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Obvious mistakes and other corrections



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Overview

- Obvious mistakes
- A case: change of applicant or inventor
- A particular case: mixed languages
- One recommendation: corrections in the abstract
- Substantive amendments

Obvious mistakes (Rule 91.1 PCT) (1)

- Obvious mistakes can be rectified under Rule 91.1 PCT – **within 26 months from the priority date** – if:
 - the mistake is obvious
 - the rectification is obvious.

- A mistake is "obvious" if it is obvious to the competent authority that something else was intended than what appears in the document concerned AND nothing else could have been intended than the proposed rectification.

- It may be rectified:
 - if the applicant so requests
 - if the competent authority invites the applicant to do so.

Obvious mistakes (Rule 91.1 PCT) (2)

Competent authority:

- **RO** => for mistakes in the **PCT request** or in a correction thereof
- **ISA** => for mistakes in the **description, claims or drawings** or in a correction thereof
- **IPEA** => for mistakes in **the description, claims or drawings** or correction thereof or **amendments under Articles 19 or 34 PCT**
- **RO, ISA, IPEA or IB** => for mistakes in **any other document**

Obvious mistakes (Rule 91.1 PCT) (3)

- To determine whether a mistake is obvious, the competent authority may take into account only:
 - in case of mistake in **the description, claims and drawings** and, where applicable, a correction thereof: **the content of the description, claims and drawings**, and , where applicable, the correction or amendment concerned.
 - in case of a mistake in **the request** or a correction thereof, or in a **document under 91.1(b)(iv) PCT: the content of the international application**, where applicable of the correction, **and any other document (including the priority document) available at the applicable date.**

Obvious mistakes (Rule 91.1 PCT) (4)

- Applicable date:
 - In case of a mistake in a part of the international application: **the international filing date**
 - In case of a mistake in a document other than the international application: **the date on which the document was submitted**

- The request shall specify:
 - the mistake to be rectified
 - the proposed rectification and
 - at the option of the applicant, contain a brief explanation

Obvious mistakes (Rule 91.1 PCT) (5)

- A mistake shall not be rectifiable under this Rule in case of:
 - the mistake lies in the omission of **one or more entire elements** or **one or more entire sheets** => (Rule 20.4 and 20.5 PCT)
 - a mistake in the **abstract** => (Rule 38.3 PCT)
 - the mistake is in an **amendment under Art. 19 PCT** (unless IPEA is competent)
 - the mistake is in a **priority claim** or in a **notice correcting or adding a priority claim** under Rule 26bis.1(a),. **where the rectification would cause a change in the priority date** => (Rule 26bis PCT)

Obvious mistakes (Rule 91.1 PCT) (6)

- The authority shall **promptly decide** whether to authorise the rectification and **promptly notify** the decision taken
=> in case of refusal indicate the reasons
- **If the obvious mistake is rectified**, it shall be effective:
 - if the mistake is in the int. application, from the international filing date
 - if the mistake is in a document other than the int. application, from the date on which that document was submitted
- **In case of refusal**, the IB shall, upon request submitted by the applicant within two months from the date of refusal, publish the **request for rectification**, the **reasons for refusal** by the authority and **any further brief comments submitted by the applicant**.

Obvious mistakes (Rule 91.1 PCT) (7)

- The DO may not take the rectification into account if:
 - processing or examination has started prior to the date of notification of the decision

- The DO may disregard such rectification only if it finds that it would not have authorised it under Rule 91 PCT if it had been the competent authority.
 - **but** not before giving the applicant the opportunity to make observations

A clarification

- Rule 91 PCT aims at facilitating corrections (e.g. linguistic or spelling mistakes), but it does not encompass the deletion of entire pages of the description, claims or drawings
- Such a cancellation would affect the disclosure -> Articles 19 or 34 PCT
- Underlying principles shared with Rules 4.18 and 20 PCT (missing parts and elements)

A case: Change of applicant or inventor (1)

What was requested?

- Applicant submitted that there was an obvious mistake because there was a error in the person indicated as second applicant (request form)

What had happened?

- The second applicant indicated in the request form had transferred its rights to another person months before the international filing date
- A few of the inventors indicated in the request worked for the alleged applicant
- Oversight when filling in the request form
- Same mistake also in the priority document, which had been corrected after the international filing date

Change of applicant or inventor (2)

Assessment under Rule 91 PCT:

- Documents taken into account:
 - The request form
 - The content of the international application itself
 - The priority document submitted with the international application

- Applicable date:
 - International filing date
 - Why? Request form is part of the international application (Article 3(2) PCT)

- Outcome: Refusal under Rule 91 PCT

Change of applicant or inventor (3)

Recommended course of action: Rule 92*bis*.1 PCT

- Where? Request form or demand triggering PCT Chapter II
- What change?
 - Person, name or address of applicant, inventor or agent
 - Nationality or address of applicant
- Concerning whom? Applicant, inventor, agent or common representative
- Time limit: 30 months from the priority date

