document to the RO after 16 months and very soon before publication, and the RO does not forward this to the IB before publication, then the time limit for supplying the priority document according to R17.1(a) PCT is not deemed respected.*

- If the RO does not inform the IB within 17 months of the priority date, the RO must then transmit the priority document to the IB, even though no fee has been paid.

**Priority document issued by RO**

R17.1(b) PCT Where the priority document was issued by the RO, the applicant may simply request the RO to forward a copy of the priority document to the IB. This request must be made within 16 months of the priority.

RO-GL 190 Furthermore, if the applicant pays the fee:

- The RO may require a fee for this service.

- later than 16 months after the priority (the time limit according to R17.1(b) PCT),

- but before the RO has sent the notification of deemed loss of priority to the IB,

then the RO *may* (on request of the applicant\*) forward a copy of the priority document to the IB. If the document arrives at the IB before publication, the time limit according to R17.1(a) PCT is deemed respected.

*\* It is not clear if the original request for the RO to forward the priority to the IB under R17.1(b) PCT is considered sufficient or if the applicant must file a new request to the RO when paying the fee.*

PCT-AG I, 5.070 The request form contains a box where the applicant can make his request to the RO to transmit a copy of the priority document to the IB (in Box VI).

**EPC dispensations do not apply**

RO-GL 183 The applicant can also make this request in a separate letter to the RO.

Euro-PCT Guide 141 The procedure whereby the EPO includes free of charge a copy of the priority in the file of an EP application [OJ 2012, 492 – see § IV.11.4.1.3, where the priority is from certain states] does **not** apply in respect of a PCT application processed by the EPO as RO.

Euro-PCT Guide 140 Where the EPO is RO, it charges a fee for this service.

Rfees 3(1) EPC The President of the EPO can set the amount of administrative fees [*in this case under R17.1(b) PCT*].

*However, if the applicant fails to provide the priority document in the international*

*phase, the EPO will apply this procedure in the EP phase [see below].*

**Priority document filed at EPO online**

- OJ 2015, A91 The priority document can be filed at the EPO via its online filing system, only if:
- the priority document is digitally signed by the issuing authority
  - the EPO accepts this digital signature

*The EPO does not appear to have published any information about which digital signatures from which issuing offices it will accept.*

OJ 2014, A98 The priority document cannot be filed online at the EPO via WFF [*Web-Form Filing*].

OJ 2015, A27 The priority document cannot be filed online at the EPO via CMS [*Case Management System*].

OJ 2014, A107 The EPO as RO now accepts the filing of PCT applications via the ePCT online system provided by WIPO.

*However, the use of ePCT does not as yet appear to extend to documents other than the application itself. This OJ reference only mentions the filing of the application.*

**Digital library**

R17.1(b-bis) PCT If the priority document is available to the IB from a digital library in accordance with the Administrative Instructions, the applicant can, **before publication**, request the IB to obtain the priority document from the digital library.

PCT-AG I, 5.070 The applicant can most easily do this by marking the check-box in section VI of the Request form.

*The IB has set up the "Priority Document Access Service" - DAS. The offices of PCT states can agree to provide electronic copies of priority documents to this IB digital library. Currently it appears that the following offices have made agreements with WIPO to provide priority documents to this centralised digital library both for deposit of and also access to priority applications filed with them (situation 07.11.2015):*

*AU, DK, CN, ES, FI, GB, IB, JP, KR, SE, US*

A.I. 715(a) A priority document is deemed available to the IB, ISA, IPEA or designated office according to R17.1(b-bis) PCT if:

- (i) that office has notified the IB [*or in the case of the IB, the IB has declared*] that it

is prepared to accept the digital availability of the priority document; and

- (ii) the priority document concerned is:

- held in that digital library and
- the applicant has, to the extent required by the procedures for accessing the relevant digital library, authorized the Office or Authority concerned or the International Bureau, as the case may be, to access that priority document.

*Note that each participating office may have certain requirements which need to be fulfilled by the applicant before the priority application filed with them is included in the database, since these are national applications. For example, the UK office requires that the priority application is filed electronically with the UK office and the applicant must indicate when filing that he wishes the application to be stored in the DAS library.*

PCT-AG I, 5.070B In order that the priority document is made available via the DAS library, the applicant must follow the instructions given on the WIPO web-site.

- When this procedure has been followed, the applicant is given an access code. This code must then be given on the Request form (section VI).

PCT-AG I, 5.070C If the priority is an international application filed with the IB as RO, the applicant may send a letter to the IB-RO requesting that the document be made available via DAS, and then request the Office of Second Filing to retrieve that document from DAS.

- For international applications filed at other ROs, the WIPO web-site gives a list of participating Offices. This list indicates if a particular participating Office will make international applications, filed at it as RO, available to DAS in addition to national applications.

Euro-PCT Guide 141 The EPO does not participate in this system.

*This means that the EPO acting as ISA, IPEA or designated office will itself not access the priority document from such a library. However, the priority document is available to the IB (which does participate) and it is not clear whether the ISA or IPEA can request the IB to provide it with a copy from that library, thus bypassing the fact that not all ISA/IPEA designated offices participate [Euro-PCT Guide 614 appears to indicate that*

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	<p><i>this does happen at least before the EPO as designated office].</i></p> <p><i>Furthermore, A.I. 715(a) does not mention the RO. A copy of the priority document may be necessary if the applicant files a request to incorporate the claims or description or missing parts of the application from that priority (see § I.7.1 and § I.7.2 respectively). Consequently, it is not clear if the RO can refuse to access the priority document if the applicant has complied with R17.1(b-bis) PCT or if it can or must obtain the priority document from the IB [as stated in RO-GL 49A].</i></p> <p><b>Sanction for failure to file - national phase</b></p>	
R17.1(c) PCT	<p>If the requirements of R17.1(a) PCT, R17.1(b) PCT or R17.1(b-bis) PCT are not met [i.e. the priority document was not made available in time] then, subject to R17.1(d) PCT*, the designated state can disregard the priority claim.</p> <p>- However, the designated office must give the applicant a second chance to file the priority document in the national or regional phase before it can disregard the priority claim.</p> <p><i>* R17.1(d) PCT states that if the priority document was filed with the designated office in its capacity as a national office [Art.2(xii) PCT - this includes regional offices such as the EPO] or if it is available to the designated office via a digital library according to the Administrative Instructions (subject to the previous conditions), then that office cannot disregard the priority claim.</i></p> <p><i>According to the EPC, the applicant gets his second chance to supply the priority document in the European regional phase according to R163(2) EPC. See § IV.11.4.1.2.</i></p> <p><i>Furthermore, in certain cases the applicant does not need to file the priority document in the European regional phase at all - see § IV.11.4.1.3.</i></p> <p><b>Sanction for failure to file - at IPEA</b></p>	
R66.7(a) PCT	<p>If the IPEA needs a copy of the priority document, then it requests it from the IB.</p> <p><i>A copy of the priority document is required by the IPEA if intermediate prior art published in the priority period is available and the validity of the priority must be verified for assessing the novelty and inventive step of the claimed invention over that intermediate prior art.</i></p>	
		<p>R66.7(a) PCT Where none of the criteria below are satisfied, the priority claim can be ignored by the IPEA in preparing the preliminary examination report:</p> <p>- the applicant has complied with R17.1 PCT and made a copy available to the IB (by sending it himself to the IB under R17.1(a) PCT or by requesting the RO to do this for him under R17.1(b) PCT)</p> <p>- the priority document is available to the IPEA from a digital library according to the Administrative Instructions</p> <p>- the priority document was filed with the IPEA* (e.g. the priority is a European application and the EPO is the IPEA).</p> <p><i>* In cases where the IPEA was the office of the priority, the IPEA cannot deem the priority claim to be invalid because the applicant did not supply a copy of the priority document under R17.1 PCT, because a copy is available to it. However, this does not exempt the applicant from the need to file the priority document at designated offices when it passes into the national / regional phase if this was not supplied to the IB according to R17.1 PCT.</i></p> <p><b>Translation for IPEA</b></p>
		<p>R66.7(b) PCT If the following apply:</p> <p>- the priority document is not in a language accepted by the IPEA</p> <p>- the validity of the priority is relevant to the formulation of the opinion under Art.33(1) PCT [i.e. there is prior art, the relevance of which to novelty and/or inventive step depends on the validity of the applicant's priority]</p> <p>then the IPEA may invite the applicant to file a translation into one of the languages it accepts within two months of the invitation.</p>
		<p>R66.7(b) PCT If the translation is not supplied on time, the priority claim may be ignored in the International Preliminary Examination.</p> <p><b>Public access to priority document</b></p>
		<p>R17.2(c) PCT After publication of the International application, the IB will, on request, furnish to any person a copy of the priority document, provided that:</p> <p>- the person pays for the service</p> <p>- the application was not withdrawn before publication*</p>

