

Patent Cooperation Treaty (PCT) Working Group

**Ninth Session
Geneva, May 17 to 20, 2016**

SAME DAY PRIORITY CLAIMS

Document prepared by the International Bureau

SUMMARY

1. The Working Group, at its eighth session, requested the International Bureau to prepare, for discussion at its 2016 session, a proposal for amendment of the PCT Regulations to expressly require receiving Offices not to cancel same day priority claims so as to prepare the ground for decisions on the matter to be taken by designated Offices in the national phase under the applicable national laws. Such a proposal is set out in the present document.

BACKGROUND

2. The Working Group, at its sixth and seventh sessions, discussed how to address the apparently different interpretations by receiving Offices and designated/elected Offices of the provisions of Rules 4.18 and 20.5 and 20.6 with regard to the incorporation by reference of missing parts (see documents PCT/WG/6/20 and PCT/WG/7/19). In the context of those discussions, the question arose whether a priority claim contained in an international application based on an earlier application which has the same filing date as the international application (“same day priority claim”) is a valid priority claim under the Paris Convention and thus the PCT.

3. More specifically, the discussions on the issue of incorporation by reference of missing parts revealed that, at present, a number of Offices of PCT Contracting States, in their capacity as both receiving Offices and designated Offices, have adopted the interpretation that same day priority claims are to be permitted under the Paris Convention and thus the PCT. Those Offices, in their capacity as receiving Offices, thus allow applicants to incorporate by reference a missing element or part contained in an “earlier” application filed on the same day as the international application (noting that the inclusion in the international application of a priority claim to such an earlier application is a requirement for validly requesting incorporation by reference of missing elements or parts).

4. On the other hand, that interpretation of the Paris Convention that same day priority claims are to be permitted under the Paris Convention (and thus the PCT) is not shared by all Offices. Thus, today, applicants depend on the interpretation by the receiving Office with which the application is filed and by designated Offices and their applicable national laws as to the “fate” of any same day priority claim contained in the international application, and thus also on the fate of any request for incorporation by reference of any missing element or part contained in any earlier application filed on the same day as the international filing date.

5. Document PCT/WG/8/5 outlined four possible options as to how to address the apparent differences in interpretation of the Paris Convention by Offices of PCT Member States as to whether same day priority claims are permitted, namely: Option 1: refer the matter to the Paris Union Assembly; Option 2: have the PCT Union Assembly decide on the matter; Option 3: amend the PCT Regulations to prepare the ground for a decision on the matter by designated Offices in the national phase; and Option 4: leave the interpretation to individual receiving Offices. For a detailed description of those four possible options, see document PCT/WG/8/5.

6. There was no consensus among Member States at the Working Group’s eighth session on the issue. For a detailed report on the discussions by the Working Group during its eighth session, see the Summary by the Chair of the session (document PCT/WG/8/25, paragraphs 124 to 131) and the Report of the session (document PCT/WG/8/26, paragraphs 331 to 352). While noting the divergence of views, the Working Group requested the International Bureau to prepare, for discussion at its next session, a proposal for amendment of the PCT Regulations to expressly require receiving Offices not to cancel same day priority claims so as to prepare the ground for decisions on the matter to be taken by designated Offices in the national phase under the applicable national laws.

PROPOSAL

7. As requested by the Working Group, and along the lines of what was set out as Option 3 in document PCT/WG/8/5, the Annex to this document sets out a proposal to amend Rule 26*bis*.2. A new paragraph (a-*bis*) has been added to this Rule to expressly provide that the fact that the filing date of the earlier application referred to in Rule 4.10(a)(i) is the same date as the international filing date shall not be considered to be a defect in the priority claim “for the purposes of the procedure under the Treaty” (that is, for the purposes of the international phase of the PCT procedure; see the wording of present Rule 26*bis*.2(b)).

8. In addition, it is proposed to amend Rule 26*bis*.2(d) to provide that the International Bureau should publish, together with the international application, information concerning any same day priority claim, the details of which would be prescribed by the Administrative Instructions, so as to draw specific attention to the fact that an international application contains such a same day priority claim (which may not be recognized by designated Offices under the applicable national law), for the benefit of designated Offices and third parties.

9. The result of the proposed amendment would be the following:
 - (a) any same day priority claim would remain in the international application;
 - (b) any such same day priority claim could serve as the basis for the incorporation by reference of any missing element or part (unless the receiving Office has notified the International Bureau under present Rule 20.8(a) that the PCT provisions regarding incorporation by reference are not compatible with the national law applied by it);
 - (c) any missing element or part incorporated by reference by the receiving Office would be taken into account by the International Searching Authority when carrying out the international search;
 - (d) each designated Office would decide, under the national law applied by the Office, whether to allow any same day priority claim and, consequently, whether to allow for the incorporation by reference of any missing element or part in accordance with Rule 20.6(b) and (c) where such same day priority claim serves as a basis for the incorporation by reference (except where the designated Office has notified the International Bureau under present Rule 20.8(b) that the PCT provisions regarding incorporation by reference are not compatible with the national law applied by it).
10. The table set out on the following page illustrates the results of the proposed amendment of the PCT Regulations with regard to same day priority claims.
11. In this context, in the view of the International Bureau, the Working Group may wish to take in particular the following considerations into account:
 - (a) Firstly, as noted in document PCT/WG/8/5, the scale of the issue is very, very small. In 2013, of the 200 international applications claiming priority to an earlier application filed on the same day as the international filing date, only two have been the subject of requests for incorporation by reference of a missing element or part. On the other hand, there is no doubt that the combination of “same day priority claim” and “incorporation by reference” is used and important to some applicants.
 - (b) Secondly, it has to be recognized that, while a Rule change as set out in the Annex to the present document would no doubt benefit a very small number of international applications, the practical result of such a Rule change would be to make the national phase procedure for applications claiming same day priority and requesting the incorporation by reference of any missing element or part based on such priority claim *more complex* for most designated Offices. At present, it appears that the majority of designated Offices do not allow for such same day priority claims and thus for incorporation by reference based on such priority claims. Thus, the majority of designated Offices would be faced—admittedly in very few cases—with what would likely be more work in relation to such cases (in particular: potential change of international filing date and/or ignoring of any missing element or part incorporated by reference; limited value of international search report established on the basis of an earlier international filing date than that recognized for the purposes of the national phase and which has taken into account the missing element or part incorporated by reference by the receiving Office).

