

C. PCT 1372

February 20, 2013

Madam,  
Sir,

*Proposed modifications to the PCT Receiving Office Guidelines*

This Circular is addressed to your Office in its capacity as Receiving Office (RO) for the purpose of consultation on proposed modifications to the PCT Receiving Office Guidelines (ROGLs). It is also addressed to certain non-governmental organizations representing users of the PCT system.

At the Fifth Session of the PCT Working Group, held in Geneva from May 29 to June 1, 2012, it was agreed that the International Bureau would consult with Offices on proposed modifications to the ROGLs dealing with the restoration of the right of priority under PCT Rule 26*bis*.3 (see documents PCT/WG/5/13, paragraph 29(d) and PCT/WG/5/22 Rev., paragraph 302). The proposed modifications provide detailed guidance to Offices on how to process incoming requests for restoration of the right of priority as well as on the interpretations of the “due care” and “unintentional” criteria.

The paragraphs of the ROGLs which are proposed to be modified are set out in the Annex to this Circular.

*Comments on the proposed modifications to ROGLs*

You are invited to provide comments, if any, to the International Bureau by March 31, 2013, preferably by e-mail to: [pct.legal@wipo.int](mailto:pct.legal@wipo.int).

Yours sincerely,



James Pooley  
Deputy Director General

Enclosure:        Annex – Proposed modified paragraphs of the ROGLs

## PCT RECEIVING OFFICE GUIDELINES

### Restoration of the Right of Priority

166A. The receiving Office should restore the right of priority if the applicant requests restoration within two months from the expiration of the priority period and satisfies the criteria applied by the Office and the requirements under Rule 26bis.3.

#### **166B. ~~Restoration of the Right of Priority—Non-Acceptance by Receiving Office.~~**

Where a receiving Office has notified the International Bureau under Rule 26bis.3(j) of the incompatibility of Rule 26bis.3(a) to (i) with the national law applied by that Office, but nevertheless receives a request to restore the priority right, the receiving Office promptly requests the International Bureau as receiving Office to agree, in accordance with the procedure outlined in paragraphs 278 to 281, to the transmittal of the international application under Section 333(b) and (c). An Office ~~may~~ also proceeds in this manner if it only applies one of the applicable criteria and the applicant requests restoration under the criterion not applied by the Office.

166CB. Receipt of a Request for the Restoration of the Right of Priority. The applicant may request restoration of the right of priority directly on the request form (Box No. VI) or by filing a separate request within the time limit provided in Rule 26bis.3(e). The receiving Office checks ~~if whether~~ the request form contains a request by the applicant to restore the right of priority in Box No. VI. If the receiving Office receives a separate restoration request, the Office promptly notifies the International Bureau of it and transmits a copy of the restoration request to the International Bureau (item 6 of Form PCT/RO/118). Where the applicant submits a separate statement of reasons, a declaration or other evidence as part of the restoration request, the receiving Office promptly transmits a copy of any of these documents to the International Bureau (item 12 of Form PCT/RO/118). ~~If such a request to restore is filed subsequently, the receiving Office promptly notifies the International Bureau of the request (item 6 of Form PCT/RO/118).~~

166D. ~~Time Limit under Rule 26bis.3(e) for Requesting Restoration of the Right of Priority.~~ The applicant is required to file the restoration request, submit a statement of reasons for the failure to file the international application within the priority period, claim priority of an earlier application in the international application and pay any fees required for requesting restoration within ~~The time limit to request to restore the priority right and to comply with the requirements listed in paragraphs (a), (b) and (c) of paragraph 166B above is~~ two months from the date on which the priority period expired. Where the applicant makes a request for early publication under Article 21(2)(b), ~~any request to restore the right of priority must be submitted and the~~ all of these requirements ~~mentioned above~~ must be complied with before the technical preparations for international publication have been completed ~~(Rule 26bis.3(e)). If the receiving Office requires the applicant to provide a declaration or evidence in support of the statement of reasons for failure to timely file the international application (Rule 26bis.3(f)), it invites the applicant within a time limit which is reasonable under the circumstances, to furnish such documents. If the receiving Office intends to refuse the request to restore the right of priority (Rule 26bis.3(g)), it allows the applicant to make observations within a time limit which is reasonable under the circumstances (Form PCT/RO/158). In this notification, the receiving Office may also request that a declaration or evidence be furnished (see paragraph 166G).~~