- the priority was not withdrawn or deemed withdrawn before publication

*\* If the application is withdrawn before publication, but after the end of the technical preparations for publication (PCT-AG I, 9.013 - generally over by the 15th day prior to publication, which occurs 18 months after the earliest priority date - Art.21(2)(a) PCT), then it is possible that the application is still published under Art.21 PCT, even though it was withdrawn before publication. The supply of the priority document is, of course, also conditional on the applicant filing it at the IB in the International phase under R17.1 PCT.*

*Note that after publication of the International application the priority documents are also made available to the public via the WIPO Internet site.*

**I.8.3. Time limits calculated from the priority**

*Many time limits in the PCT are calculated from the priority date. For example, the PCT time limit for passage into the national phase is 30 months after the priority date (Art.22 PCT / Art.39 PCT).*

Art.2(xi)(b) PCT If more than one priority is claimed under Art.8 PCT, then time limits are calculated from the earliest priority.

Art.2(xi)(c) PCT If no priority is claimed, then time limits calculated from the priority start on the International filing date.

R90bis.3(d) PCT If the priority date shifts due to the abandonment of one or more priority claims under either R90bis.3(a) PCT or R90bis.3(b) PCT, then time limits which are still running which are calculated from the original priority date, are shifted to start from the new priority date.

*For abandonment of the priority and its effect on publication see R90bis.3(e) PCT and § I.8.4.*

R26bis.1(c) PCT Where the correction or addition of a priority date causes the original priority date to change, and time limits calculated from the original priority date have not yet expired, then the time limits are calculated from the amended priority date.

*[See § I.8.5]*

PCT-AG I, 5.062 If the International application was filed after expiry of the 12 month priority period, but within 2 months after that date, the priority claim is not declared void in the international phase for PCT procedures [R26bis2(c)(iii) PCT].

- Where the priority claim is the first or the only one present, it continues to serve as basis for the calculation of time limits in the International phase. This is irrespective of whether restoration of the priority period is requested or whether such restoration is granted or not.

**I.8.4. Withdrawal of priority claim**

*Since some time limits are calculated from the priority date, withdrawal of the priority is a means to extend these time limits, where they have not yet elapsed. For example, to delay publication of the application (Art.21(2)(a) PCT).*

R90bis.3(a) PCT The applicant can withdraw the priority claim in the International phase.

R90bis.3(b) PCT Where there is more than one priority claim, the applicant can withdraw as in R90bis.3(a) PCT one or more of those priority claims.

***Time limit***

R90bis.3(a) PCT The withdrawal must be made within 30 months of the priority date.

***Notice of withdrawal***

R90bis.3(c) PCT The notice of withdrawal of the priority is addressed to the IB or to the RO, and where Art.39(1) PCT applies (i.e. where the applicant has opted for International Preliminary Examination), it may also be sent to the IPEA.

R90bis.5 PCT Where there is more than one applicant, the notice of withdrawal of the priority claim according to R90bis.3 PCT must be signed by all applicants. Where one applicant is deemed to be the common representative by default according to R90.2(b) PCT [see § V.2.3], then the notice of withdrawal must be signed by all applicants [it cannot simply be signed by that common representative].

*Where the common representative has been actively appointed by all applicants according to R90.2(a) PCT, then, according to R90bis.5(a) PCT, he can sign the notice of withdrawal of the priority claim under R90bis.3(a) PCT [for more details on the common representative, see § V.2.3].*

***Time limits calculated from the priority***

R90bis.3(d) PCT Where the abandonment of the priority leads to a change in the priority date\* any time limits not already expired when the abandonment takes place, are then calculated from the new priority date.



Unlike the situation with the correction to an earlier priority date [see § I.8.5], this procedure holds no danger that the applicant will miss any currently running time limits, since any time limits still running from the abandoned priority can only be extended.

\* Art.2(xi)(b) PCT - Since in cases of multiple priority claims, the earliest priority date is used to calculate time limits, the priority date will only change if the earliest or the only priority is abandoned. If a later priority is abandoned, according to Art.2(xi)(b) PCT it is still the earliest one which is used to calculate time limits.

**Late withdrawal and publication**

Normally the International application is published 18 months after the earliest priority date (Art.21(2)(a) PCT & Art.2(xi) PCT). If the earliest claimed priority is withdrawn before publication, the publication will be postponed to 18 months after the filing date (if no other priority is claimed) and to 18 months after the next earliest priority date (if later priorities dates are claimed). This is with the proviso that the withdrawal is made sufficiently early - see below:

R90bis.3(e) PCT However, where the priority is withdrawn by the applicant and the withdrawal reaches the IB\* after the completion of the technical preparations for publication, the publication may go ahead calculating the time limit according to Art.21(2)(a) PCT from the abandoned priority date (18 months after the abandoned priority).

PCT-AG I, 9.013 The technical preparations are generally completed by the 15th day prior to publication [which occurs 18 months after the earliest priority date - Art.21(2)(a) PCT].

\* The withdrawal of the priority may be filed directly at the IB, or at the RO or the IPEA (R90bis.3(c) PCT), the latter two will forward the withdrawal to the IB.

It is the date that the withdrawal arrives at the IB which decides if it is in time to delay International publication, since it is the IB which is responsible for the publication according to Art.21(1) PCT. Consequently, if the applicant wants to delay publication of the International application and the end of the technical preparations for publication is close, then he should file the withdrawal of the priority directly at the IB.

**Early entry**

R90bis.6(a) PCT The withdrawal of a priority is not effective in respect of a designated/elected office where early entry has been requested according to Art.23(2) PCT or Art.40(2) PCT.

OJ 2013, 156 The OJ reference confirms the above, once EP processing has begun, withdrawal of the above rights does not affect the EPO as designated/elected office.

For more details, see § IV.1.2.5.

This might happen where the applicant requests early entry into the national / regional phase according to Art.23(2) PCT or Art.40(2) PCT in respect of certain designated offices only, and subsequently withdraws the priority claim before 30 months after the originally claimed priority date. This then shifts the 30 month time limit for entering the national / regional phase forward to 30 months from the next priority date\*, but only for those offices for which the national / regional phase has not yet begun (i.e. those not subject to the early entry into the national / regional phase).

\* This may be the International filing date itself, where no other priorities are claimed - Art.2(xi)(c) PCT.

**Withdrawal for certain states only**

J6/00 The applicant cannot withdraw the earliest priority claim in respect of certain designated states and not in respect of others in the PCT. Such a withdrawal of priority is considered invalid by the EPO as designated office. The time limit for entering the European regional phase remains 31 months from the priority date, which the applicant attempted to partially abandon.

**Power of attorney waiver**

R90.4(e) PCT & R90.5(d) PCT The power of attorney waiver does not apply with regard to withdrawals.

In the case of a withdrawal, any agent can only sign the notice of withdrawal if he supplies a power of attorney (R90.4(a) PCT) or a copy of a general power of attorney (R90.5(a) PCT), or if he has been appointed by the applicant signing the Request or the Demand. For more details, see § V.2.4.3.

**I.8.5. Correction or addition of a priority claim**

**(a) - Correct/add priority claim at applicant's request**

**How, where**

R26bis.1(a) PCT The applicant can correct or add a priority claim to the request\* by a notice to the RO or the IB. This can include any information referred to in R4.10 PCT (date, state, file number).

