

When do Restoration or Benefit Claims reset PCT time Limits?

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The right to restore priority raises some interesting questions regarding the time limits in the international stage of a PCT application. Generally speaking, PCT time limits are tied to the priority date.² However, there is some ambiguity in the PCT rules regarding time limits in certain situations. Accordingly, I posed the following fact patterns and questions to a WIPO official in order to remove the ambiguity, and I provide that official's answers below, with my comments in blue and the official's comments in red.

[My introductory comment to the PCT Official]

I question what date governs the time limits in the international stage of a PCT, in certain restoration situations. I hope you or **** can advise me. I have 3 questions below. Please advise. Thanks, RICK

[The WIPO Official's response to my introduction]

Rick, I added our views below each of your scenarios. I hope this is what you were looking for. In fact, all your response are correct in our view.

[My summary of the relevant rules preceding my questions]

RELEVANT RULES

RULE 26bis.1(c) states "(c) Where the correction or addition of a priority claim causes a change in the priority date, any time limit which is computed from the previously applicable priority date and which has not already expired shall be computed from the priority date as so changed."

RULE 26.bis.2(e) states that "(e) Where the applicant wishes to correct or add a priority claim but the time limit under Rule 26bis.1 has expired, the applicant may, prior to the expiration of 30 months from the priority date and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, request the International Bureau to publish information concerning the matter, and the International Bureau shall promptly publish such information."

[My first fact pattern and question]

FIRST FACT PATTERN

FACT: A PCT is filed.

FACT: At a time after 16 months from the date of an earlier filing and after 4 months after the PCT filing, that is after the 26.bis.1 period for adding or correcting a priority claim has passed, at 17 months from the earlier filing, the

applicant files a claim for priority to the earlier filing and a certified copy of the earlier filing and pays whatever fee is required pursuant to 26.bis.2(e).

Q1. Does the belated claim to the earlier filing reset time limits in the international stage based upon the date of the earlier filing? (My guess is no because the claim is not entered pursuant to 28bis.1. But see answer to question 5 at: http://www.wipo.int/pct/en/faqs/april07_faq.html#2007_restoration)

[The WIPO Official's response to my first fact pattern and question]

Once the time limit under Rule 26bis.1 has elapsed, it is no longer possible to add or correct a priority claim during the international phase. Rule 26bis.2(e) only provides for the possibility to publish information about a late correction or addition but does not actually accept the correction/addition itself. As a result, the priority date does not change and thus time limits are not reset.

[My second fact pattern and question]

SECOND FACT PATTERN

FACT: A PCT is filed.

FACT: At a time more than 14 months from an earlier filing and less than 16 months from the earlier filing, that is before the 26.bis.1 period for adding or correcting a priority claim has passed, but after the 14 month period for restoring priority pursuant to rule 26bis.3 has run, the applicant files a claim for priority to the earlier filing and a certified copy of the earlier filing.

Q2. Does the claim to priority reset the time limits in the international stage based upon the date of the earlier filing? (My guess is yes. Because 26bis.2(b) excepts 26bis.2(c), and 26bis.2(c)(iii) provides the priority claim is not void. And see answer to question 5 at: http://www.wipo.int/pct/en/faqs/april07_faq.html#2007_restoration)

[The WIPO Official's response to my second fact pattern and question]

Irrespective of the question whether restoration of the priority right can still be requested, for as long as the Rule 26bis.1 time limit is still running, a correction or addition will be accepted and will, if it affects the earliest priority claim, change the priority date and thus set new time limits.

[My third fact pattern and question]

THIRD FACT PATTERN

FACT: A PCT is filed.

FACT: At a time less than 14 months from an earlier filing, that is while restoration of priority before the RO is possible under 26bis.3, the applicant files a claim for priority to the earlier filing and a certified copy of the earlier filing, and

requests restoration, but the RO denies the request for restoration.

Q3. Does the claim to priority reset the time limits in the international stage based upon the date of the earlier filing? My answer is yes. Because 26bis.2(b) excepts 26bis.2(c), and 26bis.2(c)(iii) provides the priority claim is not void. In addition, that is what the answer to question 5 says at:

http://www.wipo.int/pct/en/faqs/april07_faq.html#2007_restoration

[The WIPO Official's response to my third fact pattern and question]

Again, independent of the question of what happens to the request for restoration of the right of priority, if the addition or correction of the priority claim is requested within the Rule 26bis.1 time limit, it will be accepted and lead to a recalculation of any time limits which have not yet expired at that point and time.

In summary, any PCT applicant consider the time limits for action, whenever requesting restoration of priority, or whenever requesting any change to the application's priority claims that might affect the priority date.

1. I can be reached via telephone at country code 1, followed by 703-415-0012 or via the firm's website: <http://www.neifeld.com/cv.html#neifeld>

2. The "priority date" of a PCT application means the filing date of the earliest application of which priority is claimed, and where no priority is claimed, the international filing date. See: <http://www.wipo.int/pct/en/texts/glossary.html>