

Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

Twenty-First Session
Tel Aviv, February 11 to 13, 2014

CLARIFYING THE PROCEDURE REGARDING THE INCORPORATION BY REFERENCE OF MISSING PARTS

Document submitted by the European Patent Office

1. At the sixth session of the PCT Working Group, held in Geneva from May 21 to 24, 2013, the European Patent Office submitted a document entitled “Clarifying the Procedure regarding the Incorporation by Reference of Missing Parts”, containing a proposal to clarify the practice of incorporation by reference of missing parts by modifying the Receiving Office Guidelines (document PCT/WG/6/20, reproduced in Annex II to this document). The proposal received varying levels of support by the Working Group (see the Summary by the Chair of the sixth session, document PCT/WG/6/23, paragraphs 70 and 71). Following the discussions, the European Patent Office and the United States Patent and Trademark Office agreed to work together with the International Bureau on a revised proposal to be submitted to the next session of the Working Group.
2. Taking into account the discussions and the comments received during the sixth session of the Working Group, the European Patent Office and the United States Patent and Trademark Office further discussed this matter. The European Patent Office came to the conclusion that further consultation with the PCT membership was needed. In particular, in view of the twenty-first session of the Meeting of International Authorities (MIA), the European Patent Office launched a consultation of the delegations via the MIA electronic forum by means of a questionnaire (see Annex I). The assessment of the answers will be reported at the MIA where it is hoped that further progress could be made in clarifying the practice under Rule 20 PCT. In this respect, any comments from the delegations which did not provide a reply to the questionnaire in writing would be welcome at the MIA.

3. At present, the European Patent Office as designated Office reviews PCT applications entering the European phase under Rule 82^{ter}.1 (b) PCT to ensure that they are in line with European Patent Office practice and case law as indicated in document PCT/WG/6/20. The European Patent Office is of the view that current Receiving Office Guidelines are not aligned to PCT Rule 20 and thus there is a potential risk for applicants' rights when entering the European phase (see paragraph 6 of document PCT/WG/6/20, reproduced in Annex II to this document).

4. One issue which the European Patent Office would like to discuss also in that context is the new practice implemented at RO-US and RO-IB regarding acceptance of priority claims which have the same date as the international filing date. The European Patent Office is currently not in a position to change its practice under the Paris Convention, namely the priority application must be filed at least one day earlier. A discussion on this matter would be welcome.

5. The results of the questionnaire and discussions at the MIA will be taken into account by the European Patent Office when discussing bilaterally with the United States Patent and Trademark Office over a revised proposal to be submitted to the next session of the PCT Working Group (see paragraph 72, document PCT/WG/6/23).

6. *The Meeting is invited to comment on the possible improvements to clarify Rule 20 as well as to provide some feedback regarding the questionnaire enclosed in Annex I.*

[Annexes follow]

Questionnaire

Your Office is kindly requested to fill in this questionnaire. Please note the following additional information:

- *Background information : EPO document for PCT WG6, in Annex.*
- *Deadline for reply : **31 January 2014.***
- *Please reply by email to the EPO at international_pct_affairs@epo.org indicating “EPO questionnaire on incorporation by reference” in the subject.*
- *When answering, please provide a detailed reasoning and examples if possible.*
- *The EPO will assess your feedback and report at the PCT MIA for further discussions.*

Q1. Is the incorporation by reference of a full specification (set of claims and description) as missing part under Rule 20 PCT allowable at your Office?

Q2. Does your Office allow the incorporation by reference of missing parts under Rule 20 PCT where multiple priorities are claimed e.g. the applicant incorporates by reference some claims from two priority documents and a set of drawings from a third priority document? If so, how does your Office proceed in practice?

Q3. Irrespective of whether your Office currently applies missing parts provisions under Rule 20 PCT, is your Office of the opinion that a full specification (set of claims and description) may qualify as a missing part under Rule 20 PCT and thus get as international filing date the date of receipt of the originally filed erroneous documents (erroneous filing)?

Q4. Does your Office believe that Rule 20 PCT is not clear on the matter of incorporation by reference of a full specification (set of claims and description) and should thus be reviewed in order to reduce legal uncertainty (see paragraph 6 of EPO document, in Annex)?

Q5. If Rule 20 PCT were to be reviewed, would your Office be in favour of amending that Rule to cover the incorporation of a full specification (set of claims and description) into erroneous filings, or on the contrary to clarify that this practice should not be acceptable?

Q6. If Rule 20 PCT (were to) cover the incorporation of a full specification (set of claims and description) into erroneous filings, would your Office agree that International Searching Authorities be entitled to charge an additional search fee to the applicant in cases where the search copy was already sent to the ISA?

Q7. Would your Office agree that receiving Offices be entitled to charge a fee for incorporation by reference of missing parts to cover additional administrative costs?

Q8. Is your Office of the opinion that the replacement of erroneous parts or elements of an international application by new parts incorporated by reference (as proposed in the “PCT 20/20” document) could potentially affect the disclosure of the invention, and hence should rather be dealt with as an amendment in the Chapter II procedure?

Q9. With a view to incorporate by reference missing parts under Rule 20 PCT, certain receiving Offices accept that applicants indicate priority claims which bear the same date as the international filing date. Does your Office follow or support such practice (also under the applicable national law)?

Q10. Is your Office of the opinion that the practice of certain receiving Offices to accept priority claims which bear the same date as the international filing date is in line with the Paris Convention so that the priority claim is valid?

Q11. Is your Office of the opinion that the practice of certain receiving Offices to accept priority claims which bear the same date as the international filing date is in line with the PCT? If not, does your Office believe that PCT provisions (Rules, RO Guidelines) should be amended to allow receiving Offices to accept priority claims which bear the same date as the international filing date?

The EPO is very thankful for your cooperation.

[Annex II follows]

**PATENT COOPERATION TREATY (PCT)
WORKING GROUP**

SIXTH SESSION, GENEVA, MAY 21 TO 24, 2013

**CLARIFYING THE PROCEDURE REGARDING THE INCORPORATION BY
REFERENCE OF MISSING PARTS**

Document submitted by the European Patent Office

(reproduced from document PCT/WG/6/20)

1. At the fifth session of the PCT Working Group, held in Geneva from May 29 to June 1, 2012, the European Patent Office presented a proposal entitled “Proposals for Further Improvement of PCT Services and Products”, containing proposals for further improvement of the PCT system (document PCT/WG/5/20). The proposals received varying levels of support by the Working Group (see the Summary by the Chair of the fifth session, document PCT/WG/5/21, paragraphs 30 to 32). However, many delegations felt that they could provide only preliminary views on the proposals and noted that more time was needed to carefully study the proposals, to consult with user groups and to consider the possible impact on respective national laws and practices. Following the discussions, the European Patent Office agreed to further elaborate on the proposals and to provide more details on how to take the proposals forward, for discussion at the next session of the Working Group.
2. Taking into account the discussions and the comments received during the fifth session of the Working Group, the European Patent Office prepared a revised version of the original proposals for further improvement of the PCT system for discussion at the twentieth session of the Meeting of International Authorities that took place in Munich from February 6 to 8, 2013 (document PCT/MIA/20/11). Those revised proposals have also been communicated by the International Bureau, by way of a Circular (Circular C. PCT 1364, dated December 20, 2012, Annex II), to Offices of all PCT Contracting States in their capacity as a receiving Office, an International Searching and Preliminary Examining Authority and/or a designated and elected Office under the PCT, to Geneva-based missions and foreign ministries of PCT Contracting States and of States that are invited to attend meetings of the PCT Working Group as observers, as well as to certain organizations that are invited to attend meetings of the PCT Working Group as observers, with the invitation to review and further comment on those revised proposals and, in particular, to consult with user groups on those proposals and to consider the possible impact of those proposals, if adopted, on respective national laws and practices.
3. Since April 1, 2007, applicants are allowed to incorporate by reference parts of the description, claims or drawings under Rule 20 and keep their international filing date. This reform was introduced with a view to align the PCT with the Patent Law Treaty. On July 1, 2009, new paragraphs 205E and 205F of the PCT Receiving Office Guidelines have provided indications as to the way receiving Offices should process requests for incorporation by reference. In particular, paragraph 205F provides for the sequential placing of each of the subsequently filed elements before the originally filed elements. Back in 2009, the Meeting of International Authorities (MIA) was of the view that it was too premature to review the procedures concerning the incorporation by reference of missing parts. The remedy of incorporation by reference had only recently been added to the Regulations, and Authorities were still in the process of developing practices and gaining experience as to how best to implement the new provisions. It was thus felt preferable to leave the Guidelines as flexible as possible so as to accommodate the various different practices among Offices until a “best practice” emerged and could be agreed upon (paragraph 91, document PCT/MIA/16/15). Six years after the entry into force of these provisions it appears that the time is now ripe to carefully

review this procedure. The European Patent Office therefore hereby submits its proposal aiming at clarifying the practice of incorporation by reference of missing parts as already presented at the MIA (document PCT/MIA/20/11, Annex, paragraphs 12 to 16) and in Circular C. PCT 1364, mentioned in paragraph 2, above, that received broad support from both Offices and user groups.

4. Over the last few years, the European Patent Office acting as International Searching Authority has noticed that some receiving Offices are applying paragraph 205F in such a manner that applicants are actually allowed to file a new specification (description and claims) that is not related with the application as originally filed.

5. It is however noted that the confirmation of incorporation by reference of a part under Rule 20.6(a) is subject to compliance with Rule 4.18, which in turn provides that, where a part of the description, claims or drawings referred to in Rule 20.5(a) is not otherwise contained in the international application but is completely contained in the earlier application, that part is, subject to confirmation under Rule 20.6, incorporated by reference. While Rule 20.5(a) mentions that the drawings as a whole may qualify as a missing part this is not the case of the description and claims. Quite the opposite since that Rule indicates that it does not cover cases where an entire element is or appears to be missing. As a result, the incorporation by reference, as a missing part, of a whole new specification (new description and new set of claims) which is otherwise unrelated to the application as filed is not allowed under Rule 4.18. On the basis of this analysis, the European Patent Office is of the view that a whole new specification does not qualify as a missing part under Rule 20. A complete description and a set of claims were filed at the international filing date. Current Rule 20.5 was not aimed at covering the erroneous filing of a complete application.