*\* Since the priority claim must be made in the request (R4.1(b) PCT and R4.10(a) PCT), even if it is added after filing the request, the new priority claim must be added to the request.*

RO-GL 170 If the applicant does not provide a corrected sheet of the request containing the new priority, but the request satisfies R4.10 PCT [e.g. made in a letter], the RO will correct the Request.

**Time limit**

R26bis.1(a) PCT Where this does not result in a change in the priority date, this request must be submitted by 16 months from the priority date.

R26bis.1(a) PCT Where it does change the priority date, the request must be filed by the earlier of:

- 16 months of the original priority date,
- 16 months from the new priority date,

Whichever time limit applies, the request may be filed within four months after the International filing date.

*For example:*

application filed	01.05.2003
claims priority	01.02.2002

*[Priority pre-dates the application by more than 12 months]*

16 months from prio	01.06.2003
4 months from filing	01.09.2003*

*\* This is the date of expiry of the time limit for filing a corrected priority date under R26bis.1(a) PCT.*

*R26bis.1(a) PCT guarantees a minimum of four months from the filing for correction of the priority, where an erroneously early priority date would otherwise curtail the time limit or even cause it to expire before the filing date! Furthermore, where the priority is subject to restoration, this would also curtail the period for correction by as much as two months [see § 1.8.7 and sub-sections], were it not for*

*the four month minimum set under R26bis.1(a) PCT.*

*Furthermore, the applicant may validly file a correction of an existing priority claim at an even later date according to the following procedure:*

R26bis.2(b) PCT Any notice correcting the priority claim\* is considered to have been received on time where this is:

- received before the RO or IB declares the priority void [under R26bis.2(b) PCT - see below], and,
- received no later than one month after expiry of the above time limit.

*\* Note that this does not apply to a request to add a new priority claim, but only to correction of an existing priority claim. A new priority claim can only be added within the original time limit under R26bis.1(a) PCT.*

A.I. 314(b) Where the request is granted by the RO after the International application has been transmitted to the ISA and the IB [R22.1(a) PCT and R23.1(a) PCT within 13 months of the priority], then the RO informs the ISA and the IB of the correction or addition.

**Early publication**

R26bis.1(b) PCT If the applicant has a pending request for early publication of the application according to Art.21(2)(b) PCT - the request according to R26bis.1(a) PCT will be ignored unless the applicant withdraws the request for early publication before the end of the technical preparations for publication.

**(b) - Correction of priority on invitation**

R26bis.2(a) PCT Where the IB or the RO notes in relation to a priority claim any of the following defects:

- (i) the application was filed after expiry of the priority period and no request for restoration of the priority period has been filed\*,
- (ii) the priority claim does not comply with R4.10 PCT, or
- (iii) any indication in the priority claim is inconsistent with the corresponding indication appearing on the priority document

then the RO or IB invite the applicant to correct the priority claim.

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- This correction must be filed within the period fixed in R26bis.1(a) PCT [see below].*
- R26bis.2(a) PCT In the case (i) above, if the period of two months from expiry of the priority period has not yet expired, the RO or IB will inform the applicant of the possibility of requesting restoration of the priority right under R26bis.3 PCT\*.
- \* This is the two month period according to R26bis.3(e) PCT, within which a request for restoration of the priority must be filed [see § I.8.7].*
- R26bis.2(a) PCT The above [informing the applicant of the possibility of restoring the priority period] does not apply, if the RO has entered a reservation under R26bis.3(j) PCT.
- A reservation under R26bis.3(j) PCT means that that RO does not apply restoration of the priority, because this procedure is incompatible with its national [or regional] law.*
- RO-GL 182 Where the data supplied on the request according to R4.10(a) PCT (date, state\*, file number) is not consistent with the copy of the priority document supplied according to R17.1(a) PCT, the RO will invite the applicant to correct the inconsistency according to R26bis.2(a) PCT.
- \* This may also be a regional office (e.g. the EPO) or the RO (where the claimed priority is an International application).*
- Failure to correct on time**
- R26bis.2(b) PCT If the applicant does not supply the required corrections within the time limit under as R26bis.1(a) PCT [see above], the priority claim will be considered not to have been made in the PCT [**considered void**].
- Note that this only applies to the failure to correct the priority claim. If the applicant fails to add a priority claim on time, then the priority claim simply does not exist, so there is no need to declare it void.*
- R26bis.2(b) PCT Any notice correcting the priority claim is considered to have been received on time where this is:
- received before the RO or IB declares the priority void [under R26bis.2(b) PCT - see below], and
  - received no later than one month after expiry of the above time limit.
- R26bis.2(b) PCT When the priority claim is considered not to have been made, the office in question
- [RO or IB] will issue a declaration to this effect and inform the applicant.
- This is subject to [i.e. mitigated by] R26bis.2(c) PCT [see below].
- R26bis.2(c) PCT However, the priority will not be **considered void** if the deficiency is:
- (i) the missing- or incorrect- file number of the priority document according to R4.10(a)(ii) PCT
  - (ii) inconsistencies between what is mentioned on the priority document itself and in the priority claim
  - (iii) the application has a filing date after expiry of the priority period, as long as the filing date is within two months of expiry of the priority period\*/\*\*.
- \*S&E-GL 6.03 This exists in order to allow for the fact that the applicant may obtain restoration of the priority in the international phase [at the RO - R26bis.3 PCT - see § I.8.7] or before the designated offices [R49ter PCT - see § IV.11.6 and sub-sections].
- \*\* Euro-PCT Guide 233 This applies even where no request for restoration of the priority is filed at the RO and also where such a request is filed but rejected by the RO [see § I.8.7].
- This is to allow for the fact that a re-examination of the restoration of the priority may occur in the national or regional phase under R49ter PCT [see § IV.11.6 and sub-sections].*
- Furthermore, according to PCT-AG I, 5.062, if such a priority claim is the first or only priority claim, it continues to serve as a basis for calculating time limits under the PCT.*
- RO-GL 182 Where the priority claim in the request (R4.10(a) PCT) does not indicate the file number of the claimed priority, but the RO can ascertain the file number of the claimed priority because the applicant has filed the priority document with the RO, the RO may correct this deficiency in the priority claim *ex officio*.
- Effects of re-dated priority**
- Time limits calculated from priority date**
- R26bis.1(c) PCT Where the correction or addition of a priority date causes the original priority date to change, and time limits calculated from the original priority date have not yet expired, then the time limits are calculated from the amended priority date.
- RO-GL 192 - Where the time limit calculated from the original priority has

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already expired, the time limit is not reinstated when the priority date is moved to a later date.

*The correction or addition of a priority claim according to R26bis.1(c) PCT can be dangerous where this causes the earliest priority date to shift back in time. Time limits calculated from an original priority date which have not yet expired could expire retroactively when a new earlier priority date is introduced under R26bis.1(c) PCT.*

*Example:*

*International application is filed on 01.03.2001 claiming priority of 01.09.2000. The applicant then requests correction of the priority date to 01.03.2000. If the applicant makes the request to correct the priority date on 15.06.2001 this is within 16 months of the new priority date and so on time according to R26bis.1(a) PCT consequently the priority date will be corrected to this date.*

*However, according to R12.3(d) PCT, where the applicant has failed to supply the translation of the International application to the RO, within the time limit according to R12.3(a) PCT (one month after filing) and the applicant has not filed the translation late according to R12.3(d) PCT\* and/or paid any late payment fee required by the RO according to R12.3(e) PCT, then according to R12.3(d) PCT, the applicant can still file the translation and/or pay the missing fee within 15 months of the priority (provided that the RO has not yet declared that the application is deemed to be withdrawn according to R12.3(d) PCT).*

*This 15 month period from the priority has not yet expired when the priority is 01.09.2000, but has already expired retroactively when the priority date is corrected to 01.03.2000 on 15.06.2001.*

*In cases where the applicant wishes to correct the priority date to an earlier date than was originally claimed (by addition of an earlier priority or correction to an earlier date), he would be well advised to check those time limits which are calculated from the priority to see if any of them will retroactively expire when he changes the priority date. If any will, he should perform all tasks / pay all fees affected before requesting the correction to or addition of an earlier priority date.*

### **(c) - Publication of invalid priority claim**

R26bis.2(d) PCT **Where:**

- the declaration of invalid priority has been made according to R26bis.2(b) PCT, or
- the priority claim has not been considered void only because R26bis.2(c) PCT applies [see above]

**then** the IB will publish with the application:

- information concerning the priority claim as prescribed in the Administrative Instructions, and,
- any information submitted by the applicant concerning such priority claim, where this is received by the IB before the end of the technical preparations for publication [PCT-AG I, 9.013 - these are generally over by the 15th day prior to publication, which occurs 18 months after the earliest priority date\* - Art.21(2)(a) PCT]

R48.2(a)(ix) PCT The publication of the application contains the above information according to R26bis.2(d) PCT.