166E. Checking of Formal Requirements. Upon receipt of a request to restore the right of priority, ~~the~~ receiving Office ~~then~~ promptly checks whether the following requirements are met:

(a) the international filing date of the international application is later than the date on which the priority period expired but within two months from that date (Rule 26bis.3(a));

(b) a priority claim to an earlier application is made in the international application or is subsequently added, pursuant to Rule 26bis.1(a) within the applicable time limit under Rule 26bis.3(e);

(c) ~~(b)~~ the request to restore the right of priority and a statement of reasons for failure to file the international application within the priority period ~~has~~ have both been submitted furnished (see also paragraph 166F below) within the applicable time limit under Rule 26bis.3(e) (for the statement, see also paragraph 166F below); and

(d) ~~(e)~~ The fee for requesting restoration, if applicable, has been paid (Rule 26bis.3(d)) within the applicable time limit under Rule 26bis.3(e). The time limit for payment of the fee may be extended for a period of up to two months from the expiration of ~~that~~ the time limit ~~under Rule 26bis.3(e)~~ (Rule 26bis.3(d)).

~~(d) If required by the receiving Office, a declaration or evidence in support of the statement of reasons for failure to file the international application within the priority period has been furnished.~~

If any of the above requirements are not complied with, and the applicable time limit has not yet expired, the receiving Office promptly invites the applicant (Form PCT/RO/132) to comply with that requirement within the applicable time limit. If any of the above requirements are not complied with after the applicable time limit, the receiving Office notifies the applicant (Form PCT/RO/158) of the deficiency. ~~If the receiving Office intends to refuse the request to restore the right of priority, it should so indicate in detail in Form PCT/RO/158 and provides~~ the applicant with an opportunity to make observations within a reasonable time limit (Rule 26bis.3(g)).

#### ~~166C. Separate Request to Restore the Right of Priority.~~

~~A request to restore the right of priority may also be submitted separately from the request form. The receiving Office should process such separate requests in the same manner and according to the procedures outlined in paragraphs 166A to 166I.~~

#### ~~166D. Time Limit for Requesting Restoration of the Right of Priority.~~

~~The time limit to request to restore the priority right and to comply with the requirements listed in paragraphs (a), (b) and (c) of paragraph 166B above is two months from the date on which the priority period expired. Where the applicant makes a request for early publication under Article 21(2)(b), any request to restore the right of priority must be submitted and the requirements mentioned above must be complied with before the technical preparations for international publication have been completed (Rule 26bis.3(e)). If the receiving Office requires the applicant to provide a declaration or evidence in support of the statement of reasons for failure to timely file the international application (Rule 26bis.3(f)), it invites the applicant within a time limit which is reasonable under the circumstances, to furnish such documents. If the receiving Office intends to refuse the request to restore the right of priority (Rule 26bis.3(g)), it allows the applicant to make observations within a time limit which is reasonable under the circumstances (Form PCT/RO/158). In this notification, the receiving Office may also request that a declaration or evidence be furnished (see paragraph 166G).~~

#### ~~166E. Decision to Restore the Right of Priority.~~

~~The receiving Office, when deciding on a request for restoration, is free to apply either the more strict criterion of "due care" or the less strict criterion of "unintentionality"~~

~~(Rule 26bis.3(a)). The receiving Office may also apply both criteria. In such a case, the Office is free to apply, upon request by the applicant or at its own initiative, first the “due care” criterion and, if it finds that that criterion is not satisfied, the “unintentionality” criterion. If the receiving Office applies both criteria and finds that the failure to timely file the international application was unintentional but that due care had not been exercised, the receiving Office may indicate this intent to partially refuse restoration of priority under the due care criterion in Form PCT/RO/158, and explain that restoration will nevertheless be allowed under the unintentional criterion, by text in the Annex to that Form. If the applicant requests the restoration of multiple priority claims, and where the use of a single Form (PCT/RO/158 and/or PCT/RO/159) would not be sufficiently clear, the receiving Office should use a separate Form for each priority claim concerned.~~

~~166F. **Statement of Reasons.**~~

~~Rule 26bis.3(b)(ii) requires that a request to restore the right of priority should state the reasons for failure to timely file the international application. The applicant should therefore provide a summary of the facts or circumstances surrounding the failure to file the international application in time including, where applicable, actions that were taken by the applicant to prepare and file the international application.~~

