



ERRONEOUSLY FILED ELEMENTS OF INTERNATIONAL APPLICATION

FICPI perspective

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FICPI - INTERNATIONAL FEDERATION OF INTELLECTUAL PROPERTY ATTORNEYS

FICPI is unique, being the only international NGO whose membership consists exclusively of IP attorneys in private practice. FICPI thus represents an important constituency within the international IP system.

Some key facts:

- Founded over 100 years ago, in 1906, FICPI now has more than 5,000 members in more than 80 countries on six continents.
- Before being admitted, an applicant for membership of FICPI must satisfy prescribed criteria as to their character, experience and international reputation.
- FICPI members represent their clients in patent, trade mark and design matters, and related forms of IP, at the national, regional and international levels.
- Clients of FICPI members range from individuals and SMEs to multi-national industries, as well as universities, governmental and non-governmental organizations and other institutions, who are applicants and non-applicants alike.

ERRONEOUSLY FILED ELEMENTS OR PARTS THEREOF

In recent years FICPI has observed a global trend to make patent systems more and more user-friendly. The incorporation of provisions of the Patent Law Treaty (PLT) into the patent laws of many countries and regions has given many new approaches correcting mistakes and extending time limits with respect to formal aspects of the patenting procedure. We believe PCT is also subject to move in this direction, and the incorporation of provisions similar to those in the PLT into the PCT is an example of this.

ERRONEOUSLY FILED ELEMENTS OR PARTS THEREOF

FICPI believes that applicants should be permitted to correct very formal and obvious mistakes. This extends to the substitution of erroneously filed elements or parts thereof with the correct element or part as contained wholly in one or more priority application, provided that requirements of Rule 20 are met.

The increased use of ePCT which involves the uploading of documents stored on a computer increases the opportunity for incorrect documents to be uploaded. In this regard it is easy for an assistant to upload an incorrect document even when the responsible attorney has signed off on a particular specification to be used for the filing. Accordingly, the move to electronic filing systems such as ePCT has increased the need for such a remedial provision.

ERRONEOUSLY FILED ELEMENTS OR PARTS THEREOF

- Missing part = omitted by mistake
- Erroneously filed element = unintentionally filed

Missing part – usually a sheet of paper
accidentally missed when printing or copying

paper workflow – XX century

Erroneously filed element – usually an electronic file
accidentally (by mistake) uploaded when using
electronic filing system.

paperless (electronic) workflow - XXI century



ERRONEOUSLY FILED ELEMENTS OR PARTS THEREOF

In providing for this ability it will important to include some safeguards to avoid use of this option by applicants to exchange elements to intentionally gain advantages, for example with respect to third parties, but not to correct an actual mistake. To achieve this balance, we offer the following approach.

FICPI would welcome any amendment to the PCT Rules to introduce (or clarify) that an erroneous element or part thereof, filed together with the Request in a PCT application, can be replaced with the correct element or part thereof provided that the following conditions are met:

APPROACH OF FICPI - CONDITIONS

- At the time of filing the PCT application, in the Request or separately, the applicant has claimed priority to one or more earlier applications and also has made a statement of incorporation by reference, in respect of those earlier applications;
- The replacement of the erroneous element or part is made before the publication of the PCT application, within the time limits referred to in the Rule 20.7 (or a possible new rule);

APPROACH OF FICPI - CONDITIONS

- There should be a statement by the applicant explaining why a filed element or part thereof should be considered as erroneous, and possibly also a fee for processing the substitution;
- The particular element or part should be totally removed from the application with reference to Rule 9 PCT, or similar rule to cover removal or erroneous element or part thereof.

APPROACH OF FICPI - JUSTIFICATION

It is reasonable that a replacement (of an entire element or a part thereof) is allowed under these conditions, taking into account

- The possibility of extending the priority term from 12 month up to 14 month, after even more serious mistake by the applicant, namely a failure to file PCT application within the prescribed 12 month term,
- And that, under the Rule 2(5) PLT, the description and any drawings may be replaced when filing a national or national entry patent application (though it does not rule directly International phase of PCT applications)

APPROACH OF FICPI

FICPI does not put this proposal forward as an exhaustive solution to the problem, but considers it to be a good starting point for consideration.

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THANK YOU FOR ATTENTION

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