Change of applicant or inventor (4)

- Where to request: IB or receiving Office
- Evidence required: none during the international phase, but DOs or EOs may require the applicant to furnish evidence (e.g. deed of assignment) when entering the national phase (Rule 51bis.1(a) PCT)
- The IB informs the applicant of the record of the change (form PCT/IB/306)

A particular case: mixed languages (1)

- Starting point: The international application must be drafted in a single language (Article 11(1)(ii) PCT and Rule 12 PCT)

- Possible scenarios:
 - Whole international application filed in a language not accepted by the receiving Office (Rule 19.4 PCT)

 - Mixed languages in the text-matter of the drawings:
 - Invitation under Rule 26.3*ter*(a) PCT
 - Goal: reasonably uniform international publication (Rule 26.5 PCT)
 - Also applies to mixed languages in the request, abstract and sequence listings filed under Rule 5.2 PCT

A particular case: mixed languages (2)

- Mixed languages in the description or claims:
 - Sanction in Article 14(4) PCT (considered withdrawn)
 - Current practice: Rule 91 PCT applies
- Technical terms in another language:
 - State of the art
 - Language neutral
 - In general, translation is not required

One recommendation: Corrections in the abstract (1)

- Abstract: summary of the disclosure which can serve as a scanning tool (Rule 8 PCT)

- Importance of a high quality abstract from the outset:
 - Rule 91 PCT not applicable
 - Amendments under Article 19 PCT (claims) or Article 34 PCT (description, claims and drawings) may not encompass the abstract

- Procedure under Rule 38 PCT (missing or defective abstract)
 - If not compliant abstract, ISA shall establish it itself
 - The applicant may propose modifications up to one month after transmittal of the ISR

One recommendation: Corrections in the abstract (2)

- Disadvantages:
 - ISA not bound by the modifications proposed by the applicant
 - Possible delays in translations by the IB

- What to do?
 - International Authorities: seeking improvement of the guidelines
 - Applicants: invest efforts in a better abstract from the outset

Substantive changes: options after receiving ISR & WO/ISA

- **Before the IB:** Amendments of claims (Article 19, Rule 46 PCT)
 - within two months from the date of transmittal of ISR **or**
 - within 16 months from the priority date *

- **Before the IPEA:** Amendments of description, claims and drawings (Article 34 PCT)
 - within 3 months after sending of ISR **or**
 - 22 months from the priority date*
 - further opportunities to amend if sufficient time remains before entry into the national phase

(*whichever time limit expires later)

Amendments under Article 19 PCT (R. 46 PCT)

- shall not go beyond the disclosure in the international application as filed (Art. 19(2) PCT)
- **a brief statement may be filed** (Art. 19(1), R. 46.4 PCT)
- shall be accompanied by **replacement sheet(s)** and a **letter** (R. 46.5 PCT).

Amendments according to Article 19 PCT (R 46 PCT)

- will be published as part of the international application
 - including the claims filed in the original version
 - at 18 months from the priority date
 - also if filed after the expiration of the time limit but before the finalisation of the technical preparations for international publication

- do have central effect for every country

- might be useful for exact determination of preliminary protection

Amendments under Article 34 (R. 53.9 and 66.3 to 66.9 PCT)

Amendments during PCT Chapter II

- are possible for all parts of the international application
- shall be filed with the international prel. examining authority
- shall be filed:
 - together with the demand
 - not later than the expiration of the period to file the demand (R. 54*bis*.1(a) PCT).

Attention: The IPEA may not take into account amendments received after it has begun to draw up an opinion or report (R. 66.4*bis* PCT).

How are amendments made?

R. 46.5 and 66.8 PCT

- **A replacement sheet shall be submitted**
 - for every sheet which differ from the sheet originally filed.

- **If an entire sheet has been amended**
 - a letter shall draw attention to this amendment.

- regarding numbering and naming the amended claims, see Section 205 PCT administrative instructions.

- regarding renumbering in case of deletion, changing or addition of sheets, see section 311 PCT administrative instructions.

Replacement sheets, which contain amendments according to Art 19 or Art 34 PCT

Amendments under Article 19 (claims only)

- shall be filed directly before the IB
- If replacement sheets also include the rectification of obvious mistakes (R 91 PCT), the replacement sheets shall also be subject to authorization by the ISA.

Amendments according to Article 34 (Descriptions, Claims, Drawings)

- shall be filed directly before the competent IPEA
- If replacement sheets also include the rectification of obvious mistakes (R 91 PCT), the competent IPEA is also competent to authorize the rectifications.

Subst. Changes of the international application

	Art. 19 Changes	Art. 34 Changes
When	16 months from prio or 2 months from search report	Before expiry of time limit for filing a demand
What	Claims	Claims Description Drawings
Accessible to the public	Published by IB	After 30 months
Effect for	Every designated country	Every elected country
Examination	Formal examination by IB	Substantive examination by IPEA

A big thank you for your attention.

For further queries, please get back to:

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