**Results of the Proposed Amendment of the PCT Regulations
With Regard to Same Day Priority Claims**

INTERNATIONAL PHASE OF PCT PROCEDURE			
	All ROs required to allow same day priority claim		
Valid Priority Claim?	Yes		
Incorporation by Reference of Missing Element or Part?	yes <i>(if RO has not submitted a notification of incompatibility under Rule 20.8(a))</i> No <i>(if RO has submitted a notification of incompatibility under Rule 20.8(a))</i>		
Does International Search Report Take Into Account Missing Element or Part Incorporated by Reference?	yes <i>(if RO has incorporated by reference any missing element or part)</i> No <i>(if RO has <u>not</u> incorporated by reference any missing element or part)</i>		
NATIONAL PHASE OF PCT PROCEDURE			
	Does DO, under national law applied by it, allow: <ul style="list-style-type: none"> • same day priority claims (“priority” yes/no)? • incorporation by reference of missing elements or parts (“incorporation” yes/no)? 		
	Priority yes / Incorporation yes <i>(if DO has <u>not</u> submitted a notification of incompatibility under Rule 20.8(b))</i>	Priority yes / Incorporation no <i>(if DO has submitted a notification of incompatibility under Rule 20.8(b))</i>	Priority no
Valid Priority Claim?	Yes	Yes	No
Incorporation by Reference of Missing Element or Part?	Yes	No <i>(either international filing date would change or material incorporated by reference would be ignored)</i>	No <i>(either international filing date would change or material incorporated by reference would be ignored)</i>
International Search Report Useful for DO?	Yes <i>(since international search took into account the missing element or part incorporated by reference)</i>	No <i>(since international search took into account the missing element or part incorporated by reference, or was based on an earlier international filing date than that accepted by the DO)</i>	No <i>(since international search took into account the missing element or part incorporated by reference, or was based on an earlier international filing date than that accepted by the DO)</i>

12. The Working Group is invited to comment on the proposed amendments to the PCT Regulations set out in the Annex to this document.

[Annex follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS¹

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¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

Rule 26bis
Correction or Addition of Priority Claim

26bis.1 [No change]

26bis.2 *Defects in Priority Claims*

(a) [No change] Where the receiving Office or, if the receiving Office fails to do so, the International Bureau, finds in relation to a priority claim:

- (i) that the international application has an international filing date which is later than the date on which the priority period expired and that a request for restoration of the right of priority under Rule 26bis.3 has not been submitted;
- (ii) that the priority claim does not comply with the requirements of Rule 4.10; or
- (iii) that any indication in the priority claim is inconsistent with the corresponding indication appearing in the priority document;

the receiving Office or the International Bureau, as the case may be, shall invite the applicant to correct the priority claim. In the case referred to in item (i), where the international filing date is within two months from the date on which the priority period expired, the receiving Office or the International Bureau, as the case may be, shall also notify the applicant of the possibility of submitting a request for the restoration of the right of priority in accordance with Rule 26bis.3, unless the receiving Office has notified the International Bureau under Rule 26bis.3(j) of the incompatibility of Rule 26bis.3(a) to (i) with the national law applied by that Office.

[\(a-bis\) The fact that the filing date of the earlier application referred to in Rule 4.10\(a\)\(i\) is the same date as the international filing date shall, for the purposes of the procedure under the Treaty, not be considered to be a defect in the priority claim.](#)

(b) [No change] If the applicant does not, before the expiration of the time limit under Rule 26bis.1(a), submit a notice correcting the priority claim, that priority claim shall, subject to paragraph (c), for the purposes of the procedure under the Treaty, be considered not to have been made (“considered void”) and the receiving Office or the International Bureau, as the case may be, shall so declare and shall inform the applicant accordingly. Any notice correcting the priority claim which is received before the receiving Office or the International Bureau, as the case may be, so declares and not later than one month after the expiration of that time limit shall be considered to have been received before the expiration of that time limit.

[Rule 26bis.2, continued]

(c) A priority claim shall not be considered void only because:

(i) the indication of the number of the earlier application referred to in Rule 4.10(a)(ii) is missing;

(ii) an indication in the priority claim is inconsistent with the corresponding indication appearing in the priority document; or

(iii) the international application has an international filing date which is later than the date on which the priority period expired, provided that the international filing date is within the period of two months from that date.

(d) Where:

(i) the receiving Office or the International Bureau has made a declaration under paragraph (b); ~~or~~

(ii) ~~where~~ the priority claim has not been considered void only because paragraph (c) applies; ~~or~~

(iii) the filing date of the earlier application referred to in Rule 4.10(a)(i) is the same date as the international filing date;

the International Bureau shall publish, together with the international application, information concerning the priority claim as prescribed by the Administrative Instructions, as well as any information submitted by the applicant concerning such priority claim which is received by the International Bureau prior to the completion of the technical preparations for international publication. Such information shall be included in the communication under Article 20 where the international application is not published by virtue of Article 64(3).

(e) [No change]

26bis.3 [No change]

[End of Annex and of document]