R48.2(b)(vi) PCT This is indicated on the front page of the publication application.

*Note that this procedure [publication of the invalid priority claim] only applies to an existing priority claim which the applicant failed to correct under R26bis.1 PCT [a declaration of a void priority under R26bis.2(b) PCT referred to in R26bis.2(d) PCT only applies where the priority existed but was deficient].*

**If** the one of following situations applies:

- neither the RO nor the IB is aware of the deficiency, and so they do not declare the priority to be void under R26bis.2(b) PCT, or
- where either office has seen the deficiency, but the priority would not have been declared void, only because R26bis.2(c) PCT applies [see above],

**then** no automatic publication of the information relating to this priority claim will occur under R26bis.2(d) PCT.

*In this case and also in the case where the applicant failed to request the addition of a priority claim in time, the applicant can request the IB to publish the information regarding the request to correct/add the priority claim under R26bis.2(e) PCT [see below].*

A.I. Annex D, 1.38 & 3 The information included under R26bis.2(d) PCT is:

- 3.1 application nr of priority
- 3.2 date of filing of priority
- 3.3 office/RO where the priority was filed

*Evidently, if any of the above items are missing, they cannot be included in the publication.*

*The publication of the information concerning the invalidity of the priority claim might become very important in proceedings before the designated offices. For example, where the applicant requests the EPO as designated office to re-examine the request for correction of the priority claim according to R82ter.1(a) PCT, the EPO will normally allow a correction only if a warning was published along with the International application informing the public of a pending request for correction or if the error was evident anyway from the document originally filed. See in particular J2/92 and § IV.11.7.2.*

*Note that for Euro-direct applications there is an explicit time limit for correction of a priority which is the same as under R26bis.1(a) PCT [R52(3) EPC], but this period would have expired by the time the application enters the European regional phase.*

**Publication of late request**

R26bis.2(e) PCT Where the time limit for adding/correcting a priority claim under R26bis.1(a) PCT has expired, the applicant can request the IB to publish information concerning the matter [*i.e. the desire to add or correct a priority claim*], provided that the applicant:

- files the request at the IB before 30 months from the priority
- pays a fee provided in the A.I.\* to the IB

\* A.I. 113(c) The fee is provided for here and depends on the number of sheets filed.

R26bis.2(e) PCT The IB will then promptly publish this information.

*This procedure applies where either:*

- (i) *the applicant wishes to add a new priority claim after expiry of the period under R26bis.1(a) PCT, or*
- (ii) *the applicant wishes to correct an existing priority claim, but:*
  - *the IB and RO had not invited the applicant to correct any deficiencies under R26bis.2(a) PCT\*, and,*
  - *the correction is not received within the period under R26bis.1(a) PCT and is also too late for late filing under R26bis.2(b) PCT [within one month of the expiry of the period under R26bis.1(a) PCT].*

*Note that R26bis.2(e) PCT only applies when the applicant requests the addition or correction of a priority of his own motion. This rule does not apply if the applicant fails to correct a priority claim after being invited to do so by the IB or RO under R26bis.2(a) PCT. In such a case an automatic publication is effect according to R26bis.2(d) PCT [see above].*

*Note also that a request to publish information concerning the priority under R26bis.2(e) PCT may only be published with the application if it is received before the end of the technical preparations for publication [PCT-AG I, 9.013 - these are generally completed 15 days prior to the publication date - which occurs 18 months after the earliest priority date - Art.21(2)(a) PCT].*

*This information will usually not be published with the International application because it will, in almost all cases, be requested too late.*

*For late addition of a priority, the time limit under R26bis.1(a) PCT expires usually two months before publication (16 months from the earliest claimed priority), and there is no possibility for late filing under R26bis.2(b) PCT. This means that there is a period of 1 1/2 months between expiry of the period for filing this request and the end of the technical preparations. This means it is feasible that the request is made too late to be allowable, but early enough to be published with the application.*

*For corrections to an existing priority, however, it is **just** possible for this request to be early enough to be published with the International application, but too late to be within the period under R26bis.1(a) PCT. This can only happen if the request is made:*

- *after expiry of the time limit under R26bis.1(a) PCT and also after one month from expiry of this time limit (such that it cannot be considered to be on time under R26bis.2(b) PCT), which would be 17 months from the earliest claimed priority, and,*
- *no later than the end of the technical preparations for publication [15 days prior to the publication date - which occurs 18 months after the earliest priority date - Art.21(2)(a) PCT, thus 17 1/2 months from the earliest claimed priority].*

*This would be a period of about two weeks. After this it would only be possible to publish any request under*

*R26bis.2(e) PCT separately from the International application. In this latter case, it appears unlikely publication under R26bis.2(e) PCT would allow the matter to be re-investigated by the EPO, since no warning would have been published with the International application and the public would not know of the potential correction of the claimed priority (J2/92), unless the error in the priority claim is evident (including the failure to claim priority at all).*

**I.8.6. Correction of the priority according to R91.1 PCT**

*R26bis PCT allows the correction and/or the addition of a priority claim. However, this rule may only be applied within 16 months of the earliest priority or 4 months of the filing date (R26bis.1(a) PCT), whichever expires later. Once this period expires, it might be possible for certain defects in the priority claim to be corrected under R91.1 PCT. This correction is however possible only if the error in the documents presented was obvious and does not imply a change in the priority date or the addition of a priority claim.*

R91.1(a) PCT Obvious errors in documents submitted by the applicant in the International phase may be corrected.

R91.1(c) PCT However the error and its correction must be apparent.

R91.1(g)(iv) PCT It is not possible to correct the priority claim according to R91.1(a) PCT, where this would change the priority date.

S&E-GL 8.10 Changes in the priority date can only be achieved via R26bis PCT [see § I.8.5].

S&E-GL 8.09 However, changes to the priority claim, other than a change in the priority date, may be made under R91 PCT.

*R91.1 PCT does not apply to the addition of a completely new priority claim either, since it is not obvious to the RO that the applicant should have claimed a particular priority. Furthermore, in cases where no other priority is claimed or where the priority added is earlier than all existing priority claims, this would also imply a change in the priority date.*

R91.1(g) PCT R91 PCT does not affect the operation of R26bis PCT.

*This means that, if when a request for correction of the priority is made, R26bis PCT is applicable and correction is made according to this rule, then the*

*restrictions of R91.1 PCT will not apply [i.e. when corrected under R26bis PCT the priority date can change and the error and correction need not be evident, whereas a correction under R91.1 PCT is only possible if the error and its correction are evident and the correction does not cause a change in the priority date].*

*R26bis.2(b) PCT sets out the consequences of not making a correction where this is requested and R26bis.1(a) PCT sets a very clear time limit for the applicant to make additions or corrections of the priority claim of his own motion [see § I.8.5].*

*However, if an error is noticed too late to request a correction under R26bis PCT, a correction under R91.1 PCT might still be possible because the time limit set in this rule expires later than that set in R26bis.1(a) PCT.*

*Clearly R91.1 PCT should not apply to the addition of a completely new priority claim since it is not obvious to the RO that the applicant should have claimed a particular priority and this is clearly covered by R26bis PCT.*

*However, the correction of an existing priority claim might still be possible according to R91.1 PCT where the error and correction are evident and R26bis PCT does not apply, because the error is realised too late. However, it is still not entirely clear whether or not R91 PCT can actually be used to correct the priority claim.*

**Request for correction**

R4.10(a) PCT The priority claim under Art.8(1) PCT must be in the request, therefore correction of the priority claim is a correction of the Request.