166F. **Statement of Reasons.** Under Rule 26bis.3(b)(ii), the applicant is required to explain why he failed to file the international application within the priority period. The statement should describe in detail the facts and circumstances that led to the late filing and any remedial or alternative steps taken to attempt a timely filing of the international application. If the receiving Office finds the statement of reasons insufficient to determine whether the applicant satisfies the applicable criteria, the receiving Office may invite the applicant to submit further information by way of a revised statement within a reasonable time limit (item 2 of Form PCT/RO/158). The receiving Office explains in detail, by text in the Annex to that Form, why it finds the statement insufficient. In this notification, the receiving Office may also require the applicant to submit a declaration or other evidence in support of the statement of reasons (see paragraph 166G). If the applicant does not respond to that notification within the time limit, the receiving Office proceeds as outlined in paragraph 166O. If the applicant submits new arguments in response to that notification and the receiving Office decides to restore the right of priority, the Office proceeds as outlined in paragraph 166O. If the applicant submits new arguments in response to that notification and the receiving Office nevertheless intends to (partially) refuse the request to restore the right of priority, the receiving Office proceeds as outlined in paragraph 166N.

~~166G~~166G. **Declaration and Evidence.** Under Rule 26bis.3(f), the receiving Office may require the applicant to submit a declaration or other evidence in support of the statement of reasons ~~be furnished~~ or, if some evidence has already been provided, ~~that to submit~~ additional evidence ~~be furnished.~~ within a reasonable time limit (items 3 and 4 of Form PCT/RO/158). For the ~~“unintentionality~~unintentionality” criterion, a statement indicating that the failure to comply with the priority period was not ~~intentional on purpose~~ should generally be sufficient. The receiving Office may, however, require that this statement be submitted in the form of a declaration. For the ~~“due care”~~ criterion, the receiving Office may require that the statement of reasons is substantiated with a declaration or ~~other~~ evidence. ~~The submitted declaration or evidence should enable the receiving Office to determine whether the failure to file the international application within the priority period occurred in spite of due care, that is, if all reasonable care was taken under the circumstances to ensure that the priority period would not be missed.~~

166H. **Criteria Applied by the Receiving Office.** The receiving Office, when deciding on a request for restoration, is free to apply either the more strict criterion of “due care” (Rule 26bis.3(a)(i)) or the less strict criterion of “unintentionality” (Rule 26bis.3(a)(ii)). The receiving Office may also apply both criteria. In such a case, since a positive finding of “due care” in effect encompasses a finding of “unintentional” conduct, the receiving Office should,

unless the applicant requests otherwise, first apply the “due care” criterion, and only if this standard has not been complied with, apply the “unintentionality” criterion.

166I. **Unintentionality Criterion.** Under Rule 26bis.3(a)(ii), the receiving Office should restore the right of priority if it finds that the failure to file the international application within the priority period was “unintentional”. The applicant satisfies this 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.

166J. **Due Care Criterion.** Under Rule 26bis.3(a)(i), the receiving Office should restore the right of priority if it finds that the failure to file the international application within the priority period occurred in spite of “due care” required by the circumstances having been taken. Generally, the standard of having exercised “due care” within the meaning of Rule 26bis.3(a)(i) can only be met if the applicant has taken all measures which a reasonably prudent applicant would have taken. In determining whether the applicant exercised the “due care” of a reasonably prudent person, the receiving Office considers the facts and circumstances of each particular case. It is not sufficient for an applicant to demonstrate that, in general, he has taken all precautions to adhere to time limits for filing international applications. Instead, the applicant must show that he exercised all “due care” for the particular application in question. The receiving Office should engage in a factual analysis of the applicant’s specific acts related to the filing of the international application up to the expiration of the priority period. Actions by the applicant after the expiration of the priority period should not be considered when determining whether the applicant exhibited “due care”.

166K. Where the applicant is represented by an agent, both the applicant and the agent must show that they exercised “due care” in order to satisfy the “due care” criterion (see Rule 90.3(a)). In such a case, the applicant also has to demonstrate prudent action in the selection, appointment and sufficient instruction of a qualified agent.

