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# Workshop on Erroneously-Filed Elements and Parts

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# The Problem (1)

- Different interpretation by ROs and DOs of Rules 4.18, 20.5 and 20.6
- Resulting in different practices where:
  - applicant files complete application, but with wrong description and/or wrong set of claims
  - applicant requests incorporation by reference of “correct” description and/or “correct” set of claims as contained in priority application as a “*missing part*”
  - in order to amend application (at a later stage) by replacing wrongly filed description and/or claims with equivalent “correct” versions as contained in the priority application

# The Problem (2)

- Some Offices: practice not permissible
  - by definition, term “missing” requires that some part of the description or the claims was missing but other parts of those elements had been filed
  - incorporation by reference of a “missing part” requires that “missing part” which is to be incorporated indeed “completes” an incomplete element rather than replacing it completely

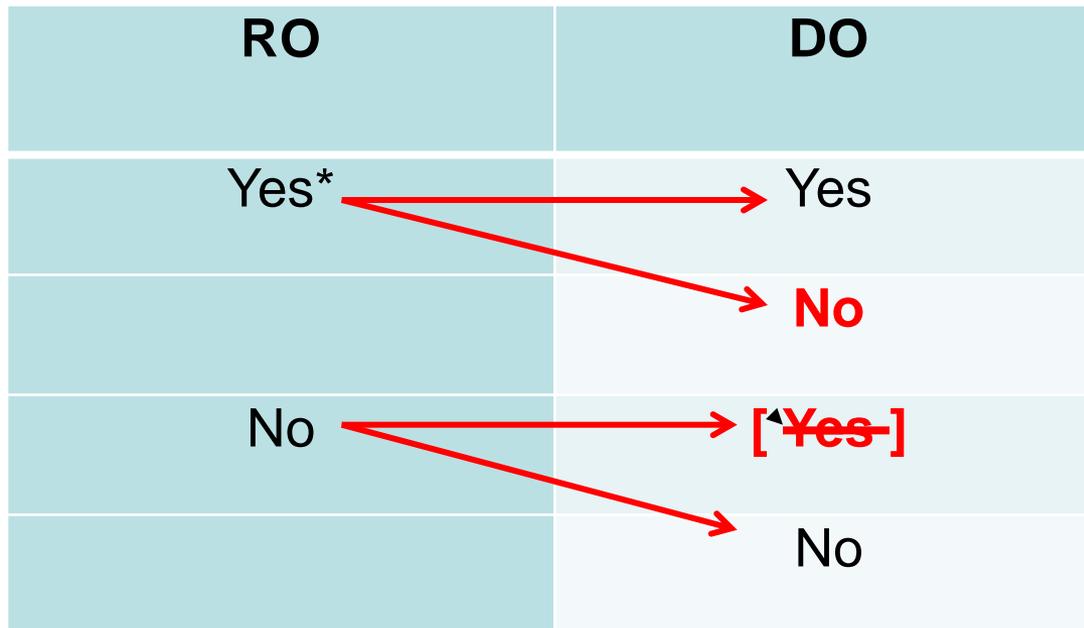
# The Problem (3)

- Other Offices: practice permissible
  - if not: applicant who did not include any claim(s) and/or any description would be better off (incorporation of missing *element*) than applicant who attempted to file description or claims but who, by mistake, files the wrong claims and/or wrong description
  - applicant would thus be penalized for attempting to file a complete IA (albeit with wrong claims and/or wrong description)

# The Problem (4)

- Different practices by Offices in capacity as both ROs and DOs

RO	DO
Yes*	Yes
	No
No	[^Yes-]
	No



\* Including RO/IB

# History (1)

- Incorporation by reference of missing elements and parts possible under the PCT since April 1, 2007
- PCT/WG/1 (2008):
  - “The Working Group noted ... that it appeared to be possible ... for part or all of the description, or part or all of the claims, contained in the priority application to be incorporated ... as a *missing part*.”
  - RO Guidelines were modified to clarify that, where incorporation resulted in a duplicated set of description, claims or drawings, the set incorporated was to be placed sequentially before the originally filed set

## History (2)

- This notwithstanding: different Office practices (and case law) evolved with regard to incorporation of “correct” elements or parts as “missing parts”
- Issue first brought up by EPO in 2013 in PCT/MIA/20 and PCT/WG/6
  - “modify RO Guidelines to clarify that practice is not permissible”
  - no consensus
- PCT/WG/7: responses to questionnaire
  - one third in favor, two-thirds against practice; many undecided

# History (3)

- PCT/WG/8: continued divergence of views
  - Chair: not fundamentally inappropriate to offer opportunity to applicant to correct mistake, but not under present “missing parts” provisions
  - allow applicant, in very limited and exceptional cases, to replace the wrongly filed claims and/or description of IA as filed with the equivalent “correct” version contained in the priority application

# History (4)

## ■ PCT/WG/9: new proposal

- proposed new Rule 20.5*bis*: opportunity for the applicant to correct IA
  - removal from the application of any erroneously filed element or part
  - incorporation by reference of equivalent correct element or part as contained in priority application
  - “erroneously”: sufficient if applicant did not intend to file element or part in question
  - entire process to be completed prior to publication
- clarify that existing Rule 20.5 does not cover incorporation of “correct” elements or part
- still no consensus
  - support / sympathy for aim but concerns about possible abuse
  - EPO: serious concerns about compatibility of proposal with PLT

# History (5)

- PCT/WG/10: assessment of PLT related issues
  - PLT does not govern PCT filing date related requirements
  - still concern: widening of gap between PCT and PLT filing date requirements if not possible for (or desired by) PCT Member State which is also PLT Contracting Party to align its national or regional law in respect of national or regional applications filed with or for that State
  - conclusion: no clear cut answer, all depends on interpretation of the PLT (exclusive competency of PLT Contracting Parties)

# History (6)

- German saying: “Wenn man nicht mehr weiter weiß – gründet man 'nen Arbeitskreis“ (if you don't know what to do – form a working group)!
  - WG requested the IB to convene a workshop
- Developments since PCT/WG/10:
  - new proposal by the EPO (document PCT/WG/11/21)

# Statistics

## ■ Incorporation by reference cases: 12-month sample

RO	Number of cases
AT	2
AU	3
CA	6
CN	56
DK	1
EP	59
ES	6
FR	9
GB	5
IB	18
IL	3
JP	1
NL	2
RU	3
SE	2
SG	1
US	55
<b>Grand Total</b>	<b>232</b>

(by RO, all incorporation by reference cases, not only erroneously filed elements or parts)

# Workshop

- Main considerations by Secretariat:
  - avoid repetition of well known Member States' positions
  - instead: focus on views of users
- Address issues such as:
  - scale of problem/experience with current divergent practices of ROs and DOs?
  - what would be the elements of a fair system from applicant and third party perspective?
  - could the underlying problem be solved by other means?

Thank You!