R91.1(b)(i) PCT A request for correction of the Request form should be made to the RO.

R91.2 PCT The request must specify:

- the mistake to be rectified
- the proposed rectification

The request may specify:

- a brief explanation

R26.4 PCT applies *mutatis mutandis*.

*\* This means that the applicant usually indicates the correction of the request in a letter.*

**Time limit for request**

R91.2 PCT The request for correction must be filed at the competent authority [the RO -

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	<i>R91.1(b)(1) PCT</i> ], within 26 months from the priority date*.		<i>as of the filing date under R91.3(c)(ii) PCT.</i>
	* <i>Since the priority date is not allowed to be modified by such a correction, this period cannot expire on a different date if the correction is allowed.</i>		<b>Information to other offices</b>
	<i>If it is possible to apply R91.2 PCT, when R26bis PCT no longer applies, then this type of correction becomes possible when the following requirements are satisfied:</i>	R91.3(a) PCT	The competent authority [ <i>if this is not the IB</i> ], informs the IB of the decision [ <i>to refuse or authorise the correction</i> ].
	- <i>The period for priority correction under R26bis.1(a) PCT has expired, and either:</i>	-	The IB will then, where required:
	- <i>the one month period for late correction calculated from expiry of this time limit [R26bis.2(b) PCT] has expired, or,</i>	-	- inform the RO
	- <i>the declaration of a void priority has been issued</i>	-	- inform the ISA
	- <i>the request for correction under R91.1 PCT is filed at the RO before 26 months after the earliest priority date.</i>	-	- inform the IPEA
		-	- inform the designated/elected offices
	<b>Decision on correction</b>		<b>Publication of a non-allowed request</b>
R91.3(a) PCT	The competent authority promptly decides whether to authorise the correction. It notifies the applicant of its decision (positive or negative).	R91.3(d) PCT	If the request for correction [ <i>here of the priority claim on the request</i> ] is refused by the competent authority, the applicant may request the IB* to publish:
	- If the decision is to refuse the request for correction, the decision will also indicate the reasons therefor.	-	the request for rectification
		-	the reasons for its refusal
		-	comments, if submitted by the applicant**
		* RO-GL 325	If the applicant files this request at the RO by mistake [ <i>and this is not the IB</i> ], that office will transmit the request to the IB.
			<i>However, it appears that it is the date of receipt at the IB which is used to work out whether the two month period under R91.3(d) PCT has been observed and not the date of receipt at the RO.</i>
R91.3(b) PCT	If the decision is to authorise the rectification, the document in question is rectified [ <i>here the priority claim on the request</i> ].	** RO-GL 306	These are comments which the applicant submits within the period under R91.3(d) PCT.
			<i>Presumably these comments would be for consideration by the designated offices if they re-consider the request for correction in the national/regional phase [see below].</i>
R91.3(c) PCT	Where the decision is to authorise the rectification, this decision becomes effective:	R91.3(d) PCT	In order to have the non-allowed request for correction published, the applicant must do the following at the IB:
	(i) in the case of a mistake in the International application, from the filing date;	-	file request within 2 months of refusal
	(ii) in the case of a mistake in any other document [ <i>including corrections of corrections or corrections of amendments in the International application</i> ], from the date of receipt of the submission of that [ <i>originally incorrect</i> ] document.	-	pay a special fee
		A.I. 113(b)	Clarifies that this fee must also be paid within the two months of the refusal.
	<i>It is highly advisable to provide the request form on the filing date of the application. This is because its filing constitutes the designation of all PCT states and at least one designation is required for a filing date to be accorded [PCT-AG I, 6.025 and Art.11(1) PCT - see § I.6.1].</i>	R91.3(d) PCT	If possible the request for correction is published along with the International application.
	<i>Consequently, where the request is provided on filing, the correction of the priority claim on that Request is effective</i>		<i>A request for correction of a priority claim under R91.1 PCT applies only if R26bis PCT is no longer applicable. Taking into account the time limits laid down in R26bis PCT [if a request for correction under R91.1 PCT is filed before these expire, it cannot be allowed because R26bis PCT still applies], the applicant has a very short period of time before completion of the technical preparations</i>

for publication [PCT-AG I, 9.013 - generally competed 15th day prior to the date of publication], in order to file a request under R91.3(d) PCT. If it is filed after that date, the mention of the non valid request for correction of priority will be published later by the IB.

The applicant also has the option under R26bis.2(e) PCT to request the IB to publish a request filed too late to be considered under R26bis PCT [see § I.8.5]. However, applying the procedure above under R91 PCT might have enabled the applicant to correct the priority after expiry of the time limit under R26bis.1(a) PCT and after the period for late correction under R26bis.2(b) PCT.

Euro-PCT Guide 518 If not in English, French or German, this published request must be translated on entry into the European phase.

*It is not clear if this translation would have to be provided within 31 months of the priority under Art.22 PCT/Art.39 PCT and R159 EPC or if it could be filed later.*

**Refused requests and designated offices**

PCT-AG I, 11.043 This publication of the refused request for correction allows the applicant to pursue the matter before the designated offices according to national law [to have them re-consider the request in the national/regional phase].

*In the case of a review by the EPO as designated office, the EPO usually allows a request for correction of the priority claim only if the public was warned of the error in the International publication (see in particular the decision J2/92) or if the presence of an error was evident for other reasons on the basis of the originally filed documents.*

**Rectification ignored by designated office**

R91.3(e) PCT The rectification of an obvious error can be ignored by designated offices where the processing or examination of the International application has already started before the office is notified by the IB of the rectification of the error under R91.3(a) PCT.

*The request for rectification can be filed as late as 26 months from the earliest claimed priority [R91.2 PCT]. If the RO delays in informing the IB of the decision allowing the correction according to R91.3(a) PCT, the IB might not be able to inform the designated office until more than 30 months after the earliest claimed priority*

*[in the case of the EPO 31 months - R159 EPC] and the designated office may have started to process or examine the application.*

*Another possible reason why this might happen, is where the applicant requests early entry into the national regional phase under Art.23(2) PCT [see § IV.1].*

R91.3(f) PCT A designated office may disregard a rectification authorised under R91.1 PCT only if it finds that it would not have authorised it under R91.1 PCT if it had been the competent authority.

- The designated office must give the applicant the chance to comment within a reasonable time limit on its intention to disregard the correction.

**Language of the correction**

R12.2(b)(ii) PCT A correction of the Request under R91.1(b)(i) PCT must be provided in the following languages:

- language of filing, **or**, where applicable,
- the language of any translation under R26.3ter(c) PCT\*

*\* This is where the applicant files the request form in a language not accepted by the RO and is then required by the RO to file a translation thereof into a publication language accepted by it [see § I.3.8].*

**I.8.7. Restoration of the priority period**

*The period for claiming priority is 12 months from the date of filing of the first application [Art.4C(1) PC and R2.4(a) PCT]. If this period is not met, the applicant may file a request for "restoration" [called re-establishment under the EPC]. For PCT applications restoration can be requested:*

- *in the International phase, before the RO, under R26bis.3 PCT [see sub-sections § I.8.7.1, § I.8.7.2, § I.8.7.3 and § I.8.7.4 below], and*
- *when entering the national or regional phase before the competent authorities of the designated states, under R49ter(2) PCT [see § IV.11.6.3].*

*If the request is made in the International phase, upon entry in the national or regional phase the designated offices may revise the decision of the RO [see § I.8.7.3, § IV.11.6.1 and § IV.11.6.2].*



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### I.8.7.1. Procedure for requesting restoration to the Receiving Office and decision thereon

R26bis.3(a) PCT Where the PCT application has a filing date which is:

- after expiry of the priority period\*, but
- within two months of that date [*of expiry*]

the applicant can request restoration of the priority right to the RO. This is subject to R26bis.1(b) PCT to R26bis.1(g) PCT [*see below*].

