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Practical advice and examples II

Incorporation by reference of missing elements or parts



Omitted parts or elements: background

- The PLT introduces the concept of incorporation by reference of missing parts (Article 5)
- Inclusion of accidentally omitted parts that are contained in an earlier application from which priority is validly claimed, without affected the international filing date

Omitted parts or elements: PCT framework

- Since 01.04.2007 implemented in the PCT, where the provision encompasses missing elements and missing parts
- Incompatibility with national law:
 - To date 7 Offices acting as RO: CU, CZ, DE, ID, IT, KR, MX
 - To date 8 Offices acting as DO/EO: CN, CU, CZ, DE, ID, KR, MX, TR

Missing element

- Requirement for obtaining an **international filing date**
- The **whole description** or the **full set of claims**
- If RO finds that an **element is missing** in the papers purporting to be an international application, it invites the applicant:
 - **to furnish** the required element: the international filing date (IFD) will be the date on which the missing element is furnished, or
 - **to confirm** that the element is incorporated by reference: if the conditions for incorporation are met, the IFD will be the date of receipt of the purported application

Missing part

- Definition: **part of the description, part of the claims or part or all of the drawings**
- If RO finds that a **part is missing** in the international application, it invites the applicant:
 - **to furnish** the missing part: the international filing date (IFD) will be the date on which the missing part is furnished, or
 - **to confirm** that the part is incorporated by reference: if the conditions for incorporation are met, the IFD is maintained

Formal requirements: time limit

- If upon invitation by RO/EP: within two months from the date of the invitation
- At the own motion of the applicant: within two months from the international filing date

Formal requirements: confirmation

- Written notice confirming that the element or part is incorporated by reference accompanied by:
 - Sheet(s) embodying the element or part as contained in the priority document
 - A copy of the priority document, if not already submitted
 - A translation if the earlier application is not in the language of the international application
 - An indication of where the missing part is in the priority document

Substantive requirement: ‘completely contained’

- The omitted part or element must be completely contained in the earlier application from which the priority was validly claimed
- It thus must be identical to the corresponding text/drawing in the priority document

Real examples: general (1/2)

Example 1: Missing part unnoticed	Example 2: Addition of priority claim
<ul style="list-style-type: none">• Several pages of the description are missing• The number of pages indicated in the check list of the request is accurate• The applicant found out once the two months from the filing date had expired and he informed the RO accordingly	<ul style="list-style-type: none">• No priority claim in the request form• A few pages of drawings appear to be missing• These are completely contained in an earlier application whose priority is claimed one week after the international filing date

Real examples: general (2/2)

Example 3: Sequence listing	Example 4: Abstract
<ul style="list-style-type: none">• References to a sequence listing in the description• No reference to a sequence listing in the check list• No sequence listing filed on the international filing date• Sequence listing completely contained in the international application whose priority is validly claimed	<ul style="list-style-type: none">• No abstract filed on the international filing date• Abstract completely contained in the international application whose priority is validly claimed

Real examples: drawings

Example 5: Missing drawings	Example 6: Missing feature in a drawing
<ul style="list-style-type: none">• The international application was filed by fax• The fax transmittal was completed shortly past the midnight of the last day of the priority period• The whole set of drawings had been transmitted past midnight• The drawings were completely contained in the priority application	<ul style="list-style-type: none">• A feature of a drawing had been omitted• The number of pages of drawings in the check list was accurate• The RO did not notice that a feature of a drawing was missing• The applicant noticed it shortly after the publication of the international application

Real examples: Erroneous filings

Example 7: Replacing

- Applicant inadvertently filed an earlier version of the set of claims
- The set of claims that he intended to file is contained in an earlier application from which priority is claimed

Advice to applicants

- This procedure is time consuming for both users and Offices and requests
- Always check the content of the acknowledgement of receipt after filing an international application

Effect on DO: full review (Rule 82ter.1 PCT)

- DOs may review decisions of ROs which have allowed incorporation by reference if the DO finds:
 - no priority document was furnished
 - the statement of incorporation was missing or not submitted
 - no required translation of the priority document was furnished, or
 - the element or part in question was not completely contained in the priority document

Effect on DO: outcome of review

- If the DO decides that the incorporation by reference did not meet the criteria:
 - The DO may treat the international application as if the international filing date had been accorded on the date on which the missing elements or parts were subsequently furnished
 - The DO has to give the applicant the opportunity to make observations on this outcome and to request that the late furnished missing parts be disregarded
- The above will also apply if the DO filed a notice of incompatibility

Entry into the European phase with the EPO

- Where the priority document is not in an EPO official language, the applicant must provide (Rule 51bis.1 PCT):
 - A translation of the priority document, and
 - In case of missing parts, an indication as to where that part is contained in the translation of the priority document

Developments at the PCT Working Group (1/2)

- Diverging practices based on the provisions on missing elements and parts among receiving Offices
- IB proposed to tackle instances of erroneous filings by drafting a new provision (PCT/WG/9)
- Not sufficient consensus gathered

Developments at the PCT Working Group (2/2)

- Workshop by various user groups on erroneous filings at the fringes of the PCT WG
- Compromise proposal tabled by the EPO:
 - Clarification of RO/GL on Rule 20.5 PCT
 - No replacement of erroneously filed elements or parts
 - Pre-publication phase (rule 20.7 PCT)
 - Possible additional search fee
 - Notification of incompatibility by RO/DO

Thank you for your attention!