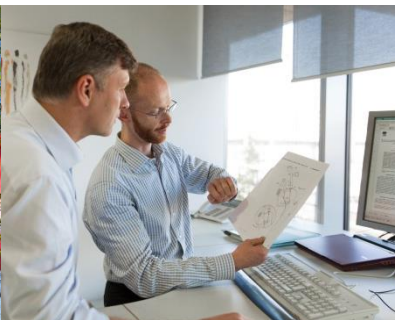




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Practical advice and examples II

Restoration of the right of priority



Restoration of the right of priority

- Patent Law Treaty (PLT) introduces the concept of restoration of the right of priority (Article 13)
- Implemented in the PCT since 01.04.2007 (Rule 26bis.3)
- Incompatibility with national law:
 - To date 13 Offices acting as RO: BR, CO, CU, CZ, DE, DZ, GR, ID, IN, IT, KR, NO, PH
 - To date 14 Offices acting as DO/EO: BR, CA, CN, CO, CU, CZ, DE, DZ, ID, IN, KR, MX, NO, PH

Objectives

- **Maintain the right of priority** even if the international application is filed after the expiry of the priority year, for a period of up to 2 months from the 12-month time limit under Paris Convention
- Harmonisation
- In practice, however, there are two criteria for harmonisation:
 - non-intentionality and
 - due care

Decision by RO: admissibility

- **International filing date within 2 months from the date on which the priority period expired**
- Within this 2-month period:
 - Filing **request** for restoration
 - Paying **fee** for restoration (RO/EP: 640 EUR); time limit for payment may be extended by 2 months (exceptionally)
 - Furnishing **statement of reasons**; may be supported by declarations or other evidence

Decision by RO: merits (1/4)

- RO applies at least one of these two criteria:
 - ‘failure to file within the priority period occurred **in spite of due care** required by the circumstances having been taken’
 - ‘failure to file within the priority period was **unintentional**’
- Interpretation available in PCT/GL/RO (166 ff)

Decision by RO: merits (2/4)

- RO/EP applies only 'due care' criterion in line with EPC law and practice (Article 122 EPC)
- Non-compliance with the time limit must result either from:
 - an exceptional circumstance, or
 - an isolated mistake within a normally satisfactory system for monitoring time limits

Decision by RO: merits (3/4)

- Primary responsibility lies with the applicant:
 - proper instructions to the agent
- Agent has to show due care by virtue of the delegation:
 - expertise entails higher standard
- ‘Due care’ of the agent in dealing with an assistant: isolated mistake by an assistant dealing with a routine task, and:
 - suitable person selected for the task
 - properly instructed
 - reasonably supervised

Decision by RO: merits (4/4)

- General guidance:
 - The circumstances of a case must be considered as a whole
 - Relevant situation: the situation as it stood before the time limit expired
 - Due care must not be interpreted in an excessive manner
 - Reference: average, reasonably competent applicant and agent
 - PCT/RO/158

Real examples: Postal services

Example 1: Irregularity in mail service	Example 2: Force majeure
<ul style="list-style-type: none">• Agent selected a well-known postal delivery service• Proper instructions were delivered• The package was wrongly stored by the delivery service• The international application was filed past the priority period	<ul style="list-style-type: none">• Agent selected a well-known postal delivery service• Proper instructions were delivered• The postal delivery service went on strike• The international application was filed past the priority period

Real examples: Unrepresented individual applicant

Example 3: Ignorance of the law	Example 4: Missed entry in diary
<ul style="list-style-type: none">• Individual applicant• Not familiar with the PCT• Invoked ignorance of the consequences of missing the priority period	<ul style="list-style-type: none">• Individual applicant• Aware of the importance of filing prior to the expiry of the priority period• Monitored time limits using his computer diary• Miscalculated the 12-month time limit

Real examples: Represented applicant

Example 5: Wrong instructions	Example 6: Combined circumstances
<ul style="list-style-type: none">• Agent requests applicant to instruct whether an international application should be filed• Applicant replies in the affirmative, but indicates the wrong file number• Agent requests clarification twice• Applicant calls agent on the day of the deadline to confirm the request to file• Agent files application past midnight	<ul style="list-style-type: none">• Agent receives a request to file with amendments on the last day of priority period• The online filing system delivers an error message• The master key to the fax room is nowhere to be found• The fax is in 'save energy' mode• The application is only transmitted past midnight

Real examples: Exceptional circumstances

Example 7: Sudden illness	Example 8: Not so sudden illness
<ul style="list-style-type: none">• Small company• Agent stayed on duty in spite of pain, medical certificate was submitted (confidential)• Online transmission was received shortly past midnight of the last day of the priority period	<ul style="list-style-type: none">• Large company• Agent absent through illness on the date of expiry of the priority period• No deputy appointed• International application filed upon return of the agent

Real examples: Cross-check mechanism

Example 9: Small company	Example 10: Big company
<ul style="list-style-type: none">• Two agents and one assistant• The assistant monitors time limits• Time limits are docketed in an electronic calendar• The wrong time limit was inadvertently entered• This was only noticed after expiry of the time limit, during a weekly review of open files	<ul style="list-style-type: none">• Several agents and assistants, numerous files• One assistant monitors time limits for one agent• Time limits are docketed in an electronic calendar• The wrong time limit was inadvertently entered• This was only noticed after expiry of the time limit, during a weekly review of open files

Real examples: Agent with assistant (1/2)

Example 11: Supervision	Example 12: Foreseeable absence
<ul style="list-style-type: none">• Assistant miscalculates priority period• Wrong date entered in the state of the art electronic tool for monitoring time limits• Experienced assistant without formal training• Written instructions by email• Periodical checks by the agent of the work carried out by the assistant	<ul style="list-style-type: none">• Main assistant on maternity leave• New temporary replacement hired• Ordered to continue monitoring time limits in the same way as she had done in her former position• No further measures taken• Time limit inadvertently missed

Real examples: Agent with assistant (2/2)

Example 13: Technically qualified assistant

- The assistant is an engineer training for the EQE (passed paper D)
- Instructed to draft the application
- Agent out of office on the last day of the priority period
- Assistant instructed to sign and submit the application using the smart card of the agent

Restoration at the DO: effect (Rule 49ter.1 PCT)

- Restoration by RO under **‘due care’ criterion**:
 - in principle, effective in all DOs (except those that notified incompatibility with national law)
 - however, the DO can review the decision by the RO if it reasonably doubts that one of the substantive requirements for restoration is complied with.

- Restoration by RO under **‘unintentional’ criterion**:
 - only effective in DOs that apply this criterion
 - if DO does apply the due care criterion, priority not considered restored

Practice at DO/EP

- 'Due care' criterion
- The applicant must file **a new request for restoration upon entry** where:
 - no request was filed during the international phase
 - RO granted under the 'unintentional' criterion
 - RO rejected the request for restoration
- In addition, DO may review a decision to restore when it has reasonable doubts as to whether one of the substantive requirements for restoration was complied with

Many thanks for your attention!