



## Late-Filed PCT Application

This briefing explores the options available to applicants in the event that the deadline for filing a PCT has been missed. In this context we refer to the deadline for filing a PCT application that is set by the twelve month deadline for claiming priority under the Paris Convention. A successful claim to priority may be important, particularly if the applicant has disclosed their invention after filing their first application and wishes to proceed with national and/or regional phases in which no grace period is provided for disclosures by the inventor/applicant.

In the event that it is realised that the one year Paris Convention deadline for filing a PCT application has narrowly been missed, it is important that one immediately investigates the options for remedying the situation because the required steps are often time-critical.

### 1 - Remedy by National Holiday

If the deadline has been narrowly missed (for instance, by a day or two), it is advisable to check whether any PCT Receiving Offices were closed for a national holiday on the day that the PCT application was due. Given the number of Receiving Offices around the world, this is quite frequently the case. If this is the case, a PCT application may be filed at that Receiving Office on the next working day for that Receiving Office with an automatically valid claim to priority. Accordingly, particularly if the Paris Convention deadline has been missed by one day, this may provide a near-perfect remedy.

### 2 - Remedy by Restoration of Priority

In cases where the saving grace of a convenient national holiday is not available, it may be possible to significantly reduce the damage of a late-filed PCT application by restoring the effect of the priority claim under Rule 26 bis.3 PCT or under Rule 49 ter.2 PCT. In order for such a request to be possible, the PCT application must have been filed within two months of the date on which the original priority period expired and must include the desired claim to priority. If successful, the effect of the priority claim may be restored such that the novelty of relevant subject matter will be judged based on the date of the priority application rather than date of filing of the PCT application.

However, not all PCT states accept restoration of the effect of a priority claim. At the time of writing, states not accepting restoration of the effect of a priority claim include Brazil, Canada (as designated office only, meaning that restoration may be requested if the PCT application is filed with the Canadian patent office as receiving office), China (as designated office only), Colombia, Cuba, Algeria, Indonesia, India, Mexico (as designated office only), South Korea and the Philippines.

In addition, those PCT contracting states that do accept restoration of the effect of the priority claim do not have uniform requirements for restoration of the effect of the priority claim to

be granted. Under Rule 26 bis.3 PCT and Rule 49 ter.2 PCT, PCT contracting states may recognise that restoration of the effect of the priority claim should be granted under either of two criteria, (i) that failure to file the International application within the priority period occurred in spite of due care required by the circumstances having been taken, or (ii) that the failure to file the International application within the priority period was unintentional. Even within those two criteria, different PCT states may apply the test with differing levels of severity. It is therefore to be understood that this provision within the PCT is significantly less harmonised than other provisions under the PCT and, even where it is available, it may not provide a perfect remedy in the event that a PCT application is not filed within the priority period.

As is discussed in more detail below, restoration of the effect of the priority period may be requested by two routes, under Rule 26 bis.3 PCT at the Receiving Office and/or under Rule 49 ter.2 PCT at the individual Designated Office.

### 3 - Requests Under Rule 26 bis.3 PCT at the Receiving Office

A request for restoration of the effect of the priority claim filed at the Receiving Office under Rule 26 bis.3 PCT has the benefit that a positive decision may later be effective in many of the designated states selected by the applicant. It may also be beneficial to have increased certainty, at least for some designated states, that the priority claim will be effective before incurring the expense of entering the national/regional phases. This may be particularly true if one is already aware of a relevant publication between the claimed priority date and the filing date of the PCT application.

#### 3.1 - Timing of Requests Under Rule 26 bis.3 PCT

In order for a Receiving Office to consider a request for restoration of the effect of the priority claim, the restoration request (as well as the patent application) must be filed at the Receiving Office within two months of the end of priority period in which the PCT application should have been filed.

When filing the request, the fee required by Receiving Office for consideration of the request for restoration of the effect of the priority claim must be paid and a reasoned statement demonstrating that the relevant criterion has been met to justify re-establishment of the effect of the priority claim. These steps must be completed within the deadline for requesting restoration of the effect of the priority claim.

Where a sworn declaration and/or evidence is required and not submitted with the restoration request, the Receiving Office should provide a reasonable time period in which to submit the declaration and/or evidence. However, in practice it is recommended to prepare and submit any such declaration and/or evidence at the same time as the request for restoration of the effect of the priority claim because it is commonly the case that

the understanding of the circumstances of a case changes significantly when supporting materials or evidence are provided and received. This may occur because an individual's recollection of the circumstances may need to be adjusted when faced with hard evidence. It may therefore change the way in which one wishes to present the case, which may not be possible if it has already been presented to the Receiving Office.

