

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

**Twenty-Second Session
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CLARIFYING THE PROCEDURE REGARDING INCORPORATION BY REFERENCE OF MISSING PARTS

Document prepared by the International Bureau

The present document contains a further revised proposal to amend the Regulations so as to address the apparently different interpretation by receiving Offices and designated/elected Offices of the Regulations with regard to the incorporation by reference of missing parts. The content of the present document is identical to that of document PCT/MIA/22/14, except for certain further proposed amendments to Rules 20.5(a) and 20.8(a) and (b) which are indicated by grey highlighting in the Annex to the present document.

SUMMARY

1. As had been requested by the Working Group at its seventh session, the International Bureau has continued to discuss informally with interested Offices how to address the apparently different interpretation by receiving Offices and designated/elected Offices of the Regulations with regard to the incorporation by reference of missing parts. The present document summarizes the results of those discussions and sets out a proposal to amend the Regulations so as to address that issue at least for the purposes of the international phase.

BACKGROUND

2. The Working Group, at its sixth and seventh sessions, discussed how to address the apparently different interpretation by receiving Offices and designated/elected Offices of the provisions of Rules 4.18 and 20.5 and 20.6 with regard to the incorporation by reference of missing parts (see documents PCT/WG/6/20 and PCT/WG/7/19). The discussions sought to address the apparently different interpretation by receiving Offices and designated/elected Offices of the provisions of Rules 4.18 and 20.5 and 20.6. This different interpretation results in different practices by Offices where the international application, on the international filing date, contains the necessary (but erroneously filed) complete claim(s) *element* and/or the necessary

(but erroneously filed) complete description *element* (see Article 11(1)(iii)(d) and (e)) but the applicant nevertheless requests the incorporation by reference of all of the claims and/or all of the description contained in the priority application as a “*missing part*” in order to (at a later stage) completely replace the wrongly filed claims and/or description *elements* of the international application as originally filed with the equivalent “correct” version of those elements contained in the priority application.

3. The discussions during sixth and seventh sessions of the Working Group as well as the responses received in reply to a questionnaire sent by the International Bureau, in preparation of the discussions at the seventh session, to all Member States on the issue of incorporation by reference of missing parts (Circular C. PCT 1407, dated March 10, 2014) showed that there is no consensus among Member States on this issue.

4. Some Offices take the view that, under the above Rules, such practice is not permissible. These Offices argue that, by definition, the term “missing part” of the claims *element* or of the description *element* indicate that some part of such *element* was missing but other parts of that *element* had been filed. Incorporation by reference of a “missing part” would thus require that the “missing part” of the claims or description element that was to be incorporated by reference indeed “completed” that (incomplete) element as contained in the international application on the international filing date, rather than replacing it completely. Such practice would result in great difficulties for the International Searching Authority, being faced with an international application with in essence two sets of claims and two descriptions (“Should the search be carried out on both? Should a lack of unity of invention objection be raised?”) or, where such incorporation was granted only after that Authority had already begun with the international search or even only after it had already established the international search report, being faced with the need to carry out a second search without the possibility to charge the applicant a second search fee for its work.

5. Other Offices take the view that such practice is permissible. If not, it would result in the situation that an applicant who did not include any claim(s) and/or any description in the international application as filed would be allowed to have those elements included in the international application by way of incorporation by reference of a missing *element*, whereas an applicant who had attempted to include those elements in the international application as filed but who erroneously had filed the wrong claims and/or the wrong description would not be allowed to correct his mistake by submitting the correct elements. The applicant in the latter situation would thus be penalized for attempting to file a complete international application, albeit with the wrong claims and/or description elements. These Offices also refer to the fact that the Working Group, at its first session (see paragraphs 126 and 127 of document PCT/WG/1/16), had agreed that such practice was indeed permissible (“the Working Group noted that, in a case where the international application, on the international filing date, contained the necessary claim(s) element and description element (see Article 11(1)(iii)(d) and (e)), it was not possible under Rules 4.18 and 20.6(a) for the claims or description contained in a priority application to be incorporated as a missing element. However, it appeared to be possible, in such a case, for part or all of the description, or part or all of the claims, contained in the priority application to be incorporated under those Rules as a missing part.”), and that the Receiving Office Guidelines had been modified accordingly so as to clarify that, in the circumstances where incorporation by reference resulted in a duplicated set of description, claims or drawings, the set incorporated by reference was to be placed sequentially before the originally filed set.

6. During the seventh session of the Working Group, all delegations which took the floor acknowledged that the legal provisions regarding incorporation by reference of missing parts needed to be clarified, but expressed divergent views on how this should be achieved. The discussions at the seventh session concluded with the Working Group requesting the International Bureau to continue to work with interested Offices on the incorporation by reference of missing parts and present a document for the next session of the Working Group.

OPTIONS

7. Since the seventh session, as had been requested by the Working Group, the International Bureau has continued to work with interested Offices, notably the European Patent Office and the United States Patent and Trademark Office, on a possible solution. Following those informal discussions, however, it would appear that the divergent views on how best to address the issue at hand, as set out in paragraphs 4 and 5, above, continue to exist.

8. There thus now would appear to be two options as to possible ways forward:

(a) Option A: leave the situation “as is”, that is, leave the “fate” of requests for incorporation by reference in the situation described in paragraph 2, above, to the (divergent) practices of the receiving Offices; or

(b) Option B: amend the PCT Regulations to require all receiving Offices to permit the incorporation by reference in the situation described in paragraph 2, above, for the purposes of the international phase only.

9. Option B is, in essence, the compromise solution set out in paragraph 16 of document PCT/WG/7/19. Despite the fact that this compromise solution had received little support during the seventh session of the Working Group, in the absence of a more promising alternative, it would appear to be the only viable option to address the issue at least for the purposes of the international phase.

10. The basic question to be answered by Member States in this context would appear to be the following: “Where the applicant has made an error (here: erroneously filing the wrong description and/or the wrong set of claims), resulting in the need to abandon the application as filed—likely at a point in time where the priority period had expired, thus potentially leading to a complete loss of rights: should the PCT provide the applicant with a “path/bridge” to reach the national phase (here: allowing the incorporation by reference of the missing description and/or claims for the purposes of the international phase only; and ensuring that an international search is carried out which takes into account the matter which has been incorporated by reference, for the benefit of those designated Offices which, under their applicable national laws, recognize such incorporation) if there is a remedy available under the national law of at least some PCT Contracting States to correct that mistake (here: designated Offices which, under their applicable national laws, allow such incorporation by reference to “stand” for the purposes of national phase procedures)?

11. If Member States were not able to agree on what the answer to that question should be, or if they were to agree that the answer should be “no”, then Option A (“leave situation as is”) would appear to be the only possible way forward.

12. If, on the other hand, Member States were to agree that the answer to that question should be “yes”, then Member States may wish to consider to amend the Regulations as set out in the Annex to this document, as follows:

(a) require receiving Offices to permit the incorporation of an entire description and/or of an entire set of claims as a missing part under Rule 20;

(b) provide a legal basis for International Searching Authorities to charge an additional search fee if, at the time of incorporation, the International Searching Authority had already commenced with the establishment of the international search report;

(c) clarify that designated Offices whose national law does not allow for such incorporation may proceed with the application in the national phase as if such incorporation had not taken place.

13. *The Meeting is invited to comment on the issues set out in this document.*

[Annex follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS¹

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¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

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) 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) 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.

[COMMENT: If the missing part had been incorporated by reference only after the international search report had already been established by the International Searching Authority, a corrected version of that report would have to be issued; this could be clarified in the PCT International Search and Preliminary Examination Guidelines.]

16.2 [No Change]

Rule 20

International Filing Date

20.1 to 20.4 [No Change]

20.5 *Missing Parts*

(a) Where, in determining whether the papers purporting to be an international application fulfill the requirements of Article 11(1), the receiving Office finds that a part of the description, claims or drawings is or appears to be missing, including:

(i) the case where all or part of the description, claims or drawings are or appear to have been erroneously included in the international application; or

(ii) the case where all of the drawings are or appear to be missing;

but not including the case where an entire element referred to in Article 11(1)(iii)(d) or (e) is or appears to be missing, it shall promptly invite the applicant, at the applicant's option:

(iii)(i) to complete the purported international application by furnishing the missing part; or

(iv)(ii) to confirm, in accordance with Rule 20.6(a), that the part was incorporated by reference under Rule 4.18;

and to make observations, if any, within the applicable time limit under Rule 20.7. If that time limit expires after the expiration of 12 months from the filing date of any application whose priority is claimed, the receiving Office shall call that circumstance to the attention of the applicant.

[Rule 20.5, continued]

(b) [No change] Where, following an invitation under paragraph (a) or otherwise, the applicant furnishes to the receiving Office, on or before the date on which all of the requirements of Article 11(1) are fulfilled but within the applicable time limit under Rule 20.7, a missing part referred to in paragraph (a) so as to complete the international application, that part shall be included in the application and the receiving Office shall accord as the international filing date the date on which all of the requirements of Article 11(1) are fulfilled and proceed as provided in Rule 20.2(b) and (c).

(c) [No change] Where, following an invitation under paragraph (a) or otherwise, the applicant furnishes to the receiving Office, after the date on which all of the requirements of Article 11(1) were fulfilled but within the applicable time limit under Rule 20.7, a missing part referred to in paragraph (a) so as to complete the international application, that part shall be included in the application, and the receiving Office shall correct the international filing date to the date on which the receiving Office received that part, notify the applicant accordingly and proceed as provided for in the Administrative Instructions.

(d) [No change] Where, following an invitation under paragraph (a) or otherwise, a part referred to in paragraph (a) is, under Rule 20.6(b), considered to have been contained in the purported international application on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, the receiving Office shall accord as the international filing date the date on which all of the requirements of Article 11(1) are fulfilled and proceed as provided in Rule 20.2(b) and (c).

[Rule 20.5, continued]

(e) [No change] Where the international filing date has been corrected under paragraph (c), the applicant may, in a notice submitted to the receiving Office within one month from the date of the notification under paragraph (c), request that the missing part concerned be disregarded, in which case the missing part shall be considered not to have been furnished and the correction of the international filing date under that paragraph shall be considered not to have been made, and the receiving Office shall proceed as provided for in the Administrative Instructions.

20.6 and 20.7 *[No change]*

20.8 *Incompatibility with National Laws*

(a) If, on October 5, 2005, any of Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(iv)(~~ii~~) and (d), and 20.6 are not compatible with the national law applied by the receiving Office, the Rules concerned shall not apply to an international application filed with that receiving Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.

(a-bis) [No change] Where a missing element or part cannot be incorporated by reference in the international application under Rules 4.18 and 20.6 because of the operation of paragraph (a) of this Rule, the receiving Office shall proceed as provided for in Rule 20.3(b)(i), 20.5(b) or 20.5(c), as the case may be. Where the receiving Office proceeds as provided for in Rule 20.5(c), the applicant may proceed as provided for in Rule 20.5(e).

[Rule 20.8, continued]

(b) If, on October 5, 2005, any of Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(iv)(ii) and (d), and 20.6 are not compatible with the national law applied by the designated Office, the Rules concerned shall not apply in respect of that Office in relation to an international application in respect of which the acts referred to in Article 22 have been performed before that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.

(c) [No change] Where an element or part is considered to have been incorporated by reference in the international application by virtue of a finding of the receiving Office under Rule 20.6(b), but that incorporation by reference does not apply to the international application for the purposes of the procedure before a designated Office because of the operation of paragraph (b) of this Rule, the designated Office may treat the application as if the international filing date had been accorded under Rule 20.3(b)(i) or 20.5(b), or corrected under Rule 20.5(c), as the case may be, provided that Rule 82~~ter~~.1(c) and (d) shall apply *mutatis mutandis*.

(d) If, on [DATE OF ADOPTION OF RULE CHANGE BY PCT ASSEMBLY], Rule 20.5(a)(i) is not compatible with the national law applied by the designated Office, that Rule shall not apply in respect of that Office in relation to an international application in respect of which the acts referred to in Article 22 have been performed before that Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [DATE (6 MONTHS AFTER ADOPTION OF RULE CHANGE BY PCT ASSEMBLY)]. The information received shall be promptly published by the International Bureau in the Gazette.

[Rule 20.8, continued]

(e) Where a part is considered to have been incorporated by reference in the international application by virtue of a finding of the receiving Office under Rule 20.6(b), but that incorporation by reference does not apply to the international application for the purposes of the procedure before a designated Office because of the operation of paragraph (d) of this Rule, the designated Office may treat the application as if the international filing date had been accorded under Rule 20.3(b)(i) or 20.5(b), or corrected under Rule 20.5(c), as the case may be, provided that Rule 82~~ter~~.1(c) and (d) shall apply *mutatis mutandis*.

[End of Annex and of document]