

2018 PCT WG WORKSHOP

**REVIEW ON NEW MATTERS
UNDER 20.5 & 20.5BIS**

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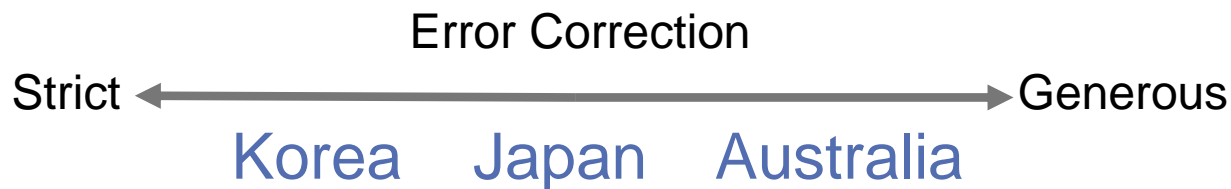
ASIAN PATENT ATTORNEY ASSOCIATION

Overview of APAA

- ✓ Since 1969
- ✓ 2400 members from 20 Recognized Groups
- ✓ 6 Standing Committees including
Patent Committee
- ✓ <http://www.apaaonline.org/>

Attitude on Human Mistakes

- ✓ Stability vs. Flexibility
- ✓ In Korea, stability is more emphasized than flexibility for procedural laws.
- ✓ In Australia, Generous on errors if they are bona fide



KR Group Perspective

- ✓ Korean Patent Act has very strict standard on filing date and new matter.
- ✓ Not adopted 20.5 and 20.6 yet.
- ✓ Users are not familiar with Missing Part System.

JP Group Perspective

- ✓ Adopted both of PCT missing part system and PLT erroneous part system.
- ✓ Applying the missing part rules on PCT applications, while applying the erroneous part rules of PLT on Paris Convention applications.
- ✓ When applying erroneous part rules, it is **possible to add a part but not possible to delete a part** without changing the application date.

AU Group Perspective

- ✓ With respect to error correction, AU national Act is generous even more than PLT.
- ✓ Limited time for corrections can be extended.
- ✓ Strict as RO but Generous as DO

Questions

- ✓ What is “Missing” or “Erroneously filed”?
- ✓ To what extent is the incorporation by reference possible for missing part or erroneous part?
- ✓ Detailed examples?

Example 1: Missing Part

- ✓ Incorporation by Replacing as a Whole

Priority Documents : $A(a,b,c)$

Intended PCT Filing : $A(a,b,c)+B$

Actual PCT Filing : $A(a,b)+B$

Proper Submission : $A(a,b,c)$

Followed by $A(a,b)+B$

Insufficient Recovery of $A(a,b,c)+B$

Example 2: Missing Part

✓ Incorporation by Paragraph(s)

Priority Documents : $A(a,b,c)$

Intended PCT Filing : $A(a,b,c)+B$

Actual PCT Filing : $A(a,b)+B$

Proper Submission : $A(a,b,c)+B$

Incorporating Missing part 'c' indeed completed the invention A

Example 3: Missing Part

- ✓ Possible Abuse of Incorporation by Paragraph(s)

Priority Documents : A+B, A+C

Actual PCT Filing : A+B

Context of Missing Paragraph of C cites as:

“In addition to the above-disclosed device, it is also combine C into the device. ~~~”

Proper Submission : A+B, A+C

Possible Submission : A+B, A+B+C

New matter over Priority

Main Concern: New Matter

- ✓ Divergence of practice may bring **new matter issues by skillful and combined corrections, which are sometimes improper.**
- ✓ How do ROs find out new matters in a limited time frame without substantive examination???
- ✓ **Any Objective Guidelines from experienced ROs or DOs?**

Example 4: Erroneous Part

- ✓ Possible Abuse of Incorporation by Paragraph(s)

Priority Documents : A+B, A+C

Erroneous Filing : A+B, A+D

Context of Missing Paragraph of C cites as:

“In addition to the above-disclosed device, it is also combine C into the device. ~~~”

Proper Submission : A+B, A+C

Possible Submission : A+B, A+B+C

New matter over Priority

Main Concern: New Matter

- ✓ Combination of Partial removals and Partial incorporation by reference may bring new matter issues more and require more detailed Guidelines.
- ✓ One solution of the new matter is re-dating, but this is not allowable under the PCT system...

One Solution

Steps For Correcting	Means for Correcting
Adding	<ul style="list-style-type: none">- Incorporation by Reference- Proposed 20.5 for Missing part- 20.5bis (a) (ii) for Erroneous Part
Deleting	<ul style="list-style-type: none">- Article 19/34 Amendment- National Phase Amendment

THANK YOU

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