

Patent Cooperation Treaty (PCT) Working Group

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

Document prepared by the International Bureau

SUMMARY

1. This document summarizes the responses from Offices to a questionnaire on procedures regarding the incorporation by reference of missing parts under Rule 20. The responses show that Offices have different opinions on whether it should be permitted to replace wrongly filed claims and/or description elements of an international application with a full specification. Offices also expressed different views on related issues, such as the incorporation by reference of missing parts from multiple priorities, the treatment of erroneous parts or elements as an amendment under the Chapter II procedure, and the acceptance of priority claims which bear the same date as the international filing date.

2. Since there is no consensus on how the PCT legislative framework should be amended to clarify the interpretation of the provisions regarding the incorporation by reference of missing parts, the International Bureau will continue working with interested Offices to explore possibilities that could achieve greater consistency and legal certainty for applicants. The responses to the questionnaire also clearly show that there is no consensus among Member States on the issue of whether a priority claim contained in the international application based on an earlier application which has the same filing date as the international application is a valid priority claim within the meaning of PCT Article 8. As this issue would appear to be not a PCT issue but a question of how to interpret Article 4(C)(2) of the Paris Convention, Member States may wish to consider whether this issue should be further explored in the Working Group (with the aim of agreeing a common interpretation of the Paris Convention by all PCT Member States) or rather in the context of WIPO's Standing Committee on the Law of Patents (SCP).

BACKGROUND

3. At its sixth session, the PCT Working Group discussed a proposal submitted by the European Patent Office entitled “Clarifying the Procedure Regarding Incorporation by Reference of Missing Parts” (document PCT/WG/6/20). The proposal sought to address the apparently different interpretation by receiving Offices and designated/elected Offices of the provisions of Rules 4.18 and 20.5 and 20.6. This different interpretation results in different practices by Offices where the international application, on the international filing date, contains the necessary (but erroneously filed) complete claim(s) *element* and/or the necessary (but erroneously filed) complete description *element* (see Article 11(1)(iii)(d) and (e)) but the applicant nevertheless requests the incorporation by reference of all of the claims and/or all of the description contained in the priority application as a “*missing part*” in order to (at a later stage) completely replace the wrongly filed claims and/or description *elements* of the international application as originally filed with the equivalent “correct” version of those elements contained in the priority application.

4. Some Offices take the view that, under the above Rules, such practice is not permissible. These Offices argue that, by definition, the term “missing part” of the claims *element* or of the description *element* indicate 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 element 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. Such practice would result in great difficulties for the International Searching Authority, being faced with an international application with in essence two sets of claims and two descriptions (“Should the search be carried out on both? Should a lack of unity of invention objection be raised?”) or, where such incorporation was granted only after that Authority had already begun with the international search or even only after it had already established the international search report, being faced with the need to carry out a second search without the possibility to charge the applicant a second search fee for its work.

5. Other Offices take the view that such practice is permissible. 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. These Offices also refer to the fact that the Working Group, at its first session (see paragraphs 126 and 127 of document PCT/WG/1/16), had agreed that such practice was indeed permissible (“the Working Group noted that, in a case where the international application, on the international filing date, contained the necessary claim(s) element and description element (see Article 11(1)(iii)(d) and (e)), it was not possible under Rules 4.18 and 20.6(a) for the claims or description contained in a priority application to be incorporated as a missing element. However, it appeared to be possible, in such a case, for part or all of the description, or part or all of the claims, contained in the priority application to be incorporated under those Rules as a missing part.”), and that the Receiving Office Guidelines had been modified accordingly so as to clarify that, in the circumstances where incorporation by reference resulted in a duplicated set of description, claims or drawings, the set incorporated by reference was to be placed sequentially before the originally filed set.

6. Following the discussions at the sixth session of the Working Group (see paragraphs 263 to 277 of document PCT/WG/6/24) and further discussions at the twenty-first session of the Meeting of International Authorities held in February 2014 (see paragraphs 65 to 69 of document PCT/MIA/21/22, reproduced in the Annex to document PCT/WG/7/3), the International Bureau consulted with Offices of all Member States and with certain user organizations on the procedure for incorporation by reference of missing parts by way of a questionnaire (Circular C. PCT 1407, dated March 10, 2014). The questions posed to Offices and users are set out in the Annex to this document.

REPLIES TO QUESTIONNAIRE

7. Thirty-three replies were received in response to the questionnaire by Offices of the following members of the Working Group: Armenia, Australia, Austria, Bulgaria, Chile, China, Denmark, European Patent Office, Finland, Georgia, Hungary, Iceland, Israel, Japan, Latvia, Lithuania, Madagascar, Malaysia, New Zealand, Nordic Patent Institute, Norway, Portugal, Republic of Moldova, Russian Federation, Slovakia, Spain, Sweden, Thailand, Turkey, Ukraine, United Kingdom, United States of America, and Uzbekistan. The responses are summarized in the following paragraphs.

ALLOWING INCORPORATION BY REFERENCE OF A FULL SPECIFICATION AS A MISSING PART

8. In response to the question of whether an Office allows incorporation by reference of a full specification (Q1), several Offices indicated that they had no practical experience of cases where this question had to be decided. Of those Offices expressing an opinion, about one third were in favor of allowing the incorporation of a full specification and two thirds were against; about one fifth of responses did not express a view on this question. The distribution of responses was similar with regard to the opinion of Offices on whether a full specification may qualify as a missing part under Rule 20 and thus be given as the international filing date the date of receipt of the originally filed erroneous documents (Q3).

