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**Datasheet for the decision  
of 13 April 2022**

**Case Number:** J 0014/21 - 3.1.01

**Application Number:** 19749424.8

**Publication Number:** 3823709

**IPC:** A61M21/00, A61B5/00, G06F3/01

**Language of the proceedings:** EN

**Title of invention:**

METHOD OF DEVELOPMENT OF CONCENTRATIONS AND DEVICE PRK-1U FOR  
ITS IMPLEMENTATION

**Applicant:**

Grabovoi, Grigorii Petrovich

**Relevant legal provisions:**

PCT Art. 2(xvii), Art. 11(1), Art. 11(3), Art. 22, Art. 22(1)  
and (3), Art. 39(1), Art. 53(1), Art. 58(2), R. 2.4(a), R.  
26bis.3(a), R. 26bis.3(a)(ii), R. 49.6, R. 49ter.2, R. 49ter.  
2(a), R. 49ter.2(b)(i) and (iii), R. 49ter.2(d), R. 76.5(ii),  
R. 80(5), R. 94  
Vienna Convention on the Law of Treaties (1969) Art. 31(1),  
Art. 31(2)(a), Art. 31(3)(a) and (b), Art. 32  
EPC Art. 122  
EPC R. 112, 126(2), 134(1), 135(1), 136(1), 159(1), 160(1),  
160(2)  
RPBA 2020 Art. 12(2), 15(8)

**Keyword:**

International (PCT) application - restoration of the right of priority - admissibility  
Request for further processing  
Failure to observe time limits for restoration of the right of priority and for entering in the European phase  
"Understandings relating to certain provisions" adopted by PCT Assembly as legislator  
Authentic interpretation of PCT Rules by PCT Assembly  
Time limit ending on Easter Monday  
Primary object of appeal proceedings to review decision  
"Eventualmaxime"  
Factual basis of impugned decision on restoration of the right of priority may not be changed in appeal proceedings  
Re-establishment of rights - (no) - all due care (no) - due care on the part of the professional representative  
Professional representative's failure to clarify client's instructions  
No substitution during absence of professional representative

**Decisions cited:**

G 0001/18, G 0005/83, J 0006/21, J 0001/19, J 0008/18,  
J 0010/17, J 0017/16, J 0013/16, J 0005/13, J 0015/10,  
J 0012/10, J 0001/07, J 0019/05, J 0010/98, J 0003/94,  
J 0041/92, J 0016/92, J 0019/89, J 0023/85, J 0020/84,  
T 1214/20, T 1897/17, T 0742/11, T 0585/08, T 0991/04,  
T 1022/01, T 0122/91, T 0112/89, T 0287/84

**Catchword:**

The PCT Assembly may be considered the legislator for the PCT Regulations. See reasons 16.

"Understandings" of the PCT Assembly expressed in relation to a newly amended rule together with the adoption of this rule are an expression of the legislator's intention. See reasons 17 and 18.

The delegates of the PCT Contracting States in the PCT Assembly agreed, in the "understandings" related to R. 49ter. 2(b)(i) PCT, on how this rule should be applied. As an act of authentic interpretation by the legislator this agreement may be taken into account when assessing the context for the purpose of interpreting the new provision. See reasons 19.

In the case in hand, when applying R. 49ter.2(b)(i) PCT in the light of the understandings of the PCT Assembly, the request and the payment for restoration of the right of priority were made in time. See reasons 23.



**Juristische Beschwerdekammer**  
**Legal Board of Appeal**  
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Case Number: J 0014/21 - 3.1.01

**D E C I S I O N**  
**of the Legal Board of Appeal 3.1.01**  
**of 13 April 2022**

**Appellant:** Grabovoi, Grigorii Petrovich  
(Applicant) Ulica Kneza Mihaila 21A, lok.113  
Belgrad, 11102 (RS)

**Representative:** Fenix Legal KB  
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**Decision under appeal:** **Decision of the Examining Division of the European Patent Office posted on 12 July 2021 refusing the request for restoration of the right of priority of application EP19749424.8 with regard to US 62/673,151.**

**Composition of the Board:**

**Chair** W. Sekretaruk  
**Members:** R. Winkelhofer  
F. Bostedt

## **Summary of Facts and Submissions**

- I. The appeal is against the Examining Division's decision of 12 July 2021, in which the Examining Division refused the request for restoration of the right of priority and stated that application EP19749424.8 did not enjoy a right of priority with regard to US 62/673,151.
  