*R26bis.3(b) PCT to R26bis.3(g) PCT lay down the time limit for filing a request for restoration, the applicability of a fee and the need to file a reasoned statement and any supporting evidence or declaration.*

\* R2.4(a) PCT The term "priority period" means 12 months from the date of filing of the earlier application. The date of filing of the earlier application is not included in that period.

R2.4(b) PCT R80.5 PCT applies *mutatis mutandis* to the priority period.

*This means that the priority period is extended under the provisions of R80.5 PCT, e.g. where the filing office is closed [see § V.1.3.1].*

R4.1(c)(v) PCT The request for restoration can be included in the Request form.

PCT-AG I, 5.064 The PCT-SAFE software includes this possibility.

PCT-AG I, 5.064 The request may also be filed in a separate letter addressed to the RO.

#### ***Due care / unintentional failure***

R26bis.3(a) PCT The RO must be satisfied that the failure to file the PCT application within the priority period:

- (i) occurred in spite of due care required by the circumstances having been taken, or
- (ii) was unintentional

Each RO must apply at least one of these criteria. ROs may also apply both.

R26bis.3(i) PCT Each RO must inform the IB of which criterion it applies.

- Each RO must inform the IB if it changes the criterion to be applied.
- The IB publishes this information.

E-VIII, 2.3.5 & Euro-PCT Guide 629 The EPO applies the criterion of "due care". It does not apply the "unintentional" criterion.

*This is consistent with the requirements for re-establishment of rights under the EPC, which also applies to the priority period (A-III, 6.6) and which also applies the "due care" criterion (Art.122(1) EPC).*

RO-GL 166J "Due care" is only met if the applicant has taken all measures which a reasonably prudent applicant would have taken.

- The applicant must show due care for the specific application in question, not for PCT applications in general.

RO-GL 166K Due care is required of both the applicant and, if appointed, his agent.

- For the applicant, normally the appointment of a qualified agent is sufficient to demonstrate that he [*the applicant*] took due care.

*The appointment of an agent means that applicant can, in most cases, take for granted that his agent will then file the application in time.*

*Where the agent then fails to do this, he would then have to prove that he also took due care, but this would then mean justifying why he (the agent) missed the priority period.*

*Clearly if the applicant files the application himself and only employs an agent later, then the above does not apply. In this case, a justification as to why the applicant missed the priority period would have to be provided.*

RO-GL 166I The applicant satisfies the "unintentionality" criterion if he demonstrates that he did not deliberately refrain from filing the international application within the priority period and that he had a continuing underlying intention to file the PCT application within the priority period.

- The Receiving Office should focus on the applicant's intent at the time when the priority period expired, irrespective of any changes in the applicant's intent before or after the expiration of the priority period.

#### ***Invitation to correct the priority***

*A request for restoration can be filed by the applicant of his own motion or after an invitation according to the procedure indicated below.*

R26bis.2(a) PCT Where the following applies:

- the filing date is after expiry of the priority period, and
- a period of two months from expiry of the priority period [*the time limit under*

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- R26bis.3(e) PCT - see below*] has not yet expired,
- the RO or IB will inform the applicant of the possibility of requesting restoration of the priority right under R26bis.3 PCT.
- However, according to R26bis.2(a) PCT the IB and RO will not do this if the RO does not apply restoration of the priority because it has entered a reservation according to R26bis.2(j) PCT. In this case, the applicant's only choices are:*
- *to correct the priority date (if the priority date was incorrect and the correct date is less than 12 months before the filing date - see § I.8.5), or,*
  - *to request the RO, on time and without invitation according to R26bis.2(a) PCT, to restore the priority anyway and then request the RO to forward the application to the IB as RO under R19.4 PCT [see below].*
- Reasoned statement**
- R26bis.3(b)(ii) PCT A request for restoration of the priority made under R26bis.3(a) PCT must state the reasons.
- PCT-AG I, 5.064 The reasons can be provided along with the request for restoration, or can be provided later, provided they are filed before expiration of the time limit under R26bis.3(e) PCT [*i.e. within the same time limit for filing the request for restoration, see below*].
- Evidence and/or declaration**
- R26bis.3(b)(iii) PCT A request for restoration of the priority made under R26bis.3(a) PCT shall preferably be accompanied by any declaration or other evidence required under R26bis.3(f) PCT.
- R26bis.3(f) PCT The RO may require the applicant to provide a declaration or other evidence in support of the statement of reasons provided under R26bis.3(b)(iii) PCT.
- A "declaration" could be, for example, a statement written by the applicant in a particular form, where he indicates the circumstances which led to the missing of the priority period.*
- The "evidence" could be in the form of documentary evidence proving certain facts which led to the missing of the priority period.*
- Euro-PCT Guide 133 The EPO requires the filing of evidence, "*where available*".
- RO-GL 166F For the "*unintentionality*" criterion, a statement indicating that the failure to
- comply with the priority period was not deliberate may be sufficient.
- RO-GL 166G However, the RO may require the applicant to submit this statement in the form of a declaration and may require that the statement provides reasons and be supported by evidence.
- R26bis.3(f) PCT This declaration or evidence [*in support of either criterion*] would have to be provided within a time limit which is reasonable under the circumstances.
- If the RO intends to refuse the request for restoration of the priority period, it can combine a communication requesting the filing of any declaration / evidence which it requires along with a communication under R26bis.3(g) PCT, warning the applicant of its intention to refuse the request [see below "Intended refusal of the request"].*
- PCT-AG I, 5.067 If the applicant has already provided evidence, but this is not considered sufficient by the RO, the RO can issue a communication under R26bis.3(f) PCT in this case as well [*requesting appropriate evidence*].
- R26bis.3(f) PCT The applicant can also provide the IB with a copy of this declaration or evidence so that this can be included in the files of the IB.
- RO-GL 166C This allows the IB to make these documents available to the designated offices to enable them to carry out the limited review provided for in R49ter.1(d) PCT [*see § I.8.7.3*].
- Late priority claim and restoration**
- R26bis.3(c) PCT Where a priority claim is not contained in the PCT application, the applicant must submit, within the time limit under R26bis.3(e) PCT, a notice under R26bis.1(a) PCT, adding the priority claim.
- R26bis.1(a) PCT allows the addition of a priority claim to the application, see § I.8.5. R26bis.3(c) PCT allows the applicant to combine such a request with a request for restoration, if the added priority claim results in a priority period of more than 12 months. Note, however, that where the applicant wishes to restore the priority period in respect of a late added priority claim, the time limit under R26bis.3(e) PCT applies, not that under R26bis.1(a) PCT.*
- If the applicant fails to add the priority claim in question within the period under R26bis.3(e) PCT, then the priority period*

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will not be restored, even if the period under R26bis.1(a) PCT was met. That is to say, in the absence of a valid request for restoration, a request to add a priority claim from an application filed more than 12 months before the filing of the International application would not be valid even if the period of R26bis.1(a) PCT to file a new priority is met, because the applicant's failure to file the application within the 12 months after the priority date would not be excusable (Art.8 PCT and Art.4 PC) and such a priority would not be valid.

### Restoration fee

R26bis.3(d) PCT The RO may charge a fee for restoration of the priority right.

- The RO fixes the amount of this fee.

Rfees 2(1).13 EPC The EPO acting as RO charges this fee. It is the same amount as the fee for re-establishment of rights under Art.122 EPC and R136 EPC.

PCT-AG I, 5.064 Annex C of the applicant's guide states which ROs charge a restoration fee.

R26bis.3(d) PCT This fee is payable within the period according to R26bis.3(e) PCT.

- The time limit for payment can be extended, at the option of the RO, by up to two months from expiry of the period under R26bis.3(e) PCT.

Euro-PCT Guide 133 The EPO acting as RO **does not** extend the period for paying the restoration fee.

Point 3.3(g) AAD The restoration fee is subject to automatic debiting before the EPO as RO.

