

## Patent Cooperation Treaty (PCT) Working Group

**Ninth Session**  
**Geneva, May 17 to 20, 2016**

### CORRECTION OF THE INTERNATIONAL APPLICATION IN CASE OF “ERRONEOUSLY” FILED ELEMENTS AND PARTS

*Document prepared by the International Bureau*

#### **SUMMARY**

1. The present document sets out a proposal, as requested by the Working Group, to amend the Regulations so as to provide for the opportunity for the applicant to replace an erroneously filed “element” of the international application (description, claims or drawings), or any erroneously filed part thereof, with the equivalent “correct” version of the element or part concerned.

#### **BACKGROUND**

2. At its eighth session, held in Geneva in June 2015, the Working Group continued its discussions on 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 document PCT/WG/8/4 and paragraphs 112 to 123 of the Summary by the Chair of the session, document PCT/WG/8/25).

3. 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.

4. Broadly speaking, one group of Member States takes the view that, in such a situation, the applicant should be entitled to correct his mistake by way of incorporation by reference of a “missing part”. 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.

5. Other Offices take the view that, under the present Regulations, such practice was not permissible. These Offices argue that, by definition, the term “missing part” of the claims *element* or of the description *element* indicated 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.

6. Given the continued divergence of views, all that Member States were able to agree at the eighth session was to better document the different approaches in the Receiving Office Guidelines to raise awareness among applicants about the different approaches taken by Offices. The Working Group thus (paragraph 123 of document PCT/WG/8/25):

“... requested the International Bureau, pending the ongoing discussions of the issues at hand in the Working Group, to prepare and consult on modifications to the Receiving Office Guidelines aimed at clarifying the continued divergent practices of Offices, and to continue to raise awareness among the applicant community on the consequences of the continued divergent practices of Offices.”

A PCT Circular on this subject is expected to issue in the coming weeks.

7. On the other hand, at the eighth session of the Working Group, it was noted that no Office had explicitly stated that it considered it to be fundamentally inappropriate to offer an opportunity to the applicant to correct a mistake, merely that it was considered by many to fall outside the scope of what the present “missing parts” provisions as set out in the Regulations were designed to achieve. The Chair noted that it would appear strange to him that the Regulations allowed the applicant to validly file certain documents in “force majeure” circumstances after a time limit had expired without filing anything at all within the relevant time limit, but that they did not allow the applicant to correct the mistake of having filed a wrong set of claims and/or a wrong description. To that extent, the Working Group (paragraph 122 of document PCT/WG/8/25):

“requested the International Bureau to prepare, for discussion at its next session, a working document containing a draft of a new provision which would allow the applicant, in very limited and exceptional cases, to replace the wrongly filed claims and/or description of the international application as filed with the equivalent “correct” version of the claims and/or description contained in the priority application.”

## PROPOSAL

8. Annex I to the present document sets out a proposal, as requested by the Working Group, to amend the Regulations so as to provide for the opportunity for the applicant to correct an international application where the applicant had erroneously filed the wrong description, claims or drawings, or any part thereof.

9. Firstly, it is proposed to amend Rule 20.5(a) so as to clarify that the existing “missing parts” provisions set out in Rule 20.5 are intended to only cover the case that a part of the description, claims or drawings is “truly” missing from the international application but do not cover the case that an entire element or part of the international application has been erroneously filed.

10. Secondly, it is proposed to add a new Rule—proposed new Rule 20.5*bis*—under which the applicant could request the removal of any erroneously filed element (description, claims or drawings) from the international application, or the removal of any erroneously filed part thereof, and confirm the incorporation by reference of the equivalent correct element or part as contained in an earlier application the priority of which is claimed in the international application.

11. Under proposed new Rule 20.5*bis*, if the correct element or part is considered to have been validly incorporated by reference in the (purported) international application “on the date on which one or more elements referred to in Article 11(1)(iii) were first received” (see Rule 20.6(b)), the receiving Office would remove from the application the erroneously filed element or part and accord as the international filing date “the date on which all of the requirements of Article 11(1) are fulfilled”. Thus, for example, if all Article 11(1) requirements had been fulfilled on the date on which the application containing the erroneously filed element or part had been received, the application would proceed on the basis of the original filing date accorded to the application containing the erroneously filed element or part, but that erroneously filed element or part would be removed and replaced by the correct element or part validly incorporated by reference.