- II. On 5 July 2019, the appellant, through a Russian-speaking patent attorney based in the United States, filed international application PCT/IB2019/055761 with the International Bureau of WIPO as receiving Office. The application claimed the priority of provisional patent application US 62/673,151 of 18 May 2018.
  
- III. The international application also contained a request to restore the right of priority as per R. 4.1(c)(v) and R. 26bis.3(a) PCT. In a statement addressing the reasons why the international application was not filed within the priority period (see R. 26bis.3(b)(ii) PCT), dated 17 June 2019, the appellant essentially explained that he had only had a limited budget and had filed the international application without professional advice, but his assistant had not paid sufficient postage to mail the application and it was eventually returned undelivered. The failure was only discovered after the 12-month priority period (R. 2.4(a) PCT) had expired. The omission had therefore been unintentional and had occurred despite the due care required by the circumstances having been taken.
  
- IV. The International Bureau of WIPO as receiving Office granted this request applying the criterion of "unintentionality".

- V. By EPO Form 1201, dated 25 September 2020, the Receiving Section of the European Patent Office informed the appellant of the requirements for entering the European phase, in particular that a request for examination under R. 159(1)(f) EPC (in conjunction with Art. 22(3) PCT) had to be filed with the EPO within 31 months of the priority date and that corresponding fees had to be paid, otherwise the European patent application would be deemed withdrawn under R. 160(1) EPC. The same legal consequence would ensue if the filing fee and, where applicable, the additional fee for a European patent application containing more than 35 pages (R. 159(1)(c) EPC, Art. 2(1), items 1, 1a Rules relating to Fees (RFees)) were not paid within 31 months of the priority date. The appellant was further informed that under Art. 49ter.2(b)(i) PCT, a (further, new) request for restoration of the right of priority had to be filed within one month of the expiry of the above-mentioned time limit, and a corresponding fee had to be paid.
- VI. The appellant did not react within the time limit under R. 159(1) EPC (i.e. by 18 December 2020).
- VII. On 26 January 2021, the Receiving Section informed him under R. 112(1) EPC that a loss of rights had occurred because the filing fee, and the fee for 440 pages, had not been paid in due time. He was also informed of the possibility for further processing of the application under Art. 121 EPC in conjunction with R. 135(1) EPC if he paid the requisite fees within two months.
- VIII. On 25 March 2021, the appellant, now represented by European professional representatives, filed a request via EPO Form 1200 for entry into the European phase and

for examination of the application by the EPO as designated Office (EP19749424.8). In the "Fees" box, various fees were indicated, including one for further processing and one for filing, which were paid on the same day.

- IX. In a telephone consultation with the appellant's representatives on 31 March 2021, a formalities officer of the Receiving Section informed them that a (further) fee for further processing was still outstanding for the late filing of a declaration under R. 6 EPC and that this fee was due by 5 April 2021. Furthermore, it was pointed out that the decision of the International Bureau of WIPO as receiving Office to restore the right of priority pursuant to the criterion of "unintentionality" had no effect in the proceedings before the EPO, and that under R. 49ter.2 PCT a new request had to be filed before the EPO as designated Office and a corresponding fee paid by 5 April 2021. The request for restoration of the right of priority therefore had to be filed, together with the fee payment for further processing, by 5 April 2021 at the latest.
- X. Full fee payments were made on 5 April 2021 (for the restoration of the right of priority) and on 6 April 2021 (for further processing).
- XI. A request for restoration of the right of priority under R. 49ter.2 PCT was submitted via EPO Online Filing on 6 April 2021 (dated 5 April 2021). According to the request, the appellant had been unable to file the international application within the priority period despite taking the due care required by the circumstances. For the priority application, he had relied on a trusted one-man patent firm in the USA

whose attorney could communicate with him in Russian and who was competent in the technical area of the invention. Starting from 9 May 2019, the appellant and the attorney had exchanged emails that gave the appellant the impression that work on the international application had already started. With an email of 19 May 2019 (received by the attorney on 18 May 2019 due to the time difference), the appellant had asked the attorney for updates but the attorney had been travelling at that time with no internet access. Because of "unforeseen technical reasons", the attorney was not able to read the email instructions until Tuesday, 21 May 2019. As the matter was urgent, the appellant actively tried to find another Russian-speaking attorney on 20 May 2019 who could confirm the status of and/or file the international application in time, but to no avail.

XII. Several documents were appended to the request for restoration, essentially confirming the factual submissions made in the request, notably a statement by the attorney dated 3 April 2021, which included the additional information that the deadline for filing the international application had been Monday, 20 May 2019, midnight Geneva time; because the attorney had been unable to access his emails while travelling over the weekend (between Saturday, 18 May 2019 and Tuesday, 21 May 2019), he had been unable to read the appellant's email and take appropriate action to file the international application before the deadline. There was no other person in his firm available to respond to client requests.

