

## Restoration of priority claims for PCT applications

The Patent Cooperation Treaty (PCT) Rules have been amended to allow Member States acting as a Receiving Office or as a Designated Office to provide restoration of a priority claim up to two months beyond the 12 month Paris Convention deadline for international patent applications filed on or after 1 April 2007.

The restoration of the priority claim is not an extension of the Convention priority period.

### Grounds for restoration

Two grounds are available for filing of requests for restoration of priority. These grounds are that the international application was not filed within the 12 month convention period either in spite of “due care” required by the circumstances having been taken, or that the failure to file in time was “unintentional”.

The grounds may be subject to reservations by individual member states which may accept one or both grounds in accordance with national legislation. IPONZ has reservations on the second ground in that it does not comply with national legislation. Therefore, IPONZ will only allow restorations of priority on the condition of “due care” having been exercised. In applying the “due care” requirement, IPONZ will effectively be applying the provisions of section 93A of the Patents Act 1953.

### Restoration process

Restoration is only available for applications having the international filing date of 1st April 2007 or later. The process for requesting restorations of priority is provided under PCT Rule 26bis3 and is broadly as follows:

1. Restoration is available in respect of priority applications filed between 12 and 14 months before the International Filing Date, Rule 26bis.3(a).
2. A request for restoration must be filed no later than 14 months from the filing date of the priority application, Rule 26bis.3(e).
3. The request should be accompanied by a declaration or other evidence in support of the request to be filed ‘within a time limit which shall be reasonable in the circumstances’, Rule 26bis.3(b)(iii). For IPONZ, the declaration should meet the standard required of applications filed under s93A.

Successful requests will be advertised on the pamphlet and will include the details of the criteria under which the request was successful i.e. “due care” or “unintentional” under new PCT Rule 48.2(a)(xi), (b)(vii) and (b)(viii). The International Bureau will also publish Form PCT/RO/159 (Notification of Decision on request to restore right of Priority) which will contain the decision of the Receiving Office and the criteria applied by that office.

The applicant will be provided the opportunity to make observations on any proposed refusal by the Receiving Office or Designated Office of a request for restoration of priority.

### Recognition by IPONZ of restoration by other member states

Where the priority has been restored by another member state under the ground of “unintentional” failure to file, then IPONZ will not recognise the claim to restored priority upon entry into the national phase of the application. In such cases, the national phase application will generally be attributed the international filing date as the earliest priority date.