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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PATENT COOPERATION TREATY (PCT)

Sixteenth Session
Seoul, March 16 to 18, 2009

PCT RECEIVING OFFICE GUIDELINES:
MISSING PARTS IN THE INTERNATIONAL APPLICATION

Proposal by the European Patent Office

BACKGROUND

1. At its first session held in Geneva from May 26 to 30, 2008, the PCT Working Group:

“agreed that the PCT Receiving Office Guidelines should be modified to clarify the procedures to be followed under Rules 4.18 and 20.6 in the circumstances outlined in paragraphs 125 and 126 (...). Where incorporation by reference resulted in a duplicated set of descriptions, claims or drawings, the set incorporated by reference should be placed sequentially before the originally filed set”

(see paragraph 127 of the report, document PCT/WG/1/16). On this basis, the International Bureau consulted the competent PCT Authorities on a new set of PCT Receiving Office Guidelines relating to the incorporation by reference of missing parts and elements (see Circular C. PCT 1157 dated December 19, 2008).

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2. The European Patent Office (EPO) has some concerns with respect to two new paragraphs, namely draft paragraphs 205 E and F, and wishes to take the opportunity of the Meeting of International Authorities under the PCT (PCT/MIA) to exchange views with other International Searching and Preliminary Examining Authorities on the practice relating to missing parts.

DRAFT PARAGRAPH 205E OF RO GUIDELINES

3. In Circular C. PCT 1157, the International Bureau proposed the following draft paragraph 205E:

“Sheets Submitted under Rule 20.6(a)(i) which contain additional matter

“205E. Where the applicant timely confirms the incorporation by reference of missing elements or parts and furnishes a sheet or sheets containing such missing elements or parts, but such sheets contain additional matter which (1) the applicant does not wish to be incorporated by reference, and/or (2) which are not contained in the earlier application and therefore cannot be incorporated by reference, the receiving Office may invite the applicant to re-submit the sheet(s) from which the said additional matter has been removed. Depending on the case, the receiving Office may alternatively correct such additional matter by deleting ex officio the said additional matter. The general manner of making ex officio corrections by the receiving Office is provided in paragraphs 161 to 163. Where there is more than one possibility of correcting the additional matter, the receiving Office should contact the applicant by telephone and/or in writing to clarify the applicant’s intention before making any ex officio correction.”

4. The EPO as receiving Office interprets the “completely contained” criteria under Rule 20.6 PCT as excluding any difference between the submitted sheets and the corresponding sheets in the priority application. Such differences may not only be additional matter, but also omissions. The EPO has found that differences occur in particular in references to claims and drawings, where these are not identical in the priority application. When the submitted sheets under Rule 20.6(a)(i) PCT differ from the priority document, the EPO informally informs the applicant that he should resubmit the sheets still within the applicable time limit as otherwise the incorporation by reference will be refused. We generally do not make any ex officio corrections in the case of sheets incorporated by reference. We inform the applicant that he may amend the application later during the processing of the application under other provisions or request a correction under Rule 91 PCT. We wish to continue with this practice so that the provisions on incorporation by reference be used only in exceptional circumstances. In addition, we have serious concerns with the use of the missing parts provisions where the parts subsequently filed are unrelated with those originally filed.

5. The EPO’s practice is based on the following two assumptions : (1) the missing parts provisions are a safety net procedure which should be strictly applied by both the receiving Office (so as to limit its burden in terms of formalities processing) and the applicant (who should not use it a means to actually amend the application); (2) it may not be required from RO formalities officers to judge whether the changes are substantive or not. The “completely contained” criterion was not further defined in the PCT Regulations to let Offices develop their own practice in the matter. We recognise that our practice might not be shared by other Offices and that a common practice might not yet emerge. Until this happens, we are of the opinion that the RO Guidelines should be flexible enough to accommodate all different practices in line with the PCT provisions.