XIII. By decision of the Examining Division of 23 April 2021, the request for further processing under Art. 121(2) EPC was granted. The Examining Division further stated



that the legal consequence of application EP19749424.8 being deemed to be withdrawn would not ensue.

XIV. By communication dated the same day, the appellant was further informed of the Examination Division's preliminary opinion that his US attorney had not taken all due care, and the appellant was invited to submit further submissions or evidence within two months of the notification of the communication.

XV. On 23 June 2021, the appellant supplemented his submissions regarding the restoration of the right of priority by stating, *inter alia*, that in an email exchange with his attorney starting on 16 May 2019 the attorney had informed him of the deadline of Monday, 20 May 2019. However, the attorney, awaiting additional instructions from the appellant, did not immediately file the application. In his submission, the appellant confirmed that the attorney had stated in the email that he would not be available over the weekend from 18 May 2019, but the appellant further submitted that he had expected the attorney to work on Monday, 20 May 2019. Moreover, the appellant submitted that "in early mid-May" the attorney had told him in a telephone conversation that, in the event that the deadline was missed, it would still be possible to restore the priority right within two months of the date of expiry of the priority period. Thus, in the appellant's view, both he and the attorney had exercised due care.

XVI. Together with his submission of 23 June 2021, the appellant again filed documentary evidence which essentially confirmed these factual submissions and notably included a statement by the attorney dated 31 May 2021. The statement contained the additional information that the appellant had planned to file a US

application and that the attorney had informed him that the deadline for any such application was the same as for an international application claiming the priority of provisional patent application US 62/673,151. The appellant had told the attorney that he - the appellant - would provide additional instructions and details regarding the filing of an international application. Accordingly, the attorney waited for further instructions and details. He told the appellant that he would not be available over the weekend starting on 18 May 2019, due to unforeseen circumstances. Accordingly, he would not file the international application before the deadline. He also informed the appellant that WIPO allowed a request for restoration of the right of priority to be filed within two months of the date of expiry of the priority period.

XVII. In the contested decision of 12 July 2021, the Examining Division refused the request for restoration of the right of priority and stated that application EP19749424.8 did not enjoy a right of priority with regard to US 62/673,151. The Examining Division first dealt with the admissibility of the request by, *inter alia*, quoting the Guidelines for Examination Part E-IX, 2.3.5.3(iii). According to this section of the Guidelines, in a case where the application was deemed withdrawn under R. 160(1) EPC for failure to comply with a requirement under R. 159(1) EPC, the request for restoration of priority might "still be filed together with a timely request for further processing in respect of the 31-month time limit under R. 159(1) [EPC]". As this had been done in the case in hand and the requisite fee had been paid, the request for restoration of the right to priority was admissible.

- XVIII. On the merits, the Examining Division held that while the appellant had acted with due care, this had not been the case with his attorney, who had gone on a trip without internet access in spite of the approaching deadline and without having taken any precautions to have another person act as his substitute and respond to client requests during his absence. In addition, he had informed the appellant that the International Bureau of WIPO as the receiving Office would allow a request for restoration of the right of priority to be filed within two months of the date of expiry of the priority period, thereby creating the impression that the right of priority could easily be restored if the priority deadline was missed. However, even if the receiving Office granted any such request under the "unintentionality" criterion, that decision would have no effect in some designated Offices, including the EPO, which exclusively applied the "due care" criterion. A diligent patent attorney would be expected to be aware of this and consequently should make every effort to ensure that a priority deadline was met.
- XIX. In his appeal, the appellant requests that this decision be amended such as to restore the right to claim priority of US 62/673,151. He does not request oral proceedings.
- XX. He essentially argues that the attorney had, in fact, also exercised all the due care required by the circumstances. The appellant had told the attorney explicitly that he did not have any intentions to file in Europe but wanted to focus on the US and Russian markets. They had agreed on filing with the Eurasian Patent Organization and in Ukraine upon entering the national phases. As the USPTO, the Eurasian Patent Organization and the Ukrainian Intellectual Property

Institute all accepted the "unintentional" criterion when restoring a priority right, the attorney, who "was forced unintentionally to stay away from the office Monday 21 [sic] May 2019", did not consider that filing a few days after the deadline would cause any disadvantage to the appellant or his international application. Thus, the appellant had informed the attorney that he would not seek to enter national phases in countries that did not accept the "unintentional" criterion.