9. Three quarters of Offices responding to the questionnaire believed that Rule 20 was not clear and needed to be reviewed in order to reduce legal certainty (Q4). If the Rule were to be reviewed, just over than two fifths of respondents supported a clarification that the practice of incorporating a full specification into an erroneous filing should not be allowable, whereas just over one fifth of respondents supported a clarification to allow the incorporation of a full specification; the remainder (between one third and two fifths) were undecided or did not express an opinion on this question (Q5).

INCORPORATION BY REFERENCE OF MISSING PARTS FROM MULTIPLE PRIORITIES

10. Many Offices indicated that they had no experience where an applicant had requested incorporation by reference of missing parts from different priority applications (Q2). A clear majority of the Offices who stated an opinion on this question believed that such incorporation was allowable; only four Offices did not consider this to be the case. However, about a quarter of Offices did not express a view on this issue.

11. One Office responded by distinguishing between incorporation based on different filed missing parts based on different priorities (e.g. a missing part of the description is derived from one priority document, and a missing drawing is derived from a different priority document) and incorporation of one missing part from different priority documents (e.g. a missing part of the description is derived from two different priority documents). Under the practice at this Office, incorporation would be allowable in the former scenario, but not in the latter.

FEES FOR INCORPORATION OF MISSING PARTS

12. A clear majority (more than 90 per cent) of Offices were in favor of International Searching Authorities being entitled to charge an additional search fee to the applicant if Rule 20 were amended to cover the incorporation of a full specification into erroneous filings in cases where the search copy had already been sent to the International Searching Authority (Q6). A smaller majority (about 55 per cent) of responses supported receiving Offices being entitled to charge a fee for handing requests for incorporation by reference of missing parts, whereas just less than 20 per cent did not support this idea; the remainder of responses did not express a view on this matter.

IMPACT ON DISCLOSURE OF REPLACEMENT OF ERRONEOUS PARTS OR ELEMENTS BY INCORPORATION BY REFERENCE

13. A majority of Offices were concerned about the potential impact on disclosure of the invention and were favorable to dealing with replacement of erroneous parts or elements as an amendment under Chapter II (Q8). A minority (about one sixth of all responses) did not agree with this view and pointed out that the replacement of erroneous parts or elements can only be accepted by reference to a priority document, so the disclosure would not be affected. More than one quarter of Offices did not express an opinion on this issue.

ACCEPTANCE OF PRIORITY CLAIMS WITH THE SAME DATE AS THE INTERNATIONAL FILING DATE

14. Responses were divided on the questions relating to the acceptance of priority claims bearing the same date as the international filing date (Q9 to Q11). Other than the responses which did not express an opinion (about one quarter of all responses), Offices were roughly evenly split on whether they accepted priority claims bearing the same date, and also on whether such practice was in line with the Paris Convention and the PCT. Of those Offices that did not accept same date priority claims, most Offices did not wish for amendments to the provisions in the PCT to allow such priority claims to be accepted.

FURTHER WORK

15. The responses to the questionnaire clearly show that there is no consensus on any of the questions raised in the questionnaire, including on the question of whether an applicant should be allowed to incorporate a full specification as a missing part under Rule 20. There is thus no obvious solution to resolving the present situation of divergent practices across receiving Offices and designated/elected Offices. The International Bureau will therefore continue to work with interested Offices to explore possibilities that could achieve greater consistency and legal certainty for applicants, with a view to preparing a document for the eighth session of the Working Group. This document will also consider the related questions of incorporation by reference of missing parts from multiple priorities, the impact on disclosure in the patent specification by incorporation by reference and the charging of additional fees by receiving Offices and International Searching Authorities.

16. One possible solution which the International Bureau intends to explore could be to amend the Regulations so as to provide that receiving Offices should permit the incorporation of a full specification as a missing part under Rule 20 (together with a legal basis for International Searching Authorities to charge an additional search fee, for example, if, at the time of incorporation, the International Searching Authority had already commenced international search on the application), while clarifying that designated Offices whose national law would not allow for such incorporation could proceed with the application as if such incorporation had not taken place. Such an approach would at least result in a uniform practice by all receiving Offices (thus avoiding "forum shopping" among receiving Offices), give the International Searching Authority a clear basis for charging a second search fee and leave the option open to the applicant to pursue the matter further in the national phase before the designated Offices on the basis of the (divergent) national laws applied by those Offices.

17. The responses to the questionnaire also clearly show that there is no consensus among Member States on the issue of whether a priority claim contained in the international application based on an earlier application which has the same filing date as the international application is a valid priority claim within the meaning of PCT Article 8. Noting that PCT Article 8(2)(a) provides that "... the conditions for, and the effect of, any priority claim [contained in an international application] shall be as provided in Article 4 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property", this issue would appear to be not a PCT issue but a Paris Convention issue, namely, how to interpret Article 4(C)(2) of the Paris Convention ("These periods [of priority] shall start from the date of filing of the first application; the day of filing shall not be included in the period"). In particular, the issue would appear to be whether the second part of Section (C)(2), according to which the 12 months priority period only begins to run on the day following the day of filing of the first application, is to be interpreted as excluding as a basis for a priority claim a first application filed on the same day as (but prior to) the subsequent application. Member States may wish to consider whether this issue should be further explored in the Working Group (with the aim of agreeing a common interpretation of Article 4(C)(2) by all PCT Member States) or rather in the context of WIPO's Standing Committee on the Law of Patents (SCP).

18. The Working Group is invited to note the contents of the present document and to comment on the proposed further work set out in paragraphs 15 to 17, above.

[Annex follows]

Questionnaire

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?

[End of Annex and of document]