12. If, on the other hand, the correct element or part is *not* considered to have been validly incorporated by reference in the (purported) international application, for example, because the requirements under Rules 4.18 and 20.6(a) for a valid confirmation of the incorporation by reference of the “correct” element or part had not been complied with, the receiving Office would simply treat the international application as if the request by the applicant to remove the erroneously filed element or part had not been made and the international application would proceed “un-corrected”, that is, the erroneously filed element or part would remain in the international application.

13. Under the proposal, for an element or part to be considered to have been “erroneously filed”, it would be sufficient if the applicant simply did not intend to file the element or part in question. It is not intended to imply that the receiving Office should be looking into the question and decide on whether the element had indeed been erroneously filed, for example, because the claims did not make any sense in relation to the description as contained in the application as filed.

14. As under Rule 20.5, in accordance with Rule 20.7 as proposed to be amended, any request to “correct” a (purported) international application under Rule 20.5*bis* would need to be made within 2 months from the date of an invitation by the receiving Office or, where no such invitation was sent, within two months from the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office. This time limit would mean that there should be no cause for third party concerns – the entire process would be complete before international publication takes place; the result would generally be more clear than under the current “missing part” practice by some Offices, where there may be room for doubt

either as to the validity of the incorporation, or else as to which matter will be retained in cases where the incorporation has introduced additional matter (a second description; an additional set of claims) rather than simple missing pages.

15. The receiving Office would promptly notify the International Bureau and International Searching Authority of the replacement or, in cases where the replacement could not be approved immediately, of the request for replacement. In combination with the strict time limit, in most cases this would mean that the International Searching Authority would become aware of at least the fact that a “correction” had been requested before beginning an international search which may turn out to be of no value. Nevertheless, the Working Group may wish to consider whether the Rule should include an option for the International Searching Authority to charge an additional fee if the request for a “correction” under proposed new Rule 20.5bis is notified to the Authority after it has begun to draw up the international search report.

16. Annex II sets out an overview of the current approach with regard to “missing element and parts” under the present Regulations and the possible future approach with regard to “truly missing elements and parts” and “erroneously filed elements and parts” under the Regulations as proposed to be amended.

#### **CONSIDERATION BY THE WORKING GROUP**

17. It is recommended that the Working Group, before looking at detailed drafting issues, consider first whether there is consensus that this new approach would be desirable from a policy perspective, taking into account issues such as the service provided to applicants, the processing required by Offices, reasonable expectations of third parties and the relationship to other existing remedies available to the applicant to “change” the application in case of “mistakes” having been made at the time of filing, such as the rectification of obvious mistakes under Rule 91.

18. Moreover, Member States may wish to comment on whether it would be likely that such a new approach would be recognized under applicable current national laws or with amendments to such national laws which could reasonably be expected to be made within a relatively short period of time, or whether Offices, in their capacity as receiving Offices and/or designated Offices, would likely be required to notify the International Bureau of the incompatibility of the new provision with the applicable national law and thus not apply that new provision. If indeed many Offices were to submit such notification of incompatibility, applicants would, of course, not be any better off than at present, with different Offices, in their capacities as both receiving Offices and designated Offices, continuing to apply different “incorporation by reference” practices.

*19. The Working Group is invited to comment on the proposed amendments to the PCT Regulations set out in the Annex to this document.*

[Annexes follow]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS<sup>1</sup>

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<sup>1</sup> Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

**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 the case where all of the drawings are or appear to be missing but not including the case:

- (i) where an entire element referred to in Article 11(1)(iii)(d) or (e) is or appears to be missing or has or appears to have been erroneously filed; and
- (ii) where a part of the description, claims or drawings has or appears to have been erroneously filed;

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.