XXI. With his appeal, the appellant again provided further documents, which essentially confirm the factual submissions, and notably include a statement by the appellant himself dated 14 September 2021. In this statement, he provided the additional information that he had had no plans to file an application in Europe but "since the filing of the international application [he] began to consider other territories, including the idea of filing an application for a European patent, not knowing that the right of priority was not automatically restored in all countries, because this issue / point never arose".

XXII. In a written statement by the attorney dated 11 November 2021 (also submitted with the appeal), the attorney confirms the appellant's assertions and adds that there was an assistant at his firm who was available to respond to client requests during holidays or weekends. The attorney had taken a day off, "not knowing for sure" that he "would have to be absent the following Monday". Thus, he "reviewed the messages [from the appellant] and his current information before leaving and then decided, having considered the worst-case scenario of restoring the right, to file a PCT

application later than the deadline, if necessary, without causing damage" to the appellant.

## **Reasons for the Decision**

### Request for restoration of the right of priority - admissibility

1. If an international application is filed more than 12 months after the filing date of the earlier application whose priority is claimed, but within two months after expiry of the priority period (R. 2.4(a) and R. 26bis.3(a) PCT, the applicant may file a request for restoration of the right of priority with the EPO as the designated Office under R. 49ter.2 PCT. The EPO will grant that request only if the failure to claim the right of priority within the priority period occurred in spite of the due care required by the circumstances having been taken. The EPO applies the requirement of due care in accordance with their established practice under Art. 122 EPC. The other criterion referred to in the PCT, namely whether the failure was unintentional (R. 26bis.3(a)(ii) PCT), does not play a role in proceedings before the EPO (see J 1/19, reasons 2.2 et seq.; J 17/16, reasons 2.1; J 10/17, reasons 2 and 3.7; for a detailed and comprehensive overview of the legal framework see also J 13/16, reasons 3.1 et seq. and 4.4).
2. A request for restoration of the right of priority has to be filed within one month of the time limit stated in Art. 22(1) and (3) PCT in conjunction with R. 159(1) EPC, i.e. within 31 months from the priority date, and the corresponding fee - the fee for restoration as per Art. 2(1), item 13, RFees - has to be paid (R. 49ter.2(b) (i) and (iii), (d) PCT, R. 136(1), third sentence, EPC;

see again J 1/19, reasons 2.3; J 13/16, reasons 3.2; J 8/18, reasons 3; J 6/21, reasons 2.2).

3. The international application was filed on 5 July 2019, thus within two months of the expiry of the priority period on 20 May 2019 (R. 49ter.2(a) PCT together with R. 80(5) PCT; 18 May 2019 fell on a Saturday).

The request for restoration of the right of priority was filed on 6 April 2021, and the corresponding fee was paid on 5 April 2021.

On the face of it, the one-month time limit under R. 49ter.2(b)(i) PCT for filing any such request had already expired on 18 January 2021 (i.e. 31 months from 18 May 2018 = 18 December 2020 + 1 month).

The request would thus appear to be deemed not to have been filed (J 1/19, reasons 2.4; J 8/18, reasons 3.6; see also G 1/18 (headnote)).

4. However, the appellant additionally failed to observe the time limits under R. 159(1)(c) and (f) EPC for entering the European phase. This failure was then remedied by the Examining Division's decision of 23 April 2021 to grant the request for further processing, with the consequence that the application was no longer deemed withdrawn.

There is nothing in the law to indicate that the failure to observe the time limits under R. 159(1)(c) and (f) EPC, and the subsequent remedying of this failure with the grant of further processing, could have an impact on the failure to meet the time limit under R. 49ter.2(b)(i) PCT.

Nevertheless, for the reasons set out below, and taking

into account the specific circumstance of the case, the failure to observe the time limits as per R. 159(1)(c) and (f) EPC has an impact on the failure to meet the time limit under R. 49ter.2(b)(i) PCT and, therefore, on the request for restoration of the right of priority in the case in hand.

5. R. 49ter.2(b)(i) PCT, in the parts relevant here, entered into force on 1 April 2007 and became applicable to the EPO as designated Office from 13 December 2007 (see PCT Gazette No. 5/2006, p. 3178; later amendments as from 1 July 2015 have no implications on this case). When the rule was introduced, the Assembly of the PCT Union ([PCT] Assembly, Art. 2(xvii) PCT) as the authority responsible for amending the PCT Regulations (Art. 58(2) PCT) adopted "Understandings relating to certain provisions" (see PCT/A/34/6, Report of the Thirty-Fourth (15th Ordinary) Session, 5 October 2005, Annex IV), which in point 8. read (emphasis added):

