



Understanding Incorporation by Reference

WIPO PCT Webinar Series

Session 2

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Houston, we have a problem...



There is a page missing!!!

I filed the wrong drawings!!!

Poll questions

Some best practice tips to start

■ How to avoid:

- Clear and distinct file names
- Double-check everything before submitting; open all attachments
- Second person review

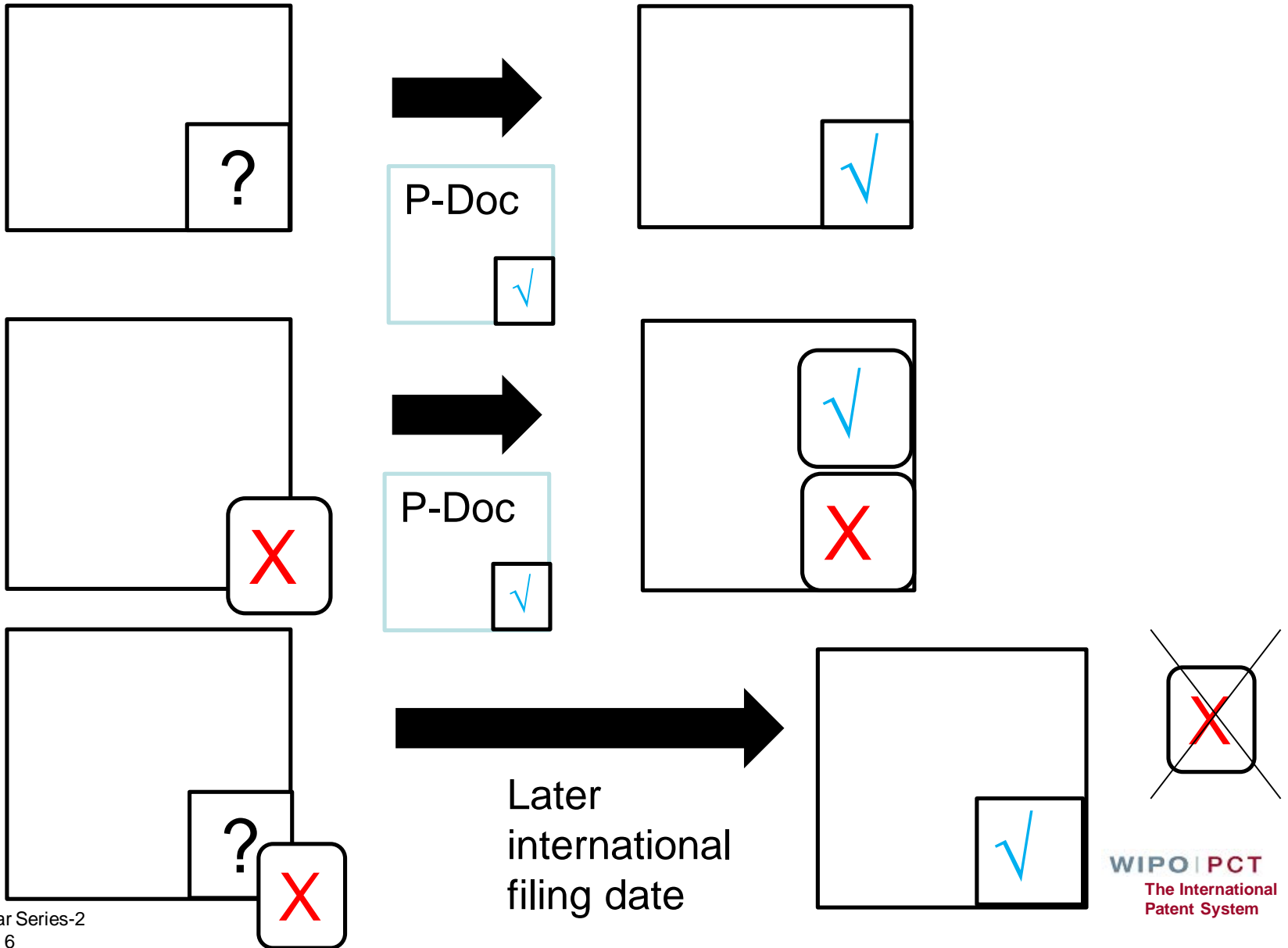
■ How to notice it:

- Online file inspection right after filing
- Invitation from RO?
- Too late if only seen in the international publication

Objective

- Enable inclusion of accidentally omitted elements or parts that are contained in a priority application without affecting the international filing date
 - element = all of the description or all of the claims
 - part = part of the description, part of claims or part or all of pages of drawings
- Erroneously filed elements or parts cannot be removed under incorporation by reference

Missing ≠ erroneously filed ≠ completed/corrected



Options in case of missing parts or erroneously filed elements or parts

	Incorporation by reference		Completion/Correction	
	Missing part	Erroneously filed element or part	Missing part	Erroneously filed element or part
PCT Rules	20.5(d), 20.5 <i>bis</i> (d), 20.6		20.5(b)&(c)	20.5 <i>bis</i> (b) and(c)
Int. Filing Date	Maintained		Will be changed	
Applicability	Not applied at some ROs and DOs		All ROs and DOs	
How erroneously filed sheets are dealt with	N/A	Remain in the application (published as part of the application — moved to the end of the respective element, e.g., description)	N/A	Removed from the application (and not visible on PATENTSCOPE)

Conditions

- Priority claimed on the original filing date (Rule 4.18)
- Priority application contains the element or part (Rule 20.6(b))
- Request contains statement of (conditional) incorporation by reference (Rule 4.18)
- Timely confirmation of incorporation by reference (Rules 20.6 and 20.7)
- Competent Authority: RO

Confirmation

- Time limit: two months from filing or from invitation (Rule 20.7)
- Documents to be filed (Rule 20.6):
 - notice of confirmation
 - missing or correct sheets
 - copy of the earlier application as filed unless the priority document already submitted
 - translation if not in the language of the international application
 - indication as to where in the priority document (and translation) the missing parts are contained



Confirmation (2)

- If not all requirements for incorporation by reference are fulfilled

(for example, if a missing element or part is not entirely contained in the earlier application):

- the international application is assigned a later filing date (date of receipt of missing or correct element or part),
- applicant may request that missing part or the correct element or part be disregarded (Rule 20.5(e) and Rule 20.5*bis*(e))

Invitation by RO to correct defect under Article 11(1) (Rule 20.3)

Where the entire description or all claims are missing, RO invites the applicant to either:

- furnish a correction under Article 11(2) and the international application is accorded a later filing date or,
- confirm under Rule 20.6(a) that the element is incorporated by reference under Rule 4.18 and the international filing date is maintained

Effect of incorporation by reference in the national phase (Rule 82*ter*.1(b))

- DOs may, to a limited extent, review the decision allowing the incorporation by reference
- Declarations of incompatibility with the national laws were made by a number of ROs and DOs

www.wipo.int/pct/en/texts/reservations/res_incomp.html

Declarations of incompatibility with the national laws (1)

The following Offices have notified the International Bureau of the incompatibility of Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), 20.5*bis*(a)(ii) and (d) and 20.6 with its national/regional law:

Incompatibility as RO (Rule 20.8(a)):

CU, CZ, DE, ID, KR, MX

Incompatibility as DO (Rule 20.8(b)):

CN, CU, CZ, DE, ID, KR, MX, TR

Declarations of incompatibility with the national laws (2)

❑ Incompatibility as RO (Rule 20.8(a-*bis*)):

CL, CU, CZ, DE, EP, ES, FR, ID, KR, MX

❑ Incompatibility as DO (Rule 20.8(b-*bis*)):

CL, CN, CU, CZ, DE, EP, ES, ID, KR, MX, TR

What if the RO or DO does not accept incorporation by reference?

- RO does not apply incorporation by reference:

- Request transfer of international application to RO/IB under Rule 19.4

- DO does not apply incorporation by reference:

- Regional path as an alternative?
- Accept later filing date for the sake of a complete application
- Maintain international filing date and accept incomplete content (unless an entire element concerned)

Poll answers

Questions?



PCT Resources

■ General questions about the PCT

□ Contact the PCT Information Service:

Telephone: +41 22 338 83 38

E-mail: pct.infoline@wipo.int

■ Questions about the ePCT

□ Contact PCT eServices Help Desk:

Telephone: +41 22 338 83 38

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