

Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

Twenty-Second Session Tokyo, February 4 to 6, 2015

CLARIFYING THE PROCEDURE REGARDING THE INCORPORATION BY REFERENCE OF MISSING PARTS – COMMENTS FROM THE EUROPEAN PATENT OFFICE

Document submitted by the European Patent Office

1. At the seventh session of the PCT Working Group, held in Geneva from June 10 to 13, 2014, the International Bureau submitted a document entitled “Clarifying the Procedure regarding the Incorporation by Reference of Missing Parts”, which summarizes the responses from Offices to a questionnaire on procedures regarding the incorporation by reference of missing parts under Rule 20 PCT (document PCT/WG/7/19). The responses show that Offices have different opinions on whether it should be permitted to replace wrongly filed claims and/or description elements of an international application with a full specification. Offices also expressed different views on related issues, such as the incorporation by reference of missing parts from multiple priorities, the treatment of erroneous parts or elements as an amendment under the Chapter II procedure, and the acceptance of priority claims which bear the same date as the international filing date.

2. In paragraph 16 of document PCT/WG/7/19, the International Bureau (IB) outlined a possible compromise solution, namely to amend the Regulations so as to provide that receiving Offices should permit the incorporation of a full specification as a missing part under Rule 20 (together with a legal basis for International Searching Authorities to charge an additional search fee, for example, if, at the time of incorporation, the International Searching Authority had already commenced international search on the application), while clarifying that designated Offices whose national law would not allow for such incorporation could proceed with the application as if such incorporation had not taken place. Such an approach would at least result in a uniform practice by all receiving Offices (thus avoiding “forum shopping” among receiving Offices), give

the International Searching Authority a clear basis for charging a second search fee and leave the option open to the applicant to pursue the matter further in the national phase before the designated Offices on the basis of the (divergent) national laws applied by those Offices.

3. At the seventh session of the Working Group, the Delegation of the European Patent Office (EPO) was supportive of the proposals from the International Bureau in paragraph 16 of document PCT/WG/7/19, provided that it was made clear that the designated Offices could, in any event, review decisions by the receiving Offices which had been taken on the basis of erroneous filings; however, it indicated that further consultation was needed with its membership before having a definite position on this matter. The EPO also indicated that by no means erroneously filed parts of the application could be replaced by parts incorporated by reference in view of the consequences this could have on the disclosure of the application.

4. For this session of the Meeting of International Authorities under the PCT, the International Bureau submitted a document entitled "Clarifying the Procedure regarding the Incorporation by Reference of Missing Parts" (PCT/MIA/22/14 Rev.) where amendments to Rules 16.1, 20.5 and 20.8 are proposed along the lines of the solution described in paragraph 16 of document PCT/WG/7/19.

5. The EPO is supportive of the compromise solution proposed by the IB and will discuss it further with its membership; however, the EPO would like to suggest some further modifications in proposed amended Rule 20.5. The EPO supports the wording as outlined by the IB for the introduction of erroneously filed parts in Rule 20.5. However, it is proposed to insert this element into a new Rule 20.5(a-bis) with a view to clarify further that also cases where *all* of the description, claims or drawings (not only a part) are or appear to have been erroneously included in the international application shall be covered. Furthermore, it would ease the reference for designated Offices making a notification of incompatibility under Rule 20.8(d).

6. It is furthermore proposed to insert a paragraph (d) in Rule 20.6 clarifying that an erroneously included part under Rule 20.5(a-bis) shall not be replaced by an incorporated part, and that a non-unity procedure shall not be started in cases where parts have been incorporated by reference under Rule 20.5(a-bis) (i.e. search shall be based on the incorporated parts). Other consequential changes are also proposed in the Annex.

7. The Meeting is invited to comment on the further improvements to clarify Rule 20 as outlined in the Annex.

[Annex follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS

(Proposed changes with regard to the draft contained in Annex to PCT/MIA/22/14 Rev.)

Rule 16.1

Right to Ask for a Fee

(a) to (f) [*No Change*]

(g) Where a part of the international application referred to in Rule 20.5~~(a)(i)~~ (a-bis) has been incorporated by reference in the international application under Rule 20.6(b) only after the International Searching Authority has begun to draw up the international search report, that Authority may invite the applicant to pay additional fees within one month from the date of the invitation, indicating the amount of those fees to be paid. Rule 40.2(a) and (b) shall apply *mutatis mutandis* to those additional fees. If the applicant does not pay the amount in full of the additional fees due within one month from the date of the invitation, the part of the international application referred to in Rule 20.5~~(a)(i)~~ (a-bis) which has been incorporated by reference in the international application under Rule 20.6(b) need not be taken into account by the International Searching Authority for the purposes of the international search.

16.2 [*No Change*]

Rule 20

International Filing Date

20.1 to 20.4 *[No Change]*

20.5 *Missing parts*

(a) *[No Change to current Rule 20.5(a)]*

(a-bis) In the case where all or part of the description, claims or drawings are or appear to have been erroneously included in the international application, the provisions of paragraph (a) shall apply *mutatis mutandis*.

(b) to (e) *[No Change]*

20.6 *Confirmation of Incorporation by Reference of Elements and Parts*

(a) to (c) *[No Change]*

(d) Any erroneously included part under Rule 20.5(a-bis) shall not be replaced by a part incorporated under paragraph (b) and shall not be considered for the purposes of Article 17(3)(a).

20.7 *[No Change]*

20.8 *Incompatibility with National Laws*

(a) *[No Change to current Rule 20.8(a)]*

(a-bis) *[No Change]*

(b) *[No Change to current Rule 20.8(b)]*

(c) *[No Change]*

(d) If on [DATE OF ADOPTION OF RULE CHANGE BY PCT ASSEMBLY],
Rule 20.5~~(a)(i)~~(a-bis) is not compatible with the national law applied by the designated Office,
that Rule [...].

(e) *[No Change to proposal in document PCT/MIA/22/14 Add.]*

[End of Annex and of document]