It is worth noting that, although the deadline for filing a PCT application that may be the subject of a request for restoration of the effect of the priority claim is the same as the deadline for filing a request under Rule 26 bis.3 PCT for filing such a request for restoration of the effect of the priority claim at the Receiving Office, the PCT application and the restoration request need not be filed at the same time. In fact, it is often desirable not to do so.

Firstly, as is discussed further below, a request to restore the effect of a priority claim may be filed at the designated offices under Rule 49 ter.2 PCT, without filing a request under Rule 26 bis.3 PCT at the Receiving Office. Furthermore, even if a request under Rule 26 bis.3 PCT is to be filed at the Receiving Office, it may be desirable to file such a request after filing the PCT application. Specifically, it typically takes time to research and prepare a request for re-establishment of the effect of the priority claim. However, it is often undesirable to delay filing the PCT application itself. This is because, as discussed above, some countries do not permit restoration of the effect of the priority claim in their respective national phases. For those countries, therefore, establishing a filing date for the PCT application that is as early as possible is likely to be desirable because this will be the date at which novelty is judged.

Furthermore, even for PCT contracting states in which restoration of the priority claim is possible, there is often a significant level of uncertainty regarding whether or not such a request will be granted, particularly before it has been possible to research the circumstances that resulted in the PCT application being filed late. Therefore it is, again, beneficial to establish a PCT filing date that is as early as possible because this will be the date at which novelty is judged if restoration of the effect of the priority claim is refused.

### 3.2 - Effect of Positive Decisions Under Rule 26 bis.3 PCT

As discussed above, two criteria exist for assessing whether or not restoration of the effect of the priority claim should be restored: whether the deadline was missed "*unintentionally*"; and whether the deadline was missed "*despite all due care*" having been taken. Where a Receiving Office allows a request under Rule 26 bis.3 PCT for restoration of the effect of a priority claim under one of these criteria, Designated Offices that apply the same criterion should, as a default, accept the decision of the Receiving Office when the PCT application is brought into the national phase, under Rule 49 ter.1 PCT. In most cases, no further action is required by the applicant on entry into the national phase.

However, if the Designated Office has significant doubts in relation to the decision of the Receiving Office to allow restoration of the effect of the priority claim under Rule 26 bis.3 PCT, the Designated Office may initiate a review of the decision under Rule 49 ter.1 (d) PCT. If this procedure is initiated, the Designated Office is required to notify the applicant, provide reasons for the doubts and provide the applicant with an opportunity to respond within a reasonable time limit. Fortunately, this procedure appears to be rare.

### 3.3 - Choice of Receiving Office

As indicated above, individual Receiving Offices may not judge requests for restoration of the effect of a priority claim under both criteria. The USPTO acting as Receiving Office, for example, will only consider the "unintentional" criterion. The Canadian Intellectual Property Office, on the other hand, will consider request for restoration of the effect of a priority claim under both the "unintentional" and the "due care" criteria despite the fact that as a Designated Office, it will not at present accept the restoration of the effect of a priority claim. Meanwhile, the Indian Patent Office acting as Receiving Office will not consider requests for restoration of the effect of a priority claim. It can therefore be desirable to select a Receiving Office that will provide a desired assessment of a request for restoration of a priority claim under Rule 26 bis.3 PCT.

Rule 19.1, which determines the competent Receiving Office, can impose limitations on the choice of Receiving Office open to an applicant. However, under Rule 19.1 (iii) it is always open to an applicant to file a PCT application at the International Bureau as Receiving Office. The International Bureau considers requests for restoration of the effect of a priority claim under Rule 26 bis.3 PCT, namely acting as the Receiving Office, under both the "unintentional" and the "due care" criterion.

In some circumstances, it may be desirable to utilise a Receiving Office that would not normally be competent for the applicant. This may be to take advantage of a national holiday at a Receiving Office on the day on which the PCT application was originally due as explained above. Alternatively, it may be to have a particular Receiving Office assess a request for restoration of the effect of a priority claim under Rule 26 bis.3 PCT. For example, a US applicant might prefer to have a case for "due care" assessed by the European Patent Office rather than the International Bureau because the European Patent Office has a long track record of assessing "due care" in request for re-establishment of rights under Article 122 EPC. In particular, the wealth of case law provides useful guidance when preparing such a request, which may be useful both to guide how best to present a case to maximise its chances of success but also to inform the applicant of their chances of success at the outset. This latter point is important because the process may be expensive; accordingly, if the chances of success are low, it may not be worthwhile.

For completeness, it is worth noting that the EPO will apply the "due care" standard as receiving office, in connection with restoration of a priority right, with the same strict approach as in the PCT regional phase. The fact that an applicant may not be based in Europe, and may not be familiar with the EPO's strict standards, cannot be used to leverage a more lenient application of the standard (see J8/21).