"In connection with the adoption of amended Rule 49ter.2(b)(i) ..., the Assembly noted that, where the effect of the international application provided for in Article 11(3) ceases because the applicant fails to perform the acts referred to in Article 22 or 39(1) within the applicable time limit but the designated Office reinstates the rights of the applicant with respect to that international application in accordance with Rule 49.6 or 76.5(ii), respectively, such reinstatement **will extend to all time limits calculated on the basis of the applicable time limit** under Article 22 or 39(1), respectively, including **the time limit under Rule 49ter.2(b)(i).**" (hereinafter referred to as "Understandings of the PCT Assembly"; see also PCT/R/WG/7/13 and PCT/A/34/1, points 55., respectively, and PCT/A/34/2 Rev., Annex V, point 78.).

6. In view of this, the Guidelines for Examination Part E-IX, 2.3.5.3(iii), in its version of March 2022, to which the Examining Division referred (in their previous version; identical in this context) in support of their conclusion that the request was made in time, and the Euro-PCT Guide 5.13.022 of January 2021 (essentially using the same wording) state the following:

"The EPO as designated ... Office will grant a request for restoration of priority right only if the following requirements are met: ... where the application is deemed withdrawn under Rule 160(1) for failure to comply with a requirement under Rule 159(1), the request for restoration of priority may still be filed together with a timely request for further processing in respect of the 31-month time limit under Rule 159(1) ..."

7. Under EPO practice, the Understandings of the PCT Assembly together with the above-cited section of the Guidelines have apparently translated into allowing requests for restoration of the priority right made before or at the same time as requests for further processing in respect of the 31-month period under R. 159 EPC, if filed within two months of a communication notifying a loss of rights as per R. 160(2) and R. 112 EPC. This is also the path that the Examining Division took in the case in hand.
8. There is no jurisprudence of the boards of appeal explicitly addressing the legal quality of "understandings" of the PCT Assembly, particularly not for a case like that in hand in which the relevant provision of the PCT Regulations is silent on the (intended) legal consequences of a particular factual situation, with only the "understandings" addressing that



situation. However, the following decisions may be noted here.

Consolidated cases J 20/84 and J 23/85, in reasons 10, deal with a "decision" of the PCT Assembly, which had likewise supplemented a PCT provision (namely Art. 11(1) PCT) by stating that an international application could also be accorded a filing date if submitted by telecopier (to the German Patent Office). It was underlined that the EPC contracting states had all been involved in this PCT Assembly decision and applied it just as if the provision - namely to also accord a filing date to applications submitted by telecopier - was contained in Art. 11(1) PCT itself. T 1022/01, reasons 6.1 et seq., deals with a "decision" of the PCT Assembly in a report adopted by the Assembly on the occasion of an amendment to R. 94 PCT which actually contained a transitional provision to R. 94 PCT in its amended version. T 1022/01 concludes that this "decision" expressed "the position taken by the Organisations administering the PCT" to apply this transitional provision just as if it was contained in the PCT rule itself. J 3/94, reasons 2.5, refers to a report of the PCT Assembly on the occasion of an amendment to the PCT Regulations, without further reflecting on the legal quality of that report.

9. There is established jurisprudence of the boards of appeal that applies the rules of interpretation of the Vienna Convention on the Law of Treaties of 1969 (VCLT), namely their Art. 31 and 32 (see Case Law III.H.1, to a large extent developed in G 5/83, OJ 1985, 64). These principles of interpretation codified in Art. 31 et seq. VCLT are also applicable when interpreting the Patent Cooperation Treaty (see J 10/98, reasons 2). While they are directly applicable only to the treaty itself, the same principles of interpretation may also be applied

when interpreting the Regulations under the Patent Cooperation Treaty, i.e. the PCT rules.

10. According to Art. 31(1) VCLT, a treaty is to be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of the object and purpose of the treaty. Art. 31(2)(a) VCLT stipulates, in particular, that the context for the purpose of interpreting a treaty encompasses, in addition to the text, including its preamble and annexes, any agreement relating to the treaty which was made between all the parties in connection with the conclusion of the treaty. Also to be taken into account, together with the context, are any subsequent agreement between the parties to a treaty regarding its interpretation or the application of its provisions (Art. 31(3)(a) VCLT), and any subsequent practice in the application of a treaty which establishes the agreement of the parties regarding its interpretation (Art. 31(3)(b) VCLT).
11. Taking into account any such agreement or subsequent practice of the parties to a treaty, whereby the parties can be seen as the treaty's legislator, is commonly referred to as the method of "authentic interpretation" by the legislator or "authentic means of interpretation", although these, or similar, terms are used for a wide variety of situations and cases, and not always in a consistent fashion. The parties as the "masters" of "their" treaty are, in principle, not prevented from making (subsequent) understandings or agreements relating to the treaty. Any such agreements are, after all, an expression of the consensus of the parties, i.e. the legislator (as regards the method of authentic interpretation, see, *inter alia*, Report of the International Law Commission (ILC) on the Work of its

