

# Restoration of Right of Priority

AIPLA Spring Meeting  
Minneapolis, MN  
May 18, 2016

Carl Oppedahl  
Oppedahl Patent Law Firm LLC  
www.oppedahl.com  
© OPLF

---

---

---

---

---

---

---

---

## Terminology

- The correct terminology is “Restoration of the Right of Priority”
- Not “Restoration of Priority”
- We will use the acronym “ROP” which means “Restoration of the Right of Priority”
- We will discuss utility ROP and design ROP

---

---

---

---

---

---

---

---

## Types of utility ROP (each 14 months instead of 12 months)

- Inbound Paris-based utility ROP (from non-US priority application)
- Inbound Paris-based utility ROP from a PCT application with at least one non-US designation
- US national phase from a PCT that missed the 12 months from a would-be non-US priority application or US provisional application
- Outbound PCT ROP
- Outbound Paris-based utility ROP
- Pure domestic utility ROP (from a US provisional patent application)

---

---

---

---

---

---

---

---

## Types of design ROP (each 8 months instead of 6 months)

- Inbound Paris-based design ROP
- Inbound Paris-based design ROP from a Hague application with at least one non-US designation
- Inbound Hague Agreement US designation, having an international filing date that missed a would-be design priority application

4

---

---

---

---

---

---

---

---

## Restoration of Priority

- Article 4 of the Paris Convention establishes a 12-month period for utility patent applications during which to do a second filing that is intended to enjoy a filing-date benefit from an earlier “priority” application
- We all recall a case where a well-known patent firm faced a \$30M verdict for failing to satisfy the 12-month period for filings outside of the US

5

---

---

---

---

---

---

---

---

## Restoration of Priority

- A request for ROP in a PCT application may be made based upon an “unintentional” standard or a “due care” standard
- The request for ROP is made in the first instance to the Receiving Office
- The RO may or may not grant the request
- If the RO denies the request, then you get another bite at the apple. You can renew the request before the DO/EO

6

---

---

---

---

---

---

---

---

## Picking your RO if you are going to request ROP

- RO/US only entertains ROP requests based upon the “unintentional” standard
- RO/US charges \$1700 (or \$850) for such a request
- RO/IB entertains both kinds of ROP request
- RO/IB charges no fee for the request
- If you are going to use RO/IB, make sure you know whether you need a Foreign Filing License
- If you need an FFL, get it before filing in RO/IB <sup>7</sup>

---

---

---

---

---

---

---

---

## But ROP does not work everywhere

- Not every DO/EO will permit ROP
- This means there are places where you might enter the national phase and the ROP would not work

8

---

---

---

---

---

---

---

---

WIPO has a very handy table that summarizes the status of ROP around the world

Restoration of the right of priority by receiving Offices (RO) and designated Offices (DO) under PCT Rules 26bis.3 and 49ter.2 (Last updated 17 November 2015)

Two-letter code	Contracting State or Organization	Does the Office accept requests for the restoration of the right of priority?		If yes, which criteria does the Office apply?	Is there a fee?
		as receiving Office	as designated Office		
AE	United Arab Emirates	See IS <sup>1</sup>	Yes	Please refer to the Office for the applicable criteria and/or any fee payable for such requests.	
AG	Antigua and Barbuda	Yes	Yes	Please refer to the Office for the applicable criteria and/or any fee payable for such requests.	
AL	Albania	Yes	Yes	Please refer to the Office for the applicable criteria and/or any fee payable for such requests.	