### Time limit for requesting restoration

R26bis.3(b)(i) PCT A request for restoration of the priority made under R26bis.3(a) PCT must be made within the time limit set under R26bis.3(e) PCT.

R26bis.3(e) PCT The time limit for the request is two months from expiry of the priority period.

This time limit applies where there is no early publication on request of the applicant under Art.21(2)(b) PCT.

R2.4(b) PCT R80.5 PCT applies *mutatis mutandis* to the priority period.

Art.4C(3) PC

R80.5 PCT If the last day of the period is an official holiday, or a day when the International authority concerned is not open for the filing of applications, the period is extended until the first following day when that authority can receive the application.

Consequently, since the priority period can be extended under R80.5 PCT, where the 12 month period expires on a holiday at the RO, then it expires later than would otherwise be the case. Since the date of expiry is later, this then means that the period for filing the request for restoration of the priority starts later as well. This demonstrates, that, in theory, the period for requesting the restoration of the priority is an aggregate time limit.

Conversely, if the priority period is curtailed, because the 12th month thereafter has no day of the same number, then the second period starts earlier, on the date after the end of that "curtailed period" [this would only happen where the priority is filed in a leap year on 29 February, the priority period would then expire the following year on 28 February]. This would then mean that the period for requesting restoration would start earlier than would otherwise be the case.

For more information on R80.5 PCT see § V.1.3.1.

### Acts to be completed within two months of the expired priority [R26bis.3(e) PCT]

R26bis.3(e) PCT The above time limit applies to the filing of the following:

- The request for restoration of the priority under R26bis.3(b)(i) PCT.
- The combined request for addition of a late priority claim under R26bis.1(a) PCT and for restoration under R26bis.3(c) PCT, where applicable [see above].
- The payment of the restoration fee where the RO prescribes one [and does not grant an extension for late payment, which EPO does not - Euro-PCT Guide 133].

RO-GL 166D The reasoning is also required within the 2m period [according to R26bis.3(b)(ii) PCT the reasons behind the request for restoration of the priority are a part of the request itself, consequently this reasoning must also be provided within the above 2m period].

### Acts which can be completed later than two months after the expired priority

R26bis.3(d) PCT The priority restoration fee is payable within the period according to R26bis.3(e) PCT [within two months of expiry of the priority period].

- However, this time limit for payment can be extended, at the option of the RO, by up to two months from expiry of the period under R26bis.3(e) PCT.

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- Euro-PCT Guide 133 The EPO acting as RO **does not** extend the period for paying the restoration fee.
- The fullest extension of this period would mean it would expire four months after the expiry of the priority period, which is still 16 months after the priority and so well before publication (18 months after the priority under Art.21(2)(a) PCT).*
- R26bis.3(f) PCT A declaration or evidence, where required by the RO [see above], would have to be provided within a time limit which is reasonable under the circumstances.
- Consequently, it is not a requirement of the PCT that these items be provided within the period specified under R26bis.3(e) PCT.*
- Where a declaration of evidence is missing or insufficient, the RO invites the applicant to provide it within a reasonable time limit according to R26bis.3(f) PCT using Form PCT/RO/158 (see "**Intended refusal of the request**" below).*
- Time limit and early publication**
- R26bis.3(e) PCT In case of early publication on request of the applicant under Art.21(2)(b) PCT [see § II.12.2], if any of the above items [request for restoration of priority, reasoning, request for late addition of priority, fee payment] are filed/paid after the end of the technical preparations for publication\*, they are deemed not received/paid in time.
- \* PCT-AG I, 9.013 The technical preparations for publication are generally completed by the 15th day prior to the date of publication.
- Consequently, in cases of early publication on request, if the time limit under R26bis.3(e) PCT expires after the end of the technical preparations for publication, then it is curtailed to expire when the technical preparations are completed. This also applies to the payment of the restoration fee. The period for payment of this fee can be extended by up to two months after expiry of the period for requesting restoration of the priority, but this does not apply where the extended period would expire after the end of the technical preparations for publication.*
- Intended refusal of the request**
- R26bis.3(g) PCT Before refusing the request totally or in part [see "**partial loss of rights**" below], the RO must give the applicant the chance to comment on the intended refusal.
- RO-GL 166N This communication of intended refusal is made on Form: PCT/RO/158.
- R26bis.3(g) PCT A notice of intended refusal may be sent to the applicant together with an invitation to file a declaration or evidence under R26bis.3(f) PCT [see above].
- R26bis.3(f) PCT allows the RO to invite the applicant to provide a (corrected) declaration and/or evidence after expiry of the 2m period under R26bis.3(e) PCT.*
- RO-GL 166F This R26bis.3(f) PCT invitation is also sent using Form PCT/RO/158.
- This means that if the applicant has not filed a declaration or evidence required by the RO and this is part of the reason for the ROs intention to refuse the request, the RO combines the communication under R26bis.3(g) WPCT (warning him of the impending refusal of the request) and the communication under R26bis.3(f) PCT (informing him that he should file the declaration and/or evidence required).*
- Furthermore, this combined communication can simultaneously invite the applicant to supplement his reasons within the original 2m period under R26bis.3(e) PCT and at the same time, file additional evidence and/or a (corrected) declaration within a different and more generous time limit set in this communication (which can consequently expire after the 2m period under R26bis.3(e) PCT has expired).*
- RO-GL 166F This invitation will explain why the RO is not convinced.
- RO-GL 166F Where restoration has been requested in respect of more than one priority claim and more than one such request is deficient, where the use of a single form would not be clear, a separate invitation under R26bis.3(f) PCT/R26bis.3(g) PCT is sent in respect of each priority affected.
- Partial loss of rights**
- There are two occasions where a partial refusal of the request might be foreseen. An RO may apply both the "due care" and the "unintentional" criteria under R26bis.3(a) PCT. If that office finds that the more rigorous "due care" criterion is not met, but the less rigorous "unintentional" criterion is satisfied (see RO-GL 166O), the applicant might want the RO to reconsider this since certain designated offices would, under R49ter.1(b) PCT, not then accept this restoration of the priority right because the "unintentional" criterion is not in*

accordance with their national law (e.g. the EPO does not apply the "unintentional" criterion - E-VIII, 2.3.5).

Another possible case where a request might be partially allowable and partially not, is where restoration is requested for more than one priority and the request is allowable in respect of at least one but not all of those priorities. However, it is also possible that each request in respect of each priority would be considered separately. This is also not clarified in the RO-GL, PCT-AG I or Euro-PCT Guide.

**The decision**

R26bis.3(h) PCT The RO promptly:

- (i) informs the IB of the request
- (ii) decides on the request
- (iii) notifies applicant/IB of the:
  - decision, and
  - criterion used (due care/unintentional)

RO-GL 1660 Where the RO applies both criteria, its decision may reject the restoration on the basis of the more rigorous "due care" criterion, but allow it under the less rigorous "unintentionality" criterion.

**I.8.7.2. Information on restoration of priority in published application**

R48.2(a)(xi) PCT The application as published shall contain:

- information concerning restoration request
- the decision of the RO on the request
- information on the criterion applied\*

\* That is, whether the "due care" or the "unintentional" criterion was used by the RO in deciding whether to grant restoration of the priority period [R26bis.3(a) PCT].

R48.2(b)(vii) PCT The front page of the application as published indicates that the application contains such matter [including an indication of the decision of the RO on the request].

R48.2(b)(viii) PCT The front page of the application also indicates if the applicant has provided to the IB either or both of the following according to R26bis.3(f) PCT:

- copies of any declaration\*
- other evidence\*\*

\* This includes a declaration of the unintentional failure to observe the priority period [see above].

\*\* This includes evidence that the "due care" criterion was observed [see above].

Note that the above evidence/declaration must be provided to the RO in order to be taken into account in deciding whether to allow the request for restoration of the priority period. The applicant **may** provide copies to the IB as well, but is not obliged to [R26bis.3(f) PCT – unless the IB is also the RO]. However, if the applicant does not provide copies to the IB, then they will not be mentioned in the published application.