65th Session, UN Doc. A/68/10 (2013), Draft Conclusion 2, 20; ILC, Draft Articles on the Law of Treaties with Commentaries, Yearbook of the International Law Commission 18 (1966), vol. 2, 187 (220 et seq.); ILC, Summary Records of the 16th Session of the International Law Commission, ILCYB 16 (1964), vol. 1, 1 (315 et seq.); *Dörr/Schmalenbach*, Vienna Convention on the Law of Treaties (2012), Article 31: General rule of interpretation, paras 65, 74; *Djeffal*, Static and Evolutive Treaty Interpretation (2015), pp. 93 et seq., 132 et seq.; *Berner*, Authentic Interpretation in Public International Law, ZaöRV 76 (2016), 845-878; *Linderfalk*, On the Interpretation of Treaties (2007), 153; see also *Endicott*, Authentic Interpretation, Ratio Juris. vol. 33 No. 1 March 2020 (6-23)).

12. Authentic interpretation of international treaties is also a well-accepted method in national and international jurisprudence, even if - again - there is a wide variety of situations and cases where it is applied, in each case with varying degrees of nuances and considerations (see, for example, the jurisprudence of the ICJ, in *Kasikili v. Sedudu Island* (Botswana/Namibia), ICJ Reports 1999, p. 1045; or the jurisprudence of the ECtHR, in *Azienda Agricola Silverfunghi S.A.S. and others v. Italy*, No. 48357/07, 52677/07, 52687/07 and 52701/07; *Naït-Liman v. Switzerland*, No. 51357/07; German BFH I R 28/14 and I R 38/14, both also stating the precedence of authentic interpretation over other means of interpretation).
13. On occasion, jurisprudence of the boards of appeal also applies the instrument of authentic interpretation, although not in the context of the PCT (see, for example, J 19/89, reasons 5; T 991/04 of 22 November 2005, reasons 6, 7, 17 and 19).

14. The board understands Art. 31 VCLT, in particular its paragraphs (2) (a) and (3) (a), to be based on the general idea that an agreement, or a subsequent agreement, between the parties of the treaty may play a role when assessing the "context" within the meaning of Art. 31(1) VCLT. Any such agreement is then taken as formalised evidence of the intention of (all) the parties, i.e. of the legislator, that a specific provision should be interpreted or applied in a certain way. Accepting that agreement as being a part of the "context" within the meaning of Art. 31(1) VCLT has to be seen in contrast to the supplementary means of interpretation, including the preparatory work of the treaty and the circumstances of its conclusion, under Art. 32 VCLT, to which recourse may be had only for confirming the result of the interpretation under Art. 31(1) VCLT, or for the purpose of resolving an ambiguity or obscurity or of avoiding a manifestly absurd result. While the intention of the legislator might be deduced from the preparatory work of the treaty, often referred to in the EPC context as *travaux préparatoires*, the legislator's intention, which is formalised in an agreement between the parties, is accorded more weight for the interpretation of the treaty provisions. Whether it was indeed the legislator's intent that the agreement formed part of the "context", or was to be taken into account together with it, will depend on the circumstances of each case.
15. The circumstances of the case in hand are as follows.
16. As set out above, the PCT Assembly is the legislative authority for amending the PCT Regulations (Art. 58(2) (a) PCT), in accordance with the majority voting requirements laid down in them (Art. 58(2) (b) PCT). The Assembly consists of delegates of the PCT contracting states (Art. 53(1) PCT). They include, *inter alia*, all EPC

contracting states. As also mentioned above, the principles of interpretation codified in Art. 31 et seq. VCLT may also be applied when interpreting the Regulations under the Patent Cooperation Treaty, i.e. the PCT rules. In the specific circumstances of this case, the PCT Assembly is to be considered the legislator as per the board's understanding set out above.

