



9th February 2018

epi Comments on CA/PL 6/18 Corr. 1

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epi has studied CA/PL 6/18 Corr. 1 and wishes to present the following comments on it for the assistance of your Committee.

Assessment under the EPC of "erroneously" filed applications under the PCT upon entering the European phase

During the last years **epi** has followed the discussions on the interpretation of Rule 20.5 PCT and on the possibility to include in PCT an explicit provision that would allow the applicant, under certain clearly defined circumstances and within a limited time from filing date, to replace erroneously filed elements with the correct elements. For the replacement, the correct elements must be "completely contained" in the priority application.

After all these years of continuous deliberations at international level **epi** welcomes the proposal of EPO, which it is believed will unblock the deadlock in the PCT/WG. A relevant explicit legal basis in PCT would increase legal certainty and would allow the rectification of clear errors that may happen on digital era, without harming the interests of third parties

The proposal relates to the competence and procedures followed by the Receiving Offices. The issue of the "replacement of the erroneously filed elements" has two further aspects, i.e. the treatment of such requests by International Authorities and by Designated and Elected Offices. If the proposal is adopted, International Authorities and in particular International Searching Authorities will have the possibility to base the search on the correct¹ elements of the application. Designated and Elected Offices will be allowed to

¹ Whilst it appears correct to refer to "erroneously filed element or part", it should not be referred to anything "correct" in the international phase, that decision lying with the Designated or Elected Offices

submit a notification of incompatibility where the replacement is not compatible with the respective national law.

Regarding the conditions presented in paragraph 34 of CA/PL 6/18 Corr. 1 **epi** has the following remarks:

- a) **epi** agrees that that the incorporation by reference and the correction of the erroneously filed element or part should be allowed only in pre-publication phase for the protection of third parties.
- b) In CA/PL 6/18, it is suggested –and **epi** supports- to allow incorporation by reference and not to replace the erroneous filing submitted on the date of filing. As it is suggested in paragraph 33 *“the file could be put in order at a later stage during examination”*.
- c) **epi** suggests including an explicit provision to regulate if the erroneous documents
 - will be published –**epi** believes they should– and
 - if they will be considered during search –**epi** believes they should not.

The condition that relates to the additional fee implies that the search will be based on the correct documents and **epi** considers appropriate to clarify these points.

- d) If an additional fee is to be charged, it should be done only if the search of the erroneous filing has begun before the incorporation by reference and it will have to be re-done on the basis of the correct documents. As the deadline for the incorporation will be in most – very few – cases two months from filing, we would like to know, how often does the search of international applications start within two months from filing.
- e) It is understood that Designated Offices should have the possibility not to allow the correction of erroneous filings if this is not compatible with the respective national law. However, all Receiving Offices should offer the possibility to incorporate the elements or parts intended to be filed, so that applicants of all international applications will have the same treatment irrespective of their nationality, residence and competent Receiving Office that they use.

In conclusion, **epi** welcomes the proposal, which is found to be constructive within the PCT framework and we expect that the PCT/WG will be in a position to reach an agreement for a legal provision that would allow the applicant of international applications to correct conditionally an international application that contains an erroneously filed element or part.

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