Where it is desirable to use a Receiving Office that is not competent to act as a Receiving Office for the intended PCT applicant, Rule 19.1 PCT may be circumvented by additionally naming as an applicant an individual that is a resident or national in a state for which the desired Receiving Office is competent, for example the attorney that is to file the PCT application at that Receiving Office. Such an individual may be named as an additional applicant for one PCT contracting state only that is selected to be a country that the true PCT applicant does not intend to select for national phase entry. Such an arrangement will be sufficient for the desired Receiving Office to be competent to handle the PCT application and therefore consider the request for restoration of the effect of the priority claim under Rule 26

bis.3 PCT without requiring a subsequent assignment of any rights from the additionally named applicant to the true PCT applicant.

In some cases, the error resulting in the PCT application having been filed late is discovered after the PCT application has been filed (for example if erroneous priority data for the PCT application is recorded in a case management system). In such a situation, the Receiving Office is already selected. In that case, it may be possible to have the PCT application transferred to a different Receiving Office upon request, provided both the old Receiving Office and the new Receiving Office agree. This may enable the selection of a desired Receiving Office to consider a request under Rule 26 bis.3 PCT for restoration of the effect of a priority claim. However, in practice, it may not be possible to complete such a process in sufficient time to enable the filing of a request under Rule 26 bis.3 PCT for the restoration of the effect of the priority claim at the new Receiving Office. In such a case, it may be preferable to request restoration of the effect of the priority claim at the designated offices under Rule 49 ter.2 PCT, as discussed below.

#### **4 - Request for Restoration of the Effect of a Priority Claim at Designated Offices under Rule 49 ter.2 PCT**

Regardless of whether or not a request for restoration of the effect of a priority claim has been filed at the Receiving Office under Rule 26 bis.3 PCT, and the outcome of any such request, it is also possible to request restoration of the effect of a priority claim at the Designated Offices under Rule 49 ter.2 PCT.

##### **4.1 - Timing of Requests Under Rule 49 ter.2 PCT**

The deadline for filing a request for restoration of the effect of a priority claim under Rule 49 ter.2 PCT is very much later than the deadline for filing a request under Rule 26 bis.3 PCT at the Receiving Office. In particular, the deadline is set by Rule 49 ter.2 (b)(i) to be one month after the Article 22 deadline for entry into the national/regional phase. Accordingly, the final deadline by which one can submit a request for restoration of the effect of the priority claim is 31 or 32 months from the earliest claimed priority date for 30 and 31 month countries, respectively. It should be noted, however, that if a request is filed for early entry into the national/regional phase under Article 23(2) PCT, the deadline for filing a request under Rule 49 ter.2 PCT for restoration of the effect of the priority claim is one month from the date of receipt of the Article 23 (2) PCT request by the Designated Office. Similarly, the European Patent Office as designated office *may* permit a later request for restoration of priority, if the European regional phase is entered late under the further processing procedure (as discussed in J14/21).

Therefore, if an error resulting in the late filing of a PCT application is discovered very close to the deadline for filing a request for restoration of the effect of a priority claim at the Receiving Office under Rule 26 bis.3 PCT, one may file the PCT application immediately in order to ensure that it is filed within two months of the original priority deadline and take additional time to investigate the circumstances and prepare a suitably detailed request for restoration of the effect of the priority claim to be filed under Rule 49 ter.2 PCT on entry into the national phases.

##### **4.2 - Benefits of Deferring Requesting Restoration**

Use of Rule 49 ter.2 PCT to file the request for restoration of the effect of the priority claim on entry into the national/regional phases may also be beneficial to provide more time to consider whether or not to do so at all. For example, it may be undesirable

to file a request for restoration of the effect of the priority claim because the restoration request may include sensitive information, such as a level of disorganisation within an organisation, that it may be undesirable to have placed in a public file. In some circumstances, it may also be undesirable to conduct the necessary investigation in order to establish the details of the circumstances that result in the PCT application being filed late. This may particularly be the case where multiple parties are involved and being seen to be apportioning blame may be damaging to the relationship between the parties.

In such circumstances, one may need to consider the likely benefit of preparing and/or filing a request for restoration of the effect of the priority claim. If the chances of success appear to be low, the potential downsides, which will also include the cost, may not be justified. Likewise, if the subject matter of interest, that is likely to become the subject of the key claims of interest in the PCT application (and its national/regional phases) was not disclosed in the priority application, such claims may not, in any case, be entitled to the claimed priority date. In that case, a benefit from restoring the effect of the priority claim is likely to be minimal. Delaying requesting restoration of the effect of the priority claim under Rule 49 ter.2 PCT until entry into the national/regional phases may provide sufficient time for such an assessment to be made, in contrast with filing a request under Rule 26 bis.3 PCT filed at the Receiving Office, where it may be necessary to proceed with preparing the request immediately.