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

20.5bis *Erroneously Filed Elements and 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 the description, claims or drawings have or appear to have been erroneously filed, or that a part of the description, claims or drawings has or appears to have been erroneously filed ("erroneously filed element or part"), and where the requirements of Rule 4.18 have been complied with, it shall promptly invite the applicant to request the receiving Office, within the applicable time limit under Rule 20.7:

- (i) to remove any erroneously filed element or part from the application;
- (ii) to confirm, in accordance with Rule 20.6(a), that the correct element or part was incorporated by reference under Rule 4.18; and
- (iii) to make observations, if any.

*[Rule 20.5bis, continued]*

(b) Where, following an invitation under paragraph (a) or otherwise, the applicant requests the receiving Office to remove an erroneously filed element or part from the application and the correct element or part 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 remove any such erroneously filed element or part from the application, 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) Any request under paragraph (b) to remove an erroneously filed part from the application shall be accompanied by an indication as to where that part is contained in the application.

(d) Where, following an invitation under paragraph (a) or otherwise, the applicant requests the receiving Office to remove any erroneously filed element or part from the application but the correct element or part is not, under Rule 20.6(c), considered to have been contained in the 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 treat the international application as if the request to remove the erroneously filed element or part had not been made.

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

(a) *[No change]* The applicant may submit to the receiving Office, within the applicable time limit under Rule 20.7, a written notice confirming that an element or part is incorporated by reference in the international application under Rule 4.18, accompanied by:

(i) a sheet or sheets embodying the entire element as contained in the earlier application or embodying the part concerned;

(ii) where the applicant has not already complied with Rule 17.1(a), (b) or (b-bis) in relation to the priority document, a copy of the earlier application as filed;

(iii) where the earlier application is not in the language in which the international application is filed, a translation of the earlier application into that language or, where a translation of the international application is required under Rule 12.3(a) or 12.4(a), a translation of the earlier application into both the language in which the international application is filed and the language of that translation; and

*[Rule 20.6, continued]*

(iv) in the case of a part of the description, claims or drawings, an indication as to where that part is contained in the earlier application and, where applicable, in any translation referred to in item (iii).

(b) *[No change]* Where the receiving Office finds that the requirements of Rule 4.18 and paragraph (a) have been complied with and that the element or part referred to in paragraph (a) is completely contained in the earlier application concerned, that element or part shall be 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.

(c) Where the receiving Office finds that a requirement under Rule 4.18 or paragraph (a) has not been complied with or that the element or part referred to in paragraph (a) is not completely contained in the earlier application concerned, the receiving Office shall proceed as provided for in Rule 20.3(b)(i), 20.5(b), ~~or 20.5(c)~~, or 20.5bis(d), as the case may be.

*20.7 Time Limit*

(a) The applicable time limit referred to in Rules 20.3(a) and (b), 20.4, 20.5(a), (b) and (c), 20.5bis(a), and 20.6(a) shall be:

(i) where an invitation under Rule 20.3(a), ~~or 20.5(a)~~ or 20.5bis(a), as applicable, was sent to the applicant, two months from the date of the invitation;

(ii) where no such invitation was sent to the applicant, two months from the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office.

(b) *[No change]*

*20.8 Incompatibility with National Laws*

(a) If, on [DATE] October 5, 2005, any of Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), 20.5bis 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 [DATE] April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.



[Rule 20.8, continued]

(a-*bis*) Where a missing element or part or [a correct 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), [20.5bis\(d\)](#), 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).

(b) If, on [\[DATE\] October 5, 2005](#), any of Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), [20.5bis](#), 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 [\[DATE\] April 5, 2006](#). The information received shall be promptly published by the International Bureau in the Gazette.

(c) 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:

[\(i\) in the case of the incorporation by reference of an element or part under Rules 20.3 or 20.5](#), 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*;

[\(ii\) in the case of the incorporation by reference of an element or part under Rule 20.5bis, as if the request by the applicant under Rule 20.5bis\(b\) to remove an erroneously filed element or part had not been made.](#)

[Annex II follows]