17. At their thirty-fourth (15th ordinary) Session in Geneva, from 26 September to 5 October 2005, the PCT Assembly adopted amendments to the PCT Regulations, as set out in Annexes I and II to the Report on this Session, in particular including the amendments to R. 49ter.2(b)(i) PCT (PCT/A/34/6) in question here. At the same time, in line with established practice, the "Understandings relating to certain provisions" were adopted and set out in Annex IV to the Report. Notably, the amendment to R. 49ter.2(b)(i) PCT had been based on the work of the PCT Working Group on Reform of the Patent Cooperation Treaty (see Report of their Seventh Session in Geneva, from 25 to 31 May 2005, PCT/R/WG/7/13 and PCT/A/34/1, points 55., respectively, and PCT/A/34/2 Rev., Annex V, point 78.), in which the related "understandings" had been discussed and developed simultaneously with the proposed amendment to R. 49ter.2(b)(i) PCT itself. The PCT Working Group had also simultaneously invited the PCT Assembly to express that understanding of the amended rule together with its adoption.
18. Thus, the Understandings of the PCT Assembly express the legislator's intention to supplement R. 49ter.2(b)(i) PCT, on the occasion of and together with its adoption, with a provision addressing a factual situation like in the case in hand. While none of the above-cited sources gives any explanation as to why a provision to that effect was not directly integrated into the amended rule,

the adoption of these understandings was subject to the same majority voting requirements and the same procedure as the amendments to the rule itself (and indeed occurred alongside them).

19. The delegates of the PCT contracting states in the PCT Assembly agreed, in the "understandings" related to R. 49ter.2(b)(i) PCT, on how this rule should be applied. As an act of authentic interpretation by the legislator, this agreement may be taken into account when assessing the context for the purpose of interpreting the new provision, even in a case like the one in hand in which the provision itself - R. 49ter.2(b)(i) PCT - does not contain any hints that the reinstatement should also extend to the time limit for restoration of the priority right.
  
20. In that respect, however, it should be noted that the content of the Understandings of the PCT Assembly was not directly integrated into the amended PCT rule or published in the same, or even a similar, fashion as the PCT rule amendment itself. Compared with an amendment to a rule, which is published after the conclusion of the legislative process for its adoption, access to any such "understanding" for users of the PCT system is severely impaired. In fact, it requires some in-depth insight into the legislative process for PCT rule amendments and can rather easily be overlooked. Against this background, there may be cases where an understanding of the PCT Assembly will have to be disregarded when interpreting the newly introduced rule, in spite of the "understanding" expressing the legislator's intention, failing its publication in a manner that allows users to readily take note of it without having to have in-depth insight into the PCT legislative procedure. This will be the case, in particular, if the "understanding" leads to

the application of the law which is to the detriment of the party relying on a newly introduced rule.

21. At least for the case in hand, however, the Understandings of the PCT Assembly are to be taken into account in such a way that their content is considered when interpreting and applying R. 49ter.2(b)(i) PCT; after all, they were clearly conceived to be to the advantage of applicants who have missed the time limit for restoration of the priority right but whose rights with respect to the international application were reinstated. Under these circumstances, the applicants' legal position would not have been impaired, even if they had been completely unaware of these "understandings".
22. In the case in hand, further processing was requested by payment of the corresponding fee on 6 April 2021. This was the last day of the time limit under R. 135(1) EPC, i.e. two months after the notification of the communication dated 26 January 2021 regarding a loss of rights under R. 112(1) EPC (26 January 2021 + 10 days (see R. 126(2) EPC) + 2 months; 5 April 2021 was Easter Monday, on which the EPO was closed; OJ 2020, A115 (see R. 134(1) EPC)). The request for restoration of the right of priority was filed on the same day.
23. Put another way, in the circumstances of the case at issue, further processing (or the granting of further processing) "turns back the clock" so as to re-open the possibility for a request for restoration for which the time limit had already been missed.

Therefore, when applying R. 49ter.2(b)(i) PCT in the light of the Understandings of the PCT Assembly (PCT/A/34/6), and in line with the considerations outlined above, the request and the payment for restoration of the

right of priority were made in time. As there are no further reasons which could call into question the admissibility of the request for restoration of the right of priority, the request is to be examined on its merits.

Request for restoration of the right of priority - merits

24. As outlined above, the EPO applies the requirement of due care to grant a request for restoration in accordance with its established practice under Art. 122 EPC. In assessing whether all due care required by the circumstances has been taken, the circumstances of each case must be considered as a whole (e.g. T 287/84 OJ EPO 1985, 333, reasons 2; T 1214/20, reasons 2.).
25. In its assessment of the request for re-establishment, the board fully subscribes to the factual findings and legal reasoning in the decision under appeal. For the reasons given in that decision (see points 10 to 14), which are in line with the jurisprudence of the boards of appeal, it cannot be said that the attorney had taken all due care required by the circumstances. Against this backdrop, reference is made to the reasoning of the decision, with which the board agrees (Art. 15(8) RPBA 2020).
26. The Examining Division rightfully pointed out that it was incumbent not only on the appellant to exercise all due care, but on all persons acting on his behalf, notably the professional representative whose acts are ultimately attributed to the appellant (Case Law III.E.5.5.2 et seq.; see for example T 742/11, reasons 12). In particular, a professional representative must be able to communicate effectively with the client, particularly when essential information has to be passed on in one



