

Patent Cooperation Treaty (PCT) Working Group

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CONDITIONS FOR THE CORRECTION OF THE INTERNATIONAL APPLICATION IN CASE OF “ERRONEOUSLY” FILED ELEMENTS AND PARTS

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SUMMARY

1. The present document sets out the conclusions reached at the consultations launched by the European Patent Office (EPO) with the Member States of the European Patent Organisation and with user groups regarding the introduction of a PCT provision that would allow the applicant, in specifically defined cases, to correct an international application in case of “erroneously” filed elements and parts of the international application by incorporating “correct” elements or parts completely contained in an earlier application from which priority is claimed on the international filing date.

BACKGROUND

2. Article 5(6)(a) of the Patent Law Treaty (PLT), adopted on June 1, 2000, provides that applicants may rectify the omission of a part of the description or a drawing by filing the missing part or drawing within the time limit prescribed in the Regulations. In this case, the part of the description or the drawing filed at a later stage is included in the application and the filing date modified either in accordance with the date on which the Office has received the missing part, or the date on which all of the requirements to obtain a filing date are complied with, whichever is later. In addition, according to PLT Article 5(6)(b), in the case where an applicant files a part of the description or a drawing missing from an application which, on the filing date, claims priority of an earlier application, the applicant is allowed to include that part in the application and still keep the filing date, subject to further requirements prescribed in the PLT Regulations.

3. After the adoption of the PLT, there was consensus to align both the PCT and the EPC legal systems to PLT Article 5(6). The inclusion of missing parts provisions into the PCT was, as a principle, endorsed by the PCT Assembly already in 2001 but it took several years of discussions before Rule 20 was finally revised in 2005 and entered into force on April 1, 2007. It follows that, subject to notifications of incompatibility submitted by some receiving and designated Offices under Rule 20.8, PCT applicants are enabled to complete the international application by incorporating by reference a missing element or part of the description, claims or drawings (including an entire set of drawings) that is completely contained in an earlier application, whose priority is validly claimed on the date of filing, without affecting the international filing date.
4. PCT Rule 20 became applicable to the EPO as a receiving and designated Office following the withdrawal of EPO's notification of incompatibility after the entry into force of the European Patent Convention 2000 (EPC 2000) on December 13, 2007, which implemented the PLT requirements. According to Rule 56(3) EPC 2000, an applicant may file missing parts of the description or missing drawings within the time limit prescribed without affecting the filing date, provided that the missing parts are completely contained in an earlier application of which priority is claimed and further requirements are fulfilled.
5. Ten years after the entry into force of the PCT provisions allowing incorporation by reference under the PCT at the EPO, the system generally works smoothly and applicants make use of these safety nets only in exceptional circumstances (around 40 files per year since 2012).
6. However, some divergence appears in the practice of the receiving Offices under PCT Rule 20 with respect to specific situations where the original filing was erroneous. In these cases a wrong but complete application has been mistakenly filed on the date of filing by the applicant, who then tries to incorporate by reference the correct application (a complete new description and set of claims contained in the priority application claimed) as a missing part in order not to lose the international filing date. While a number of receiving Offices do not accept such requests (for example, the EPO), some other receiving Offices do allow applicants to add entire elements contained in a priority application as missing parts (for example, the United States Patent and Trademark Office).
7. Numerous receiving Offices (including the EPO) take the view that, under the present Regulations, such practice is not permissible. At the tenth session of the Working Group in May 2017, the EPO argued that, by definition, the term "missing part" of the claims or of the description indicates that some part of such element was missing but other parts of that element had been filed. Incorporation by reference of a "missing part" would thus require that the "missing part" of the claims or description that was to be incorporated by reference indeed "completed" that (incomplete) element as contained in the international application on the international filing date, rather than replacing it completely (see paragraph 253 of the Report of the session, document PCT/WG/10/25).
8. Another group of receiving Offices takes the view that, in such a situation, the applicant should be entitled to correct his mistake by way of incorporation by reference of a "missing part". If not, it would result in the situation that an applicant who did not include any claim(s) and/or any description in the international application as filed would be allowed to have those elements included in the international application by way of incorporation by reference of a missing element, whereas an applicant who had attempted to include those elements in the international application as filed but who erroneously had filed the wrong claims and/or the wrong description would not be allowed to correct his mistake by submitting the correct elements. The applicant in the latter situation would thus be penalized for attempting to file a complete international application, albeit with the wrong claims and/or description elements (see paragraph 4 of PCT/WG/9/13).

9. This difference of approaches brings legal uncertainty as to the fate of the international application when entering the various national phases in addition to a series of practical difficulties for the designated Offices dealing with the file.

10. In the framework of the PCT Working Group meetings, discussions have been held over the last few years on how to address this different interpretation by receiving Offices and designated/elected Offices of the provisions related to the incorporation by reference of missing parts. However, no agreement could be reached as to the way forward on the basis of the existing PCT provisions on missing parts.

11. For this reason, at the eighth session of the PCT Working Group in 2015, it was decided to explore whether it would be possible to draft an entirely new provision which would allow the applicant, in specifically defined cases, to replace the “erroneously” filed claims and/or description of the international application as filed with the equivalent “correct” version of the claims and/or description contained in the priority application.

12. At the ninth session of the PCT Working Group in 2016, a draft proposal to include a new Rule which would allow applicants to correct the international application without amending the international filing date was presented by the International Bureau (see document PCT/WG/9/13). In particular, the following was proposed:

- Rule 20.5(a) would be amended so as to clarify that the existing “missing parts” provisions set out in Rule 20.5 were intended to only cover the cases where a part of the description, claims or drawings is “truly” missing from the international application but not to cover the cases where an entire element or part of the international application has been erroneously filed;
- A new Rule 20.5*bis* would allow the applicant to request the removal of any erroneously filed element (description, claims or drawing) or part from the international application and confirm the incorporation by reference of the equivalent correct element or part as contained in an earlier application the priority of which is claimed in the international application;
- If validly incorporated by reference, the erroneously filed element or part would be removed and replaced by the correct element or part without changing the international filing date;
- If the correct element or part is not considered validly incorporated by reference, the receiving Office would simply treat the international application as if the request by the applicant to remove the erroneously filed element or part had not been made and the international application would proceed “un-corrected”;
- It would be sufficient if the applicant simply did not intend to file the element or part in question. The receiving Office would not be required to decide on whether the element or part had indeed been erroneously filed;
- The time limits under Rule 20.7 would apply to ensure that the entire process would be complete before international publication takes place;
- The International Searching Authority would have the possibility to charge an additional fee if the request for a correction under the new Rule is notified to the Authority after it has begun to draw up the international search report.

- Receiving Offices and designated Offices would be allowed to submit a notification of incompatibility where their national law does not allow the correction of erroneous filings.

13. At that session, the compatibility of such proposal with the PLT was questioned. In particular, the EPO enquired as to whether the proposed change would not be contrary to PLT Article 2(1), according to which PLT Contracting Parties are not free to create additional possibilities to amend the scope of the disclosure without changing the filing date, and expressed concerns about the widening of the gap between the filing date related requirements applicable to international applications and those applicable to national and regional applications. The International Bureau was therefore requested to present, at the next session of the PCT Working Group in 2017, an assessment on the PLT issues raised (see paragraph 309 of the Report of the session, document PCT/WG/9/28).

14. The International Bureau presented the following analysis at the tenth session of the PCT Working Group in 2017 (see document PCT/WG/10/10):

- The interpretation of the PLT falls within the exclusive competence of the PLT Contracting Parties.
- The PLT does not govern the PCT filing date related requirements. Pursuant to PLT Article 3(1)(b), as far as international applications are concerned, the PLT only applies in a PLT Contracting State in respect of the time limits for national phase entry and any procedure after national phase entry has commenced, subject to the provisions of the PCT. Therefore, the issue of compatibility with the PLT does not concern the proposal itself but only raises concerns with regard to the widening of the gap between the PCT filing date requirements and the PLT filing date requirements, should it not be possible for a PCT Member State, which is also a PLT Contracting Party, to align its national or regional law accordingly in respect of national or regional applications filed with or for that State.
- The PLT and PCT already provide for different filing date requirements. For instance:
 - Unlike PLT Article 5, PCT Article 11 requires that an international application contains on the date of filing a part which on the face of it appears to be a claim and that it is in the language prescribed by the receiving Office.
 - Whereas under the PCT it is possible to incorporate by reference, without loss of the international filing date, an entire element, such option is not provided by the PLT.
 - Under the PLT, a Contracting State may allow for the replacement of the description and drawings by a reference to a previously filed application; this option is not provided by the PCT.
 - While under the PCT the inclusion of a statement of incorporation by reference in the international application on the date of filing is a mandatory requirement for the valid incorporation by reference of any missing element or part, under the PLT, any Contracting Party may (but is not obliged to) require such an indication.

15. For the reasons outlined below, at the tenth session of the PCT Working Group, the EPO expressed again doubts concerning the compliance of the proposed new PCT approach with the PLT (see paragraph 88 of the Summary by the Chair of the session, document PCT/WG/10/24).

16. The EPO nevertheless envisaged that, subject to consultation with all of the Member States of the European Patent Organisation, it might be able to support the proposed new approach on the following conditions: (i) the removal of any erroneously filed element or part would not be allowed; (ii) the EPO as receiving Office and as a designated Office would be given the option of making a notification of incompatibility in relation to the proposed Rule 20.5*bis*; and (iii) an International Searching Authority would be entitled to charge an additional fee in the case that the incorporation of a “correct” element or part had occurred after the Authority had begun to draw up the international search report.

ASSESSMENT OF THE PROPOSAL BY THE INTERNATIONAL BUREAU TO INTRODUCE A RULE FOR ERRONEOUSLY FILE ELEMENTS AND PARTS

COMPATIBILITY OF THE PROPOSAL WITH THE PLT

17. While the EPO agreed that there is no *ex lege* obligation for international applications under the PCT to comply with the filing date requirements set by the PLT, it recalled that there has always been consensus in the PCT framework as to the need to align the PCT, to the maximum extent possible, with the provisions of the PLT (see, for instance, paragraph 66 of document PCT/R/1/26).

18. Even though the filing requirements laid down in the PCT and the PLT are not identical, both the PCT and the PLT aim at harmonization of formal requirements. Amendments to the PCT should therefore be compliant with the standards laid down in the PLT to avoid undermining the harmonization goal underlying both the PCT and the PLT. Also, it is noted that no conclusion may be derived from the document prepared by the International Bureau as to the compatibility of the proposal with the PLT and that therefore such question is left open in that document.

19. From a PCT perspective, the introduction of a legal basis for the correction of an erroneous international application would increase clarity and legal certainty by putting an end to the divergence of practices between Offices, which leads to negative consequences for both applicants and Offices.

COMPATIBILITY OF THE PROPOSAL WITH THE EPC

20. The majority of the EPC Contracting States are bound by the PLT and the legislative intent behind the EPC 2000 was to ensure compliance of the EPC with the international obligations of the Contracting States under the PLT. For this reason, the EPO practice and any amendments to the EPC are aligned with the PLT.

21. Rule 56 EPC which serves as a basis for filing of missing parts of the description or missing drawings, does not allow for an interpretation that some, or all, of the description that was originally filed to obtain a filing date could be amended, replaced or deleted (EPO Board of Appeal Case J 27/10 points 11 and 12 of the Reasons, and Case J 15/12 point 4 of the Reasons). The same interpretation must be applied to missing drawings. As an exception to the principle that the scope of disclosure of an application is determined by the disclosure on the date of filing, Rule 56 EPC must be given a narrow interpretation.

22. Under the EPC, the assessment of whether a part of the description or drawings are missing is part of the examination of the application as to formal requirements in accordance with Article 90 EPC (EPO Board of Appeal Case J 27/10 point 13 of the Reasons). Therefore, it must be apparent, whether immediately or upon indication by the applicant (c.f. Case J 2/12 point 9 of the Reasons) judging by the content of the documents as filed on the filing date, that a part of description or drawings is objectively missing.

23. The term “description” in “missing parts of the description” refers to the description which was originally filed in order to obtain a filing date and not to any other description, such as, for example, the one the applicant actually intended to file or the description of a priority application. In its literal sense, the term “missing parts of the description” indicates that some parts of the description are missing or absent but other parts of it have been filed (EPO Board of Appeal Case J 27/10 point 11 of the Reasons). Accordingly, under the framework of the EPC there is no room for the interpretation that the application documents which were filed and appeared complete on the date of filing were “erroneous”.

24. It is a fundamental principle of the EPC that the content of an application may not be extended after the filing date (Article 123(2) EPC, as confirmed *inter alia* in EPO Board of Appeal Cases G 3/89, G 11/91 and G 2/95). This serves legal certainty and is in the interest of third parties. The public must not be taken by surprise by claims or other content of the disclosure which could not have been reasonably expected on the filing date, based on the application documents as originally filed. Furthermore, under the “reward theory” and the first-to-file principle underlying the European patent system, the applicant must not be awarded an exclusive right for subject matter which was not disclosed on the filing date of the application. The importance of the prohibition to extend the disclosure after the filing date is underlined by the fact that Article 123(2) EPC is a ground for opposition and a ground for revocation during national proceedings (see Articles 100 and 138 EPC).

25. In alignment with Article 123(2) EPC, all information contained in a filed application is part of the disclosure of the invention. Therefore, its removal is to be seen as an amendment or correction of the application.

26. Replacement of entire elements which determine the disclosure of the invention (description, claims or set of drawings) as correction of the application documents based on the applicant’s assessment that an element has been filed “erroneously” would result in a change of the disclosure of the application. Thus, it may not be accepted under Rule 139 EPC, even if those elements were present in the priority application (c.f. EPO Board of Appeal Cases G 11/91, points 3 and 4 of the Reasons, and Case G 2/95 points 2 to 4 of the Reasons).

27. As laid down in PLT Article 2(1), the Contracting Parties may not provide for requirements which would be more favorable to the applicants than the requirements of PLT Article 5. Rule 56 EPC implements PLT Article 5(6) (see Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add.1 reproduced in Special Edition No. 5, Official Journal EPO 2007, 102) and its wording largely corresponds to the wording used in the PLT. The interpretation given to Rule 56 EPC by the EPO Legal Board of Appeal forms the basis for the interpretation of the PLT by the EPO.

28. Amendments of the Implementing Regulations to the EPC (in particular Rule 56 EPC) along the lines of the proposal prepared by the International Bureau appear to put into question the principle under the EPC that the disclosure of the application is determined on the date of filing by the application documents as filed.

OUTCOME OF CONSULTATIONS – CONDITIONS FOR THE INTRODUCTION OF A NEW RULE

29. The principle that the disclosure is determined on the filing date is one of the foundations of the patent system. A new provision allowing the correction of the international application in case of “erroneously” filed elements and parts would constitute an exception to this fundamental principle. The existing provisions entitling the applicant to incorporate by reference missing parts (Rules 4.18, 20.5(a)(ii) and 20.6(a)) also are an exception to this fundamental principle. Therefore, it seems appropriate that proposed Rule 20.5*bis* is subject to conditions analogous to those of the current exceptions, namely, that an incorporation by reference without affecting

the international filing date would only be allowable provided that the relevant parts or elements were completely contained in the earlier application from which priority was claimed on the international filing date.

30. On the basis of the analysis outlined above and the discussions held in the EPO Committee on Patent Law and with European users, in order to be able to support the proposal made by the International Bureau to introduce a legal basis aimed at allowing the correction of erroneously filed elements and parts of the international application on the basis of the priority application, the EPO suggests that such proposal be further defined under the following conditions:

- The PCT Receiving Office Guidelines should be amended so as to clarify that Rule 20.5 only covers the cases where a part of the description, claims or drawings is “truly” missing from the international application and not the cases where an entire element or part of the international application has been erroneously filed;
- The new provision should not allow the “replacement” of the erroneous element or part but only the incorporation by reference of the correct element or part as completely contained in the priority application;
- The incorporation by reference and the correction of the erroneously filed element or part should only be allowed in the pre-publication phase;
- The International Searching Authority should be entitled to charge an additional fee if the search of the erroneous filing has already been started; and
- Receiving Offices and designated Offices should be allowed to submit a notification of incompatibility where their national law does not allow the correction of erroneous filings.

31. The Working Group is invited to consider the proposal set out in paragraph 30 of the present document.

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