

ASSOCIATION INTERNATIONALE
POUR LA PROTECTION
DE LA PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL ASSOCIATION
FOR THE PROTECTION
OF INTELLECTUAL PROPERTY

INTERNATIONALE VEREINIGUNG
FÜR DEN SCHUTZ
DES GEISTIGEN EIGENTUMS



Workshop on Erroneously- Filed Elements and Parts

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About AIPPI

- Politically neutral, non-profit organization formed in 1897
- More than 9000 members representing more than 100 countries
- Aims to represent all user perspectives
- Focused on harmonization of IP laws
 - More than 700 resolutions have been passed to date

Disclaimer

- AIPPI does not have a formal position on this topic
- In response to the request from the Working Group, AIPPI convened a special meeting of its PCT Committee to elicit user perspectives
- The comments herein reflect only the views of the presenter and certain individual AIPPI members, not the view of AIPPI as a whole

Scale of Problem from the User Perspective

- Occurrence of the problem is rare
- When the problem does occur, the ramifications are significant
 - Potential loss of rights resulting from a clerical error
 - Possibility that electronic filing methods can increase the likelihood of making this error
- Lack of international consistency creates uncertainty
 - Different results in different jurisdictions on the same set of facts

User Experience with this Issue

- Extremely limited based on consultations to date
 - Study of user experience of entire membership may be useful
- Users are both applicants and “third parties” so share concern for appropriate balance of rights
- In general, “form over substance” rules that result in loss of rights from clerical errors, when the intent of the applicant is clear, do not constitute an appropriate balance of rights
- In general, objective standards are preferred
 - Difficulty with meeting sometimes uneven subjective standards

Case Example

- Application 1 and application 2 are related
 - Filed as priority applications on the same day
 - Overlapping disclosures but with some differences
 - Overlapping drawings but with some differences
- International application 1 and international application 2
 - Filed the same day, claiming priority
 - IA 1 is correct
 - IA 2 filed with specification from PA 2 but drawings from PA 1
 - Error “easier” to make when most of the drawings are the same (same thing is true for the disclosure)
 - In this example, the error is objectively clear from review of the PAs and the description of the drawings

Objectives from the User Perspective

- A clerical filing error, when what the applicant intended to file is clear, should not result in a loss of rights
 - The exact path is of less concern to the user, provided that there is a path of some kind
 - That path should be as uniform as possible across the Offices
- Certainty as of the international filing date must be maintained
 - Users share the concern to prevent late-filed, unsupported subject matter

Elements of a Fair System from the User Perspective

- Provides a clear path to avoid loss of rights
- Avoids “form over substance”
 - Whether an element is: 1) entirely “missing” or 2) an incorrect or incomplete version of that element should not be determinative of the substantive relief available
 - The procedures may differ
 - Amendment of the Rules to address these situations separately would add clarity and minimize divergence in interpretations
 - An ability to replace an erroneously-filed element (not actually “missing”) is viewed as preferable to add and later delete approach
 - Whether the application/request includes an incorporation by reference statement should not be determinative of the substantive relief available
 - Requirement does not add to certainty, but creates a “trap” for less experienced applicants

Elements of a Fair System from the User Perspective

- Protects predictability by providing a clear standard for correction of erroneous filing
 - Objective standards provide clarity and predictability for both applicants and third parties
 - If a subjective standard is employed, “unintentional” is considered a fair balance
- Protects predictability by limiting correction to pre-publication
- Fees or other measures to discourage use of these provisions would be reasonable

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Thank you for your attention

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