direction or the other; in particular, when necessary instructions for discharging the representative's duty are missing, the representative has to take all measures necessary to obtain them (see Case Law III.E.5.5.2(a) and T 112/89, reasons 5) and clarify the applicant's awareness of the particular circumstances of the case and their intentions for the further pursuit of the application (see for example J 1/07 point 4.4, J 12/10 point 3., J 5/13 point 3.3.2). This is even more important if, as is the case here, the client was not familiar with the procedures before the EPO, as evident from his own assertions. Moreover, professional representatives generally have to start work on a case well ahead of a deadline, so as not to run the risk of getting into a situation where the required act cannot be completed in time (see Case Law III.E.5.5.2(e), J 16/92, reasons 8). Lastly, professional representatives must ensure an effective system of staff substitution in the event of absences (see Case Law III.E.5.4.5; T 122/91, reasons 2, in which it was found that the responsible person had not exercised due care when going on a trip without informing his deputy that immediate attention was required because of a time limit to meet; J 41/92, OJ 1995, 93, reasons 4.4, which held that if there was no substitute or assistant at a representative's office, the observance of time limits might, for example, be sought through co-operation with colleagues).

27. In the appellant's favour, the Examining Division considered that all his factual submissions in the course of the proceedings had been validly filed, even though the filing of submissions in re-establishment and restoration proceedings is subject to substantial restrictions when made outside the initial time limit (see Case Law III.E.4.4 and III.E.5.1; see J 19/05, reasons 4, 5; T 585/08, reasons 9; J 15/10, reasons 3.2; this

corresponds to the principle of "Eventualmaxime" or "Häufungsgrundsatz" in contracting states with a German law tradition). It is clear from R. 49ter.2(b)(ii) PCT that the request must state the reasons why the international application was not filed within the priority period. Any reasons added later may be disregarded. However, the Examining Division accepted the later factual submissions, in the appellant's favour, even though they were somewhat at odds with the submissions made in the request as initially filed.

28. In the appeal, the appellant further adds factual assertions which have not been made before, and which only partly coincide with the submissions made at first instance. It is not permissible to alter the factual basis of the impugned decision by asserting facts in the appeal that have never been raised before, and which are even - at least partly - in contradiction to the factual submissions made in first instance.
29. Against this backdrop, the appellant's new factual assertions in the appeal proceedings, according to which he had never planned to file an application before the European Patent Office, cannot be taken into account.
30. Lastly, even if the board were to take into account these new factual assertions - again in the appellant's favour - they would not change the outcome of the case.

First, it is questionable if the attorney started working on the file (particularly reaching out to the appellant to clarify his plans and performing the necessary steps to pursue them) early enough to be ready in good time before the deadline and to be prepared for last-minute surprises. Secondly, he should certainly not have considered waiting beyond the deadline to finalise the

necessary steps on the assumption, and/or giving the appellant the impression, that the priority right could easily be restored even if the application were filed only in jurisdictions operating on the "unintentional" criterion. This was even more an issue in the case in hand since the appellant's statements demonstrate that he was not familiar with any of these procedures. Thirdly, the attorney knew that instructions from the appellant for filing the international application were missing. Nevertheless, he went on a weekend trip, which included the final day of the deadline, without access to his emails and without having reached out to the appellant (again) beforehand. Thus, he could not clarify beforehand whether the appellant would give the necessary instructions immediately. Lastly, the attorney did not find a substitute for the duration of his absence who could have ensured that any last-minute instructions from the appellant could have been implemented and that the application could be submitted on the last day of the deadline at the latest.

31. In view of these circumstances, the Examining Division was correct in concluding that due care had not been taken by the attorney, whose negligent conduct was to be attributed to the appellant. For this reason alone, the right of priority cannot be restored. It can thus remain open whether the appellant himself had acted with all due care.
32. No request for oral proceedings was made. Since the present decision is based on facts which are based on the appellant's own submissions, there was no reason to hold oral proceedings of the board's own motion either (T 1214/20, reasons 13; T 1897/17, reasons 12; J 10/21, reasons 13).

**Order**

**For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chair:



C. Eickhoff

W. Sekretaruk

Decision electronically authenticated