166L. For a corporate applicant or agent to satisfy the “due care” criterion, the applicant or agent generally must demonstrate that a reliable docketing, back-up and reminder system has been established, that reliable, adequately trained and supervised staff has used these systems and did not make mistakes in the past, and that the failure to file within the priority period in this particular case was an isolated incident. While the same standard cannot be expected from a small applicant or agent, such as an individual inventor or a small and medium enterprise, any applicant or agent is expected to set up an efficient and reliable reminder, supervision and back-up system which corresponds to best practices in the field.

166M. While each receiving Office must engage in its own case-by-case analysis for each restoration request, the application of the “due care” criterion to the following factual circumstances (based on the experience of the International Bureau) may be of assistance:

(a) Lack of Knowledge by the Applicant

A prudent applicant acquires the requisite knowledge of the PCT system in order to be able to timely file a complete international application, and/or appoints a competent agent to file on his behalf if the applicant lacks the requisite knowledge. An applicant who failed to file the international application within the priority period due to a lack of knowledge concerning the operation of the PCT system or concerning the 12 months priority period as set out in Article 4C of the Paris Convention generally did not act with “due care”.

(b) Human Error by the Applicant or Agent Himself

A reasonably prudent applicant or agent recognizes the importance of meeting crucial priority deadlines and ensures that all aspects of the preparation and filing of the international application are carried out with the diligence and meticulousness needed to successfully and timely submit the international application. A human error attributable to increased workload, lost files and incompletely filed PCT applications generally lacks “due care”.

(c) Miscommunication between the Applicant and the Agent

Where the applicant appoints an agent, both the applicant and the agent must act with “due care” in their communication with each other. A prudent applicant instructs the agent in a clear and timely manner to file the international application. A prudent agent acts upon instructions received by the applicant and clarifies with the applicant in case of doubt. A prudent agent advises the applicant of all important matters in relation to the timely filing of an international application and the consequences of a late filing in a clear manner. A prudent applicant or agent finds alternative ways to communicate with the other person if the usual communication channels fail. Where the failure to timely file a PCT application was caused by technical difficulties (e.g. unexpected email delivery failure between the applicant and the agent), both the applicant and the agent may have acted with “due care” if they can demonstrate that the system had worked reliably in the past and that the breakdown could not have been anticipated by either party.

(d) Absence from the Office by the Applicant or Agent

Where an applicant or agent is absent from the office at the expiration of the priority period, a prudent applicant or agent either files the international application in advance insofar as the absence was predictable, or instructs another person to timely file the international application during his absence. For example, a prudent applicant with a scheduled absence from the Office due to vacation or a medical appointment checks whether the priority period for the filing of an international application expires during this absence and instructs an agent, a colleague or a staff member to file the international application on his behalf. In addition, a prudent agent/applicant maintains a reliable communication system that provides other persons in the office with access to important communications so that other persons can receive and react upon filing instructions in case of unplanned absences. For example, a prudent agent ensures that instructions to file an international application are sent to an email account to which several persons have access. An applicant or agent generally fails to demonstrate “due care” if he failed to timely file a PCT application due to illness or vacation. Only in cases where the applicant or agent fell unexpectedly ill and needed urgent treatment that prohibited all communication with other persons the failure to timely file an international application may have occurred in spite of “due care”.

(e) Human Error by the Agent’s or Applicant’s Staff

An applicant or agent may entrust administrative staff (non-attorneys such as assistants or paralegals) with the performance of certain administrative tasks. A prudent applicant or agent carefully chooses, trains and monitors the work of a reliable, experienced, adequately trained and supervised employee. A human error by an assistant in the docketing, monitoring, preparation or filing of the international application is not attributed to the applicant or agent if the applicant or agent can show that “due care” was exercised in the management of the assistant and the failure to file



within the priority period in this particular case was an isolated human error. In the statement of reasons, the applicant or agent should usually outline the number of years the assistant has been entrusted with the particular task, the level of training and supervision provided to the assistant, and whether the assistant has performed all his duties diligently in the past.

(f) Docketing System Error

Docketing system errors can be divided into human entry errors (see paragraphs (b) and (e) above) and technical errors (e.g. software malfunction or server crashes). Where the applicant or agent failed to timely file the international application due to a technical error, the applicant or agent may have acted with all "due care" if he demonstrates that he set up a reliable and well functioning reminder system, had sufficient knowledge of the use and operation of the system, sufficiently trained and supervised staff on the use of the system, arranged reliable back-up and entry review (a second person that independently checks the correct entry of dates) procedures, and that the technical error occurred unexpectedly and was as such not foreseeable.

