


Institut der beim Europäischen Patentamt zugelassenen Vertreter
Institute of Professional Representatives before the European Patent Office
Institut des mandataires agréés près l'Office européen des brevets

Workshop on Erroneously-Filed Elements and Parts

19 June 2018 Geneva 1



Issues

- scale of problem/experience with current divergent practices of ROs and DOs?
- what would be the elements of a fair system from applicant and third party perspective?
- could the underlying problem be solved by other means?

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RO	DO
Yes*	Yes
	No
No	[Yes]
	No

- fairness for the applicant
- