



Crikey! The PCT filing deadline has passed inadvertently

How to still save your priority date

The time limit for filing a patent application claiming priority from an earlier application is 12 months from the earlier application's filing date. But what if you realise that you have missed the deadline – does that mean it's "game over"? Not necessarily.

It is possible *in certain circumstances* to file an application and request restoration of the priority right up to **14 months** from the first filing date. This article takes you through the PCT restoration process and, in particular, highlights areas where special care needs to be exercised, setting out points you should be aware of in order for the right of priority to be restored and recognised in the national phase.

It is important to note however that whilst it is possible to obtain restoration of the right of priority in the international phase, there are some territories where the national law simply does not allow the right of priority to be restored once lost – a list of these IP Offices can be found [here](#).

Where to file the restoration request?

The request for restoration can be filed at the **Receiving Office** (i.e. upon entering the international phase), as well as at the **Designated Office** (i.e. on entering the national/regional phase).

Different offices apply different criteria in assessing whether a restoration will succeed, but how do you decide where to file your restoration request? Assuming that one or more national offices in which you are interested recognises the restoration of the right of priority in principle, you will want to find the easiest process which is likely to be recognised without further actions being required in the national phase. Whether the Designated Office will recognise the restoration will generally depend on whether the Receiving Office made its decision based on a sufficiently stringent basis, i.e. on the basis of the due care criterion discussed below, where necessary. If not, then further individual requests for restoration may be needed in some of the national phases, which is possible.

Receiving Offices and Designated Offices that recognise the restoration of the right of priority must apply at least one of the following criteria when deciding on such a request by an applicant – the applicant needs to show that in spite of the relevant deadline having been missed:

1. **Due care required by the circumstances** had been taken; and/or
2. Missing the deadline was **unintentional**.

The details of which office applies which criteria can be found in a useful table [here](#).



This sets out which territories' offices recognise the restoration of the right of priority, whether they apply it in their capacity as a Receiving Office, Designated Office or both – and which standard they apply in assessing a restoration request.

'Due care' is a difficult standard to meet – and that is what the EPO applies when acting as a Receiving Office as well as when it's acting as a Designated Office (so you need to be able to satisfy the due care criterion if you want to restore the priority date for Europe). The 'unintentional' standard is much lower and is generally quite easy to satisfy – the USPTO applies the unintentional standard.

Restoration of the right of priority at the Receiving Office is governed by Rule 26*bis* PCT, while restoration at a Designated Office is governed by Rule 49ter2 PCT – the criteria are similar under both Rules.

At the Receiving Office

Using the United States example – the right of priority can be restored where the USPTO is acting as the Receiving Office (at the 12 month stage) as well as where the USPTO is acting as a Designated Office (at 30 months). However, the USPTO applies *only* the lower, *unintentional standard*.

If we look at the EPO as an example, similarly to the USPTO, the right of priority can be restored where the EPO is acting as the Receiving Office (at the 12 month stage) as well as where the EPO is acting as a Designated Office (at 31 months) – but the *only* standard applied by the EPO at both stages is *due care*.

The effect of this is that if, for example, you apply for restoration at the USPTO as Receiving Office and succeed under the unintentional standard (which is the only standard the USPTO applies and therefore

the only one available at the USPTO), when you come to the national/regional phase and if you want to enter Europe (at 31 months), you will need to *file another restoration request at the EPO* as Designated Office, since the standard under which the priority was restored at the USPTO was *not* the higher due care standard which is demanded by the EPO's strict rules.

The IB can be very helpful

Why would you want to apply for restoration twice if you don't need to? Fortunately, there is a way of avoiding a situation like the one described above where you end up having to file a restoration request at both the Receiving Office and the Designated Office. This is by filing your restoration request at the **International Bureau of WIPO** (the "IB") and this option is always available. The advantage of doing so is that the IB applies *both* the due care standard *and* the unintentional standard when assessing requests for restoration of priority, and you can always file at the IB. The IB will automatically review the application first under the due care criterion and then under the unintentional criterion.

If the IB allows restoration, this is generally accepted by all national offices (obviously apart from those offices whose national law does not recognise restoration of the priority right at all) and if the restoration request is unsuccessful at the IB (or at any other receiving office) either wholly or in part e.g. restoration is allowed only in respect of the unintentional criterion, a request for restoration can still be filed at the Designated Offices.

Not so intuitive – Rule 26*bis*.2(c)(iii) PCT

When trying to restore the right to priority, you need to be aware of something which is important but is also counterintuitive in many ways and that is PCT Rule 26*bis*.2(c)(iii).



Even if the restoration request does not succeed at the Receiving Office (or if you are in a situation where the receiving Office is one which has notified the International Bureau (IB) of the incompatibility of PCT Rule 26bis.3 with its national law), PCT Rule 26bis.2(c)(iii) – which is applicable to **all** receiving Offices – provides that **a priority claim is not to be considered void** for the purposes of the international phase **if the international filing date is within two months from the date on which the priority period expired.**

Therefore, the date of the earlier application will still serve as a basis to calculate time limits during the international phase. So the clock carries on ticking based on the earliest priority date, and if that priority date was included on the PCT Request Form – it remains as the date from which all subsequent deadlines are to be calculated. Docketing deadlines should therefore not be reset in a situation where a restoration request at the Receiving office has not succeeded.

There have been instances where on receiving a notice stating that the priority restoration request had been refused, the applicant deleted the priority date from its docketing records system. The effect of this has been to move all of the reminders for national phase entry forward by twelve months, based on the international filing date as the first date (when in fact the dates and reminders should not have been changed at all) – resulting in the applicant being rather shocked when it received notices of loss of rights for failure to enter various national phases, when they thought they had the best part of a year to go before they were due to enter the national phase, since that's what their records system indicated.

The Effect of the Receiving Office Decision

Rule 49ter.1

Where the right of priority has been restored by the Receiving Office

This decision is in principle binding on the Designated Office (but a limited review is possible).

Where the request for restoration of the right of priority has been refused by the Receiving Office

No designated State is bound by the decision of the Receiving Office – i.e. you can try again when you enter the national/regional phase (although this can turn out to be a rather expensive exercise).

At the Designated Office

Some specifics when restoring the right of priority at the various Designated Offices (Rule 49ter.1)

You can request the restoration of the right of priority in the national phase rather than in the international phase in the following situations:

- if the Receiving Office *refused* the request for restoration; or
- if *you simply did not request restoration* of the right of priority during the international phase.

If you request the restoration of the priority right before the Designated Office, there are several conditions which must be met and actions that must be taken. These are:

- the request for restoration must be filed within a time limit of one month from the applicable time limit under PCT Article 22. As was indicated above, even where the Receiving Office has refused to restore the right of priority, the priority claim remains in the application and time limits will be calculated from the filing date of the priority claim which has not been restored, including the time limit under PCT Article 22; and
- the request should state the reasons for the failure to file the international application within the priority period and – where applicable before the Designated Office concerned – be accompanied by any declaration or other evidence required and a fee.

The Designated Office will restore the right of priority if it finds that the criterion for restoration under its own rules is satisfied.



In Summary

There are just two main points:

Make sure you have received all necessary instructions and have documents ready to file **well before the end of the 12-month priority period** in order to avoid any problems caused by unexpected last-minute delays.

Have a 'Rolls-Royce' records management and docketing system in place so that in the event that you ever need to, you can very easily show *due care* – i.e. if it weren't for that awful, unexpected, unavoidable event that occurred, it's obvious to anybody that your established top-notch office system had everything under control – normally it just purrs and purrs, like a Rolls-Royce.

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Need advice?

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