9

---

---

---

---

---

---

---

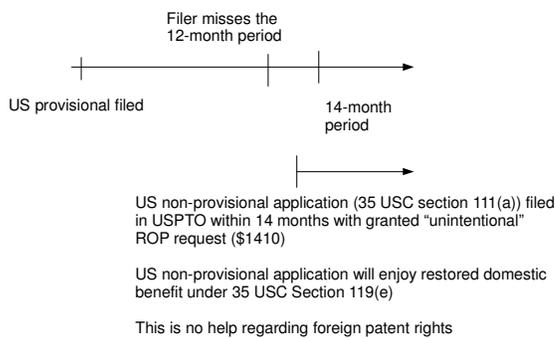
---

## Sometimes a PCT application claims priority from a prior US application

- When the US national phase is entered from such a PCT application, the relationship between it and the priority application has nothing whatsoever to do with Article 4 of the Paris Convention
- The relationship is defined by 35 USC § 119e or by 35 USC § 120
- We call this “domestic benefit” (or, more sloppily, “domestic priority”)
- ROP may be employed to overcome the problem of missing the 119e 12-month period in such domestic benefit cases

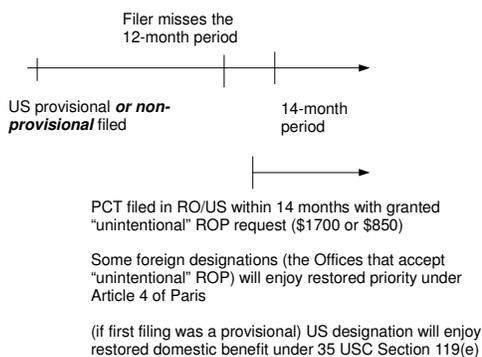
10

### Example 1: US provisional filer misses 12 months



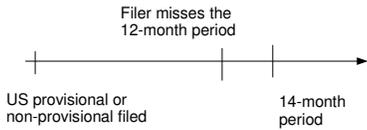
11

### Example 2: US filer misses 12 months



12

Example 3: US filer misses 12 months



US provisional or non-provisional filed

PCT filed *in RO/IB* within 14 months with granted "unintentional" ROP request (**no fee**)

Some foreign designations (the Offices that accept "unintentional" ROP) will enjoy restored priority under Article 4 of Paris

(if first filing was provisional) US designation will enjoy restored domestic benefit under 35 USC Section 119(e)

The FFL in the US priority application might cover the filing in RO/IB

---

---

---

---

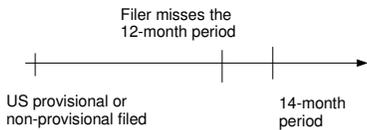
---

---

---

---

Example 4: US filer misses 12 months



US provisional or non-provisional filed

PCT filed in RO/IB within 14 months with granted "**due care**" ROP request (no fee)

**More** foreign designations (those Offices that accept either "unintentional" or "due care" ROP) will enjoy restored priority under Article 4 of Paris

(if first filing was provisional) US designation will enjoy restored domestic benefit under 35 USC Section 119(e)

The FFL in the US priority application might cover the filing in RO/IB

---

---

---

---

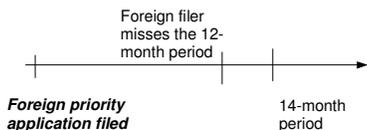
---

---

---

---

Example 5: *inbound PCT within 30 months*



**Foreign priority application filed**

PCT filed in RO/IB (or some other RO) by foreign filer within 14 months with granted "unintentional" or "due care" ROP request (no fee)

Some foreign designations will enjoy restored priority under Article 4 of Paris but that's not our point in this slide

US national-phase entry will enjoy restored priority under Article 4 of Paris

---

---

---

---

---

---

---

---

## Old filings must be reviewed

Example: Five years ago, the 6- or 12-month period was missed but the second application was filed within 8 or 14 months

You can file the ROP request now, if the delay five years ago was unintentional

16

---

---

---

---

---

---

---

---

## ROP and IBR

- US provisional filed May 17, 2015
- PCT filed May 17, 2016
- On May 18, 2016 practitioner discovers to his or her horror that ***the wrong figures*** were filed
- Rule-based IBR is unlikely to save the practitioner
- Express IBR is unlikely to help in non-US countries
- Maybe a new PCT filing on May 18, 2016, together with ROP, will help

17

---

---

---

---

---

---

---

---

Thank you!

Carl Oppedahl  
Oppedahl Patent Law Firm LLC  
[www.oppedahl.com](http://www.oppedahl.com)

18

---

---

---

---

---

---

---

---