(g) Facsimile or Software Submission Failure

Where an applicant or agent fails to timely file a PCT application due to a transmission error using facsimile, or any filing software, an applicant or agent has to show that the error occurred due to an external technical problem that was beyond the applicant's/agent's control in order to satisfy the "due care" criterion (for facsimile submissions, see also Rule 92.4(c) which puts the risk of an unsuccessful transmission on the side of the applicant). A prudent applicant or agent takes particular care and vigilance when he files an international application on the last day or even during the last hours of the priority period. This includes the preparation of the necessary facilities for the filing of the PCT application reasonably in advance of the expiration of the priority period, such as where the applicant or agent chooses to file electronically, a well-functioning computer system, the installation of the latest filing software and the digital certificate, a reliable Internet connection and sufficient knowledge of the software used, and where the applicant or agent chooses to file via facsimile, a well-functioning fax machine. Where a prudent applicant or agent experiences technical problems during the submission of an international application, the applicant or agent exhausts all reasonable alternative means to timely file the international application (such as hand delivery, express mail, submission via fax instead of electronic filing, use of a different fax machine, submission to a different fax number within the same receiving Office, filing with another receiving Office in a different time zone which is competent for the main applicant).

(h) Postal Service Difficulties

Where an applicant fails to timely file a PCT application due to postal service errors, the receiving Office should apply the underlying idea of Rule 82.1 when evaluating whether an applicant or agent acted with all "due care" required by the circumstances. A prudent applicant or agent mails an international application to the receiving Office at least five days prior to the expiration of the priority period by registered airmail (applicants or agents need not use airmail if surface mail normally arrives within two days of mailing or if airmail is unavailable). The applicant or agent may have acted with all "due care" if the filing of the international application would have been timely under normal circumstances and the postal delay was unforeseeable.

(i) Force Majeure

An event of force majeure means external, unforeseeable and/or unavoidable circumstances beyond the control of the applicant or agent. Disasters, such as hurricanes, volcanic eruptions, earthquakes, international conflicts and war may be considered as such events. Generally, if such circumstances make it impossible for an applicant or agent to file the international application within the priority period, the failure to file the application occurs in spite of “due care”. An applicant or agent generally acted with all “due care” if the applicant or agent demonstrates that the consequences of the event could not have been predicted and/or avoided.

166N. **Intended (Partial) Refusal of the Request to Restore the Right of Priority.** If the receiving Office intends to (partially) refuse the request to restore the right of priority (Rule 26bis.3(g)), the Office notifies the applicant of the intended refusal and allows the applicant to make observations within a reasonable time limit (Form PCT/RO/158). In this notification, the receiving Office may also invite the applicant to submit a declaration or other evidence (see paragraph 166G). The receiving Office should explain in detail, by text in the Annex to that Form, why it intends to (partially) refuse the restoration request. If the receiving Office applies both the “due care” and the “unintentionality” criteria and finds that the failure to timely file the international application was “unintentional” but that “due care” had not been exercised, the receiving Office indicates the intent to partially refuse restoration of priority under the “due care” criterion, and explains that the right of priority will nevertheless be restored under the “unintentionality” criterion, by text in the Annex to Form PCT/RO/158.

~~166I~~166O. **Decision and Notification.** As soon as the receiving Office decides to restore the right of priority or, after notifying the applicant of the intended refusal (see paragraph 166N), decides to (partly) refuse the request to restore the right of priority ~~has come to a decision on the request to restore the priority right, it~~, the Office promptly notifies the applicant of its decision (Form PCT/RO/159) ~~and furnishes a copy thereof to the International Bureau (Rule 26bis.3(h))~~. In this notification, the receiving Office indicates whether the Office restores the right of priority or (partly) refuses the request to restore the right of priority and the criterion for restoration upon which the decision was based. In the Annex to the Form, the receiving Office summarizes the facts and the reasons for its decision. The receiving Office promptly submits a copy of its decision to the International Bureau, along with any correspondence between the Office and the applicant not previously submitted (such as Form PCT/RO/158, a copy of the request for restoration, the statement of reasons and of any accompanying declaration or other evidence).

166P. **Multiple Priority Claims.** If the applicant requests the restoration of multiple priority claims, and where the use of a single Form (PCT/RO/158 and/or PCT/RO/159) would not be sufficiently clear, the receiving Office should use a separate Form for each priority claim concerned.

[End of Annex]