6. The EPO therefore suggests to modify the RO Guidelines as follows :

“Sheets submitted under Rule 20.6(a)(i) which ~~contain additional matter~~ differ from the earlier application

“205E. Where the applicant timely confirms the incorporation by reference of missing elements or parts and furnishes a sheet or sheets containing such missing elements or parts, but such sheets contain **additional** matter which ~~(1) the applicant does not wish to be incorporated by reference, and/or (2) which are not contained in~~ differ from the contents of the earlier application and therefore cannot be incorporated by reference, the receiving Office may **invite** informally inform the applicant ~~to that he should~~ re-submit the sheet(s) ~~from which the said additional matter has been removed~~ the contents of which correspond with the earlier application within the applicable time limit under Rule 20.7(a) PCT; otherwise the receiving Office proceeds under Rule 20.6(c) PCT. ~~Depending~~ According to its own practice, and depending on the case, the receiving Office may alternatively correct ~~such additional matter by deleting the sheets~~ ex officio the said additional matter with a view to bring them into conformity with the earlier application. The general manner of making ex officio corrections by the receiving Office is provided in paragraphs 161 to 163. Where there is more than one possibility of correcting the **additional matter** defect, the receiving Office should contact the applicant by telephone and/or in writing to clarify the applicant’s intention before making any ex officio correction.”

DRAFT PARAGRAPH 205F RO GUIDELINES (AS PROPOSED BY THE INTERNATIONAL BUREAU)

7. In Circular C. PCT 1157, the International Bureau proposed the following draft paragraph 205F:

“Incorporation by reference cannot replace elements/parts of the international application originally submitted

“205F. Where the applicant timely confirms incorporation by reference of missing elements or parts, and furnishes sheets under Rule 20.6(a)(i) which contain the description, claims and/or drawings from the earlier application, and requests that they replace the description, claims and/or drawings of the international application, the receiving Office may not perform such substitution; the description, claims or drawings from the earlier application, which are to be incorporated by reference, cannot replace the description, claims or drawings of the international application as filed. In this situation, the parts to be incorporated by reference (Rule 20.5) should be combined with the elements of the international application originally submitted and should also be checked for compliance with the physical requirements referred to in Rule 11 to the extent that compliance is necessary for the purpose of reasonably uniform international publication (Rule 26.3(b)(ii)), including image scanning and OCR by the International Bureau. The receiving Office should invite the applicant to renumber any paragraphs, pages, claim numbers and drawing numbers so that the pages of the combined international application are placed in an order such that the sheets incorporated by reference are placed first sequentially followed by the pages which were originally filed such as in the following example:

- (a) Description incorporated from earlier application
- (b) Description as originally filed
- (c) Claims incorporated from earlier application
- (d) Claims as originally filed
- (e) Drawings incorporated from earlier application
- (f) Drawings as originally filed

“The receiving Office should note that the abstract is not covered by incorporation by reference under Rule 20 (see Rule 38.3 for the possibility of the applicant to request modification of the abstract by the International Searching Authority).”

8. Apart from having (still) some reservations with respect to the acceptance of “replacing parts” under the missing parts provisions under the PCT, the EPO has serious reservations with placing sequentially each of the subsequently filed elements before the originally filed elements. We note that the PCT Working Group agreed on the word “set” in paragraph 127 of the report, thereby letting the matter open as to whether all “replacing parts” had to be placed first in the application body.

9. First, with the IB proposal, the application as published would look awkward. This practice is adverse to the goal of simplification and transparency of the PCT.

10. Most importantly from an ISA point of view, the whole search copy is theoretically to be searched. Furthermore, having all elements subsequently and originally filed mixed in the same application body complicates the processing of the application at both procedural and searching level. We therefore suggest to have the originally filed elements presented separately, under another header which would indicate that this separate part of the application is not be searched by the ISA.

11. The Meeting is invited to comment on the proposals raised in this document.

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