



INCORPORATION OF ENTIRE MISSING ELEMENTS AND PARTS IN PCT APPLICATIONS BY CROSS REFERENCE

Greg Chambers
Partner

Phillips Ormonde Fitzpatrick



Imagine....



Esmerelda (Patent Attorney)



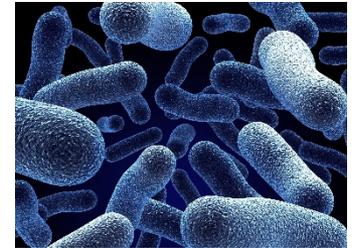
Nigel (Patent Office)



Luke (Assistant)



Biometrics Today, Inc.



Biotech Today, Inc.



ACTING FOR THE IP PROFESSION WORLD WIDE



Background

- There is a long history of harmonisation efforts in connection with application procedures – e.g. the Patent Law Treaty
- There are continuing efforts to streamline and harmonise patent filing processes and rules. Recent meetings of the Member States of WIPO to find an agreed common solution to the issue concerning erroneously filed documents is an example
- Harmonisation of the words in rules does not necessarily mean that there is harmonisation in practice
- There are currently different approaches taken by different Receiving Offices if there is an erroneously filed part or element in a PCT application – using the same rules
- In the case of erroneously filed documents, FICPI has proposed rules aimed at avoiding a loss of rights without adversely affecting third parties



Patent Law Treaty

- Adopted in 2000
- 42 Member States

Aims:

- Harmonise formal procedures in relation to patent applications
- Streamline formal procedures for such applications
- Make procedures more “user friendly”

Several of the provisions in the PLT have counterparts in the PCT rules



Missing Parts on Filing

Patent Law Treaty (Article 5.5):

“Where, in establishing the filing date, the Office finds that a part of the description appears to be missing from the application, or that the application refers to a drawing which appears to be missing from the application, the Office shall promptly notify the applicant accordingly”

N.B.- For example, if in the description, there is reference to a drawing, but the drawings filed do not correspond with the description, then the drawings would “appear to be missing from the application” even if other drawings were filed.



Missing Parts on Filing

Patent Law Treaty (Article 5.7(a)):

“...reference, made upon the filing of the application, in the language accepted by the Office, to a previously filed application shall, for the purposes of the filing date of the application, *replace* the description and any drawings” [in the event that there is a missing part at the time of filing]



Missing Parts on Filing

PCT Rule 4.18 (in summary):

A PCT request may contain a statement that where an element or a part of the description, claims or drawings are not otherwise contained in the international application, though completely contained in an earlier priority application, that that element or part can be incorporated by reference into the international application



Missing Parts on Filing

PCT Rule 20.5 (in summary):

If, on filing, the Receiving Office finds that a part of the description, claims or drawings, is *or appears* to be missing, it shall promptly invite the applicant to furnish the missing part, or confirm that the part was incorporated by reference under rule 20.6



PCT Rules

PCT Rule 20.6:

The applicant may provide a written notice confirming that an element or part is incorporated by reference. (In such a case, subject to other formalities the filing date is not lost. Must be done within two months of filing)



Competing interpretations of the current Rules

Some Receiving Offices take the position that if the wrong drawings, claims or description are filed with a PCT application, that the particular part or element is not “missing” and therefore the current incorporation by reference rules of the PCT cannot be used.

Other Receiving Offices take the position that if the wrong drawings, claims or description are present in the application, then the correct drawings, claims or description are “missing”.



More liberal approach more consistent with the rules of statutory interpretation

- The Mischief Rule of Interpretation
- Purposive construction
- Context of the word “missing” in the expression “is or appears to be missing” and in the PLT the use of the word “replace”



What happens to the material incorrectly filed?

Rule 48.2(I)

The International Bureau shall, upon a reasoned request by the applicant, received by the International Bureau prior to the completion of the technical preparations for international publication, omit from publication any information, if it finds that:

- 1) this information does not obviously serve the purpose of informing the public about the international application;
- 2) publication of such information would clearly prejudice the personal or economic interests of any person; and
- 3) there is no prevailing public interest to have access to that information



Current difficulties in connection with erroneously filed elements or parts in a PCT application

- Different practices applied by different Receiving Offices
- Potential publication of confidential materials that were erroneously filed
- Prospect that an approach taken by one Receiving Office could have an impact on the validity of any granted rights in those countries or regions that differently interpret the PCT Rules
- An applicant filing through a Receiving Office which will not treat an erroneously filed part as “missing” may be precluded from advancing the application – even in designated countries which have a different approach



Current proposal for amendment of the PCT Rules

Proposed Rule 20.5 bis(d)

- New provision to cover the case of “erroneously filed” parts – to be distinguished from “missing parts”. Parties to the PCT will have an option to lodge a reservation with respect to the new rule
- Possibility that the new rule will have an impact on the interpretation of the old rule and jeopardise earlier cases accorded more liberal treatment
- Under the proposed rules, the erroneously filed material will remain on the application (however, with the possibility of non-publication under Rule 48.2(I))



FICPI's position

- If an element or part of a PCT application is erroneously filed, the applicant should be entitled to withdraw that erroneously filed material from the application and replace it with the appropriate element or part through an incorporation by reference
- Within practical limits, this should be available at any time prior to publication



FICPI's position

- If necessary, the fact that the element or part has been erroneously filed might be supported by a declaration (in cases where it is not clear)
- The erroneously filed material should not be published or retained and should be returned
- FICPI is troubled by the current proposed rule changes. FICPI prefers no (or minimal) changes to the PCT rules, but each party to agree on accepted practice under those rules
- Clarification could be achieved for example by defining the terms “missing part” and “missing element”
- FICPI does not consider that its proposal would adversely affect third party rights



Questions and Comments?

FICPI CET Group 3

Michael Caine (michael.caine@ficpi.org)

Vladimir Rybakov (rybakov@ars-patent.com)