03/25/2020 Information
COVID-19

Covid-19 Pandemic: International Bureau and International Bureau as Receiving Office Remain Open for the Purposes of Filing and Processing of PCT Applications

As from 17 March 2020, WIPO put in place remote working arrangements for most of its staff. As a result, the International Bureau (IB) and the IB as receiving Office remain open for the purposes of filing and processing PCT applications. For further information, please refer to Press Release PR/847/2020 at:

www.wipo.int/pressroom/en/articles/2020/article_0004.html [1]

If you have not already done so, you are advised to check with other Offices with which you conduct PCT-related business to see if they have published any notices relevant to Covid-19.

In addition, please refer to the "Practical Advice [2]" in this issue for information about possible remedies in the case of missed time limits where the PCT Office with which an action needs to be taken is exceptionally closed, or if the applicant's or agent's company/firm is forced to close temporarily.

At the same time, "Practical Advice" can be studied in the state language:

Practical Advice

Possible remedies where time limits under the PCT have been missed due to unforeseen events

Q: I am a patent attorney working for a law firm, and have a number of pending PCT applications, as well as applications that I am planning to file in the near future. I am concerned about the effects of the current novel Coronavirus (Covid-19) pandemic, and what will happen regarding our pending PCT applications, as well as applications yet to be filed, if certain PCT deadlines are not met in the following situations:

– *if the PCT Office with which an action needs to be taken is exceptionally closed; or*

– *if our firm is forced to close temporarily.*

Please could you explain what remedies might apply in case of any delay that occurs as a result of these circumstances?

A: This Practical Advice will take a look at the above-mentioned scenarios separately, and suggest possible remedies that may be applicable in the circumstances.

The Receiving Office or other PCT Authority or the International Bureau, with which a particular action needs to be taken, is closed

PCT Rule 80.5(i) [3]**:** If a national office or intergovernmental organization acting as a receiving Office (RO), International Searching Authority (ISA), Authority specified for supplementary search (SISA), International Preliminary Examining Authority (IPEA), the International Bureau (IB) or a designated/elected Office were to exceptionally not be open to the public for the purposes of the transaction of official business on a particular day, all PCT time limits (including the time limits under PCT **Articles 22** [4] and **39** [5] to enter the national phase) expiring on that day would be extended, under **PCT Rule 80.5(i)** [3], to the next subsequent day on which that Office or authority is open for

business.

Note that **PCT Rule 80.5(i)** [3] applies to any time limit in the PCT and an equivalent provision in the Paris Convention applies to the priority period (refer to **Article 4(C)3** [6], below).

PCT Article 8 [7]; **Article 4(C)(3) of the Paris Convention** [6]: As far as the failure to file any new international application within 12 months from the filing date of an earlier application (the priority of which you wish to claim in the international application) is concerned, this is governed by **Article 4(C)(3) of the Paris Convention** [6]. Unfortunately, if the international application is received after the expiration of the 12-month time limit, you would only have protection in the case where the receiving Office is not open for the filing of applications, and not where the applicant or agent's Office is closed for business.

Temporary closure of the agent or applicant's place of work

PCT Rules 26*bis*.3 [8] and **49*ter*.2** [9]: One possible remedy in case of failure to file the international application within the 12-month priority period, however, would be to attempt to make use of the provisions concerning "restoration of the right of priority", which give applicants who have missed the 12-month Paris Convention priority period the possibility of restoring their priority claim (refer to **PCT Rules 26*bis*.3** [8] and **49*ter*.2** [9]). The decision on a request for restoration would be taken on a case-by-case basis by either the receiving Office or the designated Office in the national phase, and a detailed explanation would need to be provided, in particular, if the applicant wishes to show that the "due care" standard has been met. Please note, however, that some Offices have submitted a notification of incompatibility in respect of these Rules (please refer to: www.wipo.int/pct/en/texts/reservations/res_incomp.html [10])

PCT Rule 82*quater* [11]: For missed time limits applicable for performing an action before the RO, ISA, SISA, IPEA or the IB, PCT Rule 82*quater* [11] may apply in circumstances such as the one you describe. This Rule provides for excuse of delays in meeting time limits due to force majeure reasons set out in the Rule. To benefit from this Rule, the applicant would need to present evidence to that effect to the Office concerned, not later than six months after the expiration of the applicable time limit, in addition to having taken the relevant action as soon as reasonably possible. It would be up to the Office, Authority or the IB, as the case may be, to decide whether the failure to meet the time limit could be excused according to the Rule. Please note, however, that this Rule does not apply to the priority period and the time limit for entering the national phase.

PCT Rule 49.6 [12]**:** If a PCT applicant were to fail, within the applicable time limit, to enter the national phase due to the reason mentioned above, he/she may request the reinstatement of rights before the relevant designated Offices under **PCT Rule 49.6** [12]. This would again be a case-by-case decision to be taken by the designated Offices and may depend on whether the Office in question applies the due care or the unintentional standard. Please note, however, that some Offices have submitted a notification of incompatibility in respect of this Rule (please refer to: www.wipo.int/pct/en/texts/reservations/res_incomp.html [10]).

If the time limit missed relates to an action to be performed in the national phase before a designated or elected Office, possible remedies may also be available under the relevant national laws (refer to *PCT Rule 82bis.2* [13] and, as an example of such a national/regional law, the request for "further processing" at the European Patent Office (**Rule 135 EPC** [14])). In this regard, please consult the respective National Chapters of the **PCT Applicant's Guide** [15] and the national Offices for further information.

Note also that if any submission of document or payment of fee is delayed due to irregularities in the mail service, please consult **PCT Rules 80.5(ii)** [16], **80.6** [17] and **82.1** [18].

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