6. It is noted that the divergence of practice between receiving Offices raises legal uncertainty. In proceedings under the European Patent Convention, Rule 56 EPC also provides a legal basis for the filing of missing parts. In that respect, the EPO Boards of Appeal stated that the term "missing part" indicates that some part of the description is missing or absent but another part has been filed (J 0027/10, decision dated December 9, 2011). The incomplete originally filed description is to be completed by the missing part which must be added to the already filed text of the description. The same principle could apply to international applications entering the European phase. Since designated Offices may review, under Rule 82*ter*.1(b), decisions of receiving Offices regarding incorporation by reference of missing parts where such decisions are (believed) not to be in line with the applicable PCT rules, the EPO Boards of Appeal will be entitled to decide on the matter.

7. From a practical point of view the current practice is also not satisfactory. It is indeed unclear what ought to be searched by the International Searching Authority as paragraph 205F of the PCT Receiving Office Guidelines implies that two sets of description or claims could be accepted in which case the search copy consists of two different specifications. However, the International Searching Authority is required to search the whole application, and not only a part of it. In view of paragraph 205F, the substantive examiner in practice performs the search only on the basis of the latest specification after incorporation by reference had been granted by the receiving Office but there are doubts as to whether, strictly speaking, unity of invention should not be questioned under Rule 13.

8. There are also instances where incorporation by reference of missing parts is accepted by the receiving Office after the search copy was transmitted to the International Searching Authority. The problems regarding clarity described in paragraph 7, above, would apply but also, in these extreme cases, the international search report may well already be established. The European Patent Office has been experiencing such cases where it performed the international search on the basis of the application as filed (search copy) and then received, after the international search report was established, a communication from the receiving Office allowing the incorporation by reference of a whole new description and set of claims as a

missing part which were not related with the application as originally filed. The Office was then requested to perform a second search, this time on the basis of the new specification. This situation is not acceptable.

9. In view of the above, the European Patent Office suggests aligning paragraphs 205E and 205F of the PCT Receiving Office Guidelines with Rule 20 in order to ensure legal certainty for applicants and third parties, and facilitate the work of International Searching Authorities.

10. *The Working Group is invited to comment on the proposal set out in the Annex to this document.*

[Annex (to document
PCT/WG/6/20) follows]

ANNEX (to document PCT/WG/6/20)

Proposed Amendments to PCT Receiving Office Guidelines (Clarify Practice Regarding Incorporation by Reference)

205D. **Negative Finding.** Where the receiving Office finds that not all the requirements of Rules 4.18 and 20.6(a) have been complied with or that the part concerned is not completely contained in the earlier application or that the alleged missing part does not qualify as a missing part under Rule 4.18 in conjunction with Rule 20.5(a) (e.g. where both the description (and drawing(s) if any) and claims submitted as missing part are unrelated to the elements originally filed), the receiving Office issues Form PCT/RO/114 accordingly and treats the subsequently furnished sheets as if the incorporation by reference had not been confirmed and proceeds, after the expiration of the time limit under Rule 20.7, as described in Section 309(c) (see also paragraphs 200 to 202). A copy of the notice (Form PCT/RO/114) is sent to the International Bureau and to the International Searching Authority.

205F. ~~Where the An~~ applicant ~~wishes to completely~~ may not replace an element ~~or all elements~~ of an international application as originally filed with a different elements through incorporation by reference of a missing parts, ~~t.~~ The receiving Office may only add any elements of the international application as missing parts but may not perform a substitution of the ~~international application element~~ as filed with the subsequently furnished missing parts. The description, claims or drawings from the earlier application, which are to be incorporated by reference, cannot replace the description, claims or drawings of the international application as filed. The parts to be incorporated by reference (Rule 20.5) should be combined with the elements of the international application originally submitted and should be checked for compliance with the physical requirements referred to in Rule 11 to the extent that compliance is necessary for the purpose of reasonably uniform international publication (Rule 26.3(b)(ii)), including image scanning and OCR by the International Bureau. The receiving Office should invite the applicant to, or, if at all feasible and if the Office so wishes, by way of an ex officio correction, order the pages of the combined international application in such a manner that the sheets incorporated by reference are placed first, sequentially followed by the pages which were originally filed such as in the following examples:

Example 1

Description incorporated from earlier application
Description as originally filed
~~Claims incorporated from earlier application~~
Claims as originally filed
Drawings incorporated from earlier application
Drawings as originally filed

Example 2

Description as originally filed
Claims incorporated from earlier application
Claims as originally filed
Drawings as originally filed

[End of Annex II and of document]