	Issue	Today	Future
1.	No description (element) No claim (element)	<b><u>ADD missing element</u> (by furnishing the missing description or claim(s) or by incorporation by reference of the missing description or claim(s))</b> <ul style="list-style-type: none"> <li>No international filing date accorded</li> <li>Later furnishing or incorporation by reference of entire element possible, allowing international filing date to be accorded</li> </ul>	<u>No change</u>
2.	No drawing (element)	<b><u>ADD missing element</u> (by furnishing the missing drawings or by incorporation by reference of the missing drawings)</b> <ul style="list-style-type: none"> <li>International filing date accorded</li> <li>Later furnishing (possible impact on filing date) or incorporation by reference (no impact on filing date) of all missing drawings possible – technically, a special case of missing parts, as below;</li> </ul>	<u>No change</u>
3.	(Truly) Missing part of description (Truly) Missing part of claim(s) (Truly) Missing part of drawings	<b><u>COMPLETE an element</u> (by furnishing the missing part or by incorporation by reference of the missing part)</b> <ul style="list-style-type: none"> <li>International filing date accorded</li> <li>Later furnishing (possible impact on filing date) or incorporation by reference (no impact on filing date) possible of missing part of description and of missing part of claims and of one or more missing drawings</li> </ul>	<u>No change for truly “missing” parts</u> <ul style="list-style-type: none"> <li>clarification that the “missing part” provisions do <i>not</i> cover the case that an entire element (description, claim(s) or drawing(s)) is or appear to have been erroneously filed, and do not cover the case that a part of the description, claims or drawings has or appears to have been erroneously filed</li> </ul>
4.	Erroneously filed entire description (element) Erroneously filed entire claim(s) (element) Erroneously filed entire drawing(s) (element)	<b>[Certain Offices]</b> <b><u>ADD additional version of element</u> (by incorporation by reference of the missing element as a “missing part”)</b> <ul style="list-style-type: none"> <li>Incorporation by reference (no impact on filing date) possible of correct entire description, claims or drawings as “missing parts”</li> <li>Erroneously filed entire description, claims or drawings remain in the application – cannot be replaced and may be used as basis for an international search which will be of no relevance to the international application once amended for the national phase</li> </ul> <b>[Other Offices]</b> <ul style="list-style-type: none"> <li>No possibility for addition of additional version of element by incorporation by reference</li> </ul>	<u>New “Correction of Erroneously Filed Element” Provision</u> <b><u>REPLACE an element</u> (by way of incorporation by reference of the correct element and removal of the erroneously filed element)</b> <ul style="list-style-type: none"> <li>Replacement of erroneously filed entire element (description, claim(s) or drawing(s)) by correct element (description, claim(s) or drawing(s)) as contained in priority application</li> <li>Erroneously filed element can be viewed on file, but is not treated as part of the international application to be processed (similar to rectified “obvious mistake”)</li> <li>Clarification that “the “missing part” provisions do <i>not</i> cover the case that an entire element (description, claim(s) or drawing(s)) is or appear to have been erroneously filed (see above)</li> </ul>
5.	Erroneously filed part of description Erroneously filed part of claim or claim(s) Erroneously filed part of drawing(s)	<b>[Certain Offices]</b> <b><u>ADD correct part of description, claims or drawings</u> (by incorporation by reference of a “missing part”, leaving erroneous filed part in the international application)</b> <ul style="list-style-type: none"> <li>Incorporation by reference (no impact on filing date) possible of correct part of description, claims or drawings as “missing parts”</li> <li>Erroneously filed part of the description, claims or drawings remains in the application – potentially confusing, but will not usually result in international search which is of no relevance to the international application once amended for the national phase</li> </ul> <b>[Other Offices]</b> <ul style="list-style-type: none"> <li>No possibility for addition of additional version of part of description, claims or drawings by incorporation by reference of a “missing part”</li> </ul>	<u>New “Correction of Erroneously Filed Part” Provision</u> <b><u>REPLACE a part of the description, claims or drawings</u> (by way of incorporation by reference of the correct part and removal of the erroneously filed part)</b> <ul style="list-style-type: none"> <li>Replacement of erroneously filed part of the description, claim(s) or drawing(s) by the correct part as contained in priority application</li> <li>Erroneously filed part can be viewed on file, but is not treated as part of the international application to be processed (similar to rectified “obvious mistake”)</li> </ul> Clarification that “the “missing part” provisions do <i>not</i> cover the case that a part of the description, claim(s) or drawing(s)) is or appear to have been erroneously filed (see above)