R48.2(j) PCT

**If** the following apply:

- the technical preparations\* for publication are completed, **and**,
  - a request under R26bis.3 PCT is still pending,
- then** instead of indicating the decision, the published application indicates that the decision has not yet been reached.

\* This is generally 15 days prior to publication, which occurs 18 months after the priority under Art.21(2)(a) PCT [PCT-AG I, 9.013].

This means that the application as published will indicate:

- information concerning restoration request
- the decision on the request is still pending
- information on the criterion applied

R48.2(j) PCT

The published application will then indicate that the decision will be published separately when it becomes available.

**I.8.7.3. Restoration of priority - effect and possible review in national or regional phase**

The grant or refusal of restoration of the priority period by the RO can be subject to review after the application has passed into the national/regional phase. Furthermore, the applicant may request restoration of the priority right before a designated office after entry into the national/regional phase [R49ter.2(a) PCT]. For more information on this topic with regard to treatment under the EPC, see § IV.11.6.

**Restoration: effect in designated states**

R49ter.1(a) PCT

Where the receiving Office has restored the priority right under R26bis.3 PCT on the basis of the "due care" criterion, that restoration is effective in each designated State.

However, this is subject to R49ter.1(c) PCT [i.e. that the designated office can later find that the request should not have been considered valid by the RO].

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- R49ter.1(b) PCT A decision of restoration made by the RO under R26bis.3 PCT based on the “*unintentional*” criterion is only valid in those states where this criterion is also accepted under the applicable national law [or regional law].
- E-VIII, 2.3.5 The EPO only accepts the criterion of “*due care*” as a ground for restoration. Any restoration made by an RO under R26bis.3 PCT based on the “*unintentional*” criterion is invalid before the EPO.
- Restoration by RO not accepted by designated office**
- R49ter.1(c) PCT A decision granting restoration made by the RO under R26bis.3 PCT is not effective in the designated states which find that the requirements provided under R26bis.3 PCT were not complied with [*i.e. that the request was filed at the RO within 2 months of the expired period, that any fee due was paid, and that the reasons for missing the period were duly indicated and were satisfactory*].
- Review of positive restoration decision**
- R49ter.1(d) PCT The designated office may only review the decision of an RO if it has a reasonable doubt that a condition under R49ter.1(c) PCT was met. In such case the applicant must be informed and given opportunity to make observations within a given period.
- PCT-AG I, 5.069 A review is not possible on purely formal grounds, e.g. that the restoration fee was not paid.
- Euro-PCT Guide 137 Where the EPO grants restoration of the priority as RO [R26bis.3 PCT], it will not review this decision in the European phase under R49ter PCT.
- Designated office review of refusal of restoration by the RO**
- R49ter.1(e) PCT No designated State shall be bound by a decision of the receiving Office refusing a request under Rule 26bis.3 PCT for restoration of the right of priority.
- R49ter.1(f) PCT Where the RO refuses the request, any designated office\* may consider that request to be a request for restoration of the priority right in the national/regional phase before that office under R49ter.2(a) PCT [see § IV.11.6].
- \* R76.5 PCT R49ter PCT also applies to **elected** offices.
- Requesting restoration before the designated offices**
- The applicant may also request restoration of the priority right before a designated office after entry into the national/regional phase under R49ter.2(a) PCT. For more information on this topic, and in particular with regard to treatment under the EPC, [see § IV.11.6].*
- I.8.7.4. Reservations**
- R26bis.3(j) PCT If, on 05.10.2005, the following rules are not compatible with the national law applied by the RO:
- R26bis.3(a) PCT to
  - R26bis.3(i) PCT
- then these will not apply to that RO.
- The RO in question must have informed the IB by 05.04.2006.
  - This applies for as long as the above rules continue to be incompatible with the national law applied by the RO.
- Currently the following ROs have such a reservation: BE, BR, CO, CU, CZ, DE, DZ, GR, ID, IN, IT, KR, NO, PH [situation 18.09.2015].*
- PCT-AG I, 5.062 An up to date list of states applying this reservation can be found on WIPO’s Internet site.
- RO-GL 166B Where an RO applies such a reservation and still receives a request for restoration of the priority, it requests the IB to act as RO under R19.4(a)(iii) PCT\*.
- \* *For more details on transmittal to the IB as RO under R19.4 PCT, see § I.2.2.*
- PCT-AG I, 5.062 If the need to request restoration of the priority only becomes apparent after filing, the applicant can request the RO to transmit the application to the IB as RO.
- R19.4(a)(iii) PCT allows the IB to act as RO if the office where the application was originally filed does not allow for restoration of the priority because of a reservation. Since the IB allows restoration of the priority when acting as RO, if the IB and the applicant both agree [the applicant’s consent being implied by his request], the IB will then act as the RO and the request for restoration can be examined by the IB.*
- Presumably, the office where the application was originally filed, will forward not only the application to the IB as RO under R19.4(a)(iii) PCT and R19.4(b) PCT, but also the request for*

restoration of the priority. If this does not happen, then the applicant would have to file it again at the IB.

In these cases of transmittal of the application to the IB as RO, the period under R26bis.3(e) PCT for filing the request for restoration of the priority remains unchanged (2 months after the expiry of the priority period). Consequently, if the applicant does not file the request until after this period has expired, it is not clear if the original RO will:

- not transmit the application to the IB, since the request is too late, or
- transmit the application to the IB and allow it to decide whether or not it considers the request to have been filed in time.

It is also unclear what would happen if the request for restoration of the priority is filed at the office where the application was originally filed within the time limit of R26bis.3(e) PCT, but this did not reach the IB before expiry of this period (either because it was forwarded by that office to the IB too late or was not forwarded at all and was not filed in time at the IB by the applicant). R19.4(b) PCT indicates that application is deemed to have been filed at the IB on the same date that it was received at the original RO. However, the application does not include a request for restoration of the priority under R26bis.3(a) PCT.

Consequently, where the applicant files a request for restoration of the priority at an RO which has entered such a reservation, it would be advisable for the applicant to indicate in that request that he requests transmittal of the application under R19.4 PCT (provided for in PCT-AG I, 5.062) and to file a copy of the request directly at the IB before expiry of the period under R26bis.3(e) PCT.

#### **Effects in the national-regional phase**

The granting or refusal of restoration of the priority period by the RO is subject to review after the application has passed into the national/regional phase. Furthermore, the applicant may request restoration of the priority right before a designated office after entry into the national/regional phase [R49ter.2(a) PCT]. For more information on this topic with regard to treatment under the EPC, see § IV.11.6.

## **I.9.**

### **Examination of formal requirements before the Receiving Office**

The formal requirements of an International application are checked by the RO. First the application is checked to see if it can be assigned a filing date (Art.11 PCT) and then it is subjected to the formalities check (Art.14 PCT).

In theory, according to Art.27(1) PCT, the application does not need to comply with further formal requirements when passing into the national or regional phase. However, the PCT provides certain exceptions where the designated offices may insist on further formal requirements being satisfied.

#### **Formal requirements and national law**

Art.27(1) PCT National law cannot require the applicant to conform to the requirements of form and/or content which are different from or additional to those of PCT.

This means that once the RO has accorded a filing date and verified that the other requirements of form and content are met, the national offices of the designated states cannot impose other stricter requirements and the International application must be acknowledged by all of them (Art.2(xii) PCT - this includes regional offices e.g. EPO).

This is, however, subject to the notable exceptions given below:

#### **Exceptions under Art.27(3) PCT and Art.7(2)(ii) PCT**

Art.27(3) PCT Where the national law of a contracting state provides that the inventor is the only qualified applicant, and where the applicant is not also the inventor, the International application can be rejected by that office [*this provision was used by the USA - see § I.1.1*].

Art.7(2)(ii) PCT Designated offices may require the presence of drawings in the application as a national requirement [*see § I.9.5*].

## **I.9.1.**

### **Contents of the application**

Art.3(2) PCT The International application must contain:

- a request
- a description
- at least one claim
- one or more drawings (if required)
- an abstract

The presence of some of these components has already been checked when the filing