Deferring any request for restoration of the effect of the priority claim until entry into the national/regional phases may also have the benefit of enabling one to wait until the International Search Report has been prepared in order to see whether or not a relevant prior art is cited with a publication date between the claimed priority date and the PCT filing date, for which there would be a clear benefit if the effect of the priority claim were restored. However, it should be appreciated that a decision not to seek restoration of the effect of the priority claim on the basis of no such prior art being identified in the International Search Report entails a significant risk because such prior art may be identified later.

##### **4.3 - Option of Taking Action Early Under Rule 49 ter.2 PCT**

If a decision is made to defer filing a request for restoration of the effect of a priority claim until entry into the national/regional phases, namely filing such requests under Rule 49 ter.2 PCT, it may still be preferable to conduct a thorough investigation into the circumstances and/or prepare the restoration request as soon as possible. This is because as time elapses, it may be more difficult to prepare as strong a case as possible because it may become more difficult to locate relevant evidence and/or because key individuals may change jobs, making it harder to obtain information from them. Finally, it may also be more difficult because key aspects of the case may become forgotten by the individuals involved. It may also be much more difficult to gather contemporaneous evidence supporting the request (for instance, if notes of meetings and so on are destroyed after a short period of storage).

If a request for restoration of the effect of a priority claim has not been filed at the Receiving Office under Rule 26 bis.3 PCT due to a lack of time or because, for example, the Receiving Office at which the PCT application was filed does not consider requests for restoration of the effect of the priority claim under the “due care” criterion, it may be worth considering bringing the PCT application into one of the national/regional phases early with a

request for restoration of the effect of the priority claim under Rule 49 ter.2 PCT. This may be used, for example, to test the strength of the case justifying restoration of the effect of the priority claim under one or both of the relevant criteria before incurring the cost of national/regional phase entry in a plurality of countries.

It may also be worthwhile entering the European regional phase early with a view to establishing a positive decision under the “due care” criterion from a respected patent office with a consistent history of judgements under the “due care” criterion. Although other Designated Offices applying the same criterion would be under no obligation to follow the decision of the European Patent Office, and separate requests for restoration of the effect of the priority claim would subsequently need to be presented to each Designated Office on national/regional phase entry, such a positive decision may be persuasive to other patent offices with less experience in judging “due care”.

A further potential benefit from requesting early entry into the European regional phase and requesting that the European Patent Office consider a request for restoration of the effect of the priority claim under Rule 49 ter.2 PCT is that one may then have at least a first instance decision from the European Patent Office before the expiry of the 31 month deadline. In the event that it appears that it may not be possible to obtain restoration of the effect of the priority claim under Rule 49 ter.2 PCT under the “due care” criterion examined by the European Patent Office, a fall-back position may be to request entry into the UK national phase, requesting restoration of the effect of the priority claim under Rule 49 ter.2 PCT under the “unintentional” criterion applied by the UK IPO, which may be easier to justify, or relying on a positive decision from the Receiving Office under Rule 26 bis.3 PCT under the “unintentional” criterion.

Unfortunately, . Several countries in Europe do not have separate national phases, for example France; some countries that do have a separate national phase do not accept restoration of priority in their national phase, for example Germany; and other countries apply the “due care” criterion.

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### **5 - Traps for the Unwary**

Particularly if one is considering deferring filing a request for restoration of the effect of the priority claim under Rule 49 ter.2 PCT on entry into the national/regional phase at 30/31 months, one must be aware that the deadline for including a claimed priority (if it has been omitted when filing the PCT application) is much earlier than the deadline for requesting restoration of the effect of such a priority claim. In particular, Rule 26 bis.1 PCT requires that any priority claim to be corrected or added must be completed no later than 16 months from the earlier of the priority date(s) stated on the PCT application as filed and 16 months from the earliest priority date of the application as corrected unless this date is less than four months from the International filing date, in which case the deadline is four months from the International filing date. It is therefore advisable to include the desired priority claim(s) on the Request form, even if a restoration request has not yet been filed.

It is also important to be aware that, if the Receiving Office rejects a request for restoration of the effect of the priority claim under Rule 26 bis.3 PCT, this does not result in a recalculation of the 30/31 month deadline for entry into the national/regional phases, even if the applicant does not dispute the finding of the Receiving Office. Note that, in fact, even if no request for restoration of the effect of a priority claim is filed, PCT deadlines will still be calculated from any priority date claimed in the PCT application provided the PCT application is filed within two months of the priority period set by the claimed priority date.

The deadlines, including the 30 and 31 month periods for entry into the national/regional phases are only recalculated if the priority claim is actively withdrawn earlier than 30 months from the claimed priority date. Care therefore needs to be taken to ensure that, if one decides not to pursue an attempt to restore the effect of a priority claim, the deadlines for entry into the national/regional phases are not erroneously computed ignoring the claimed priority date, which would result in the deadlines for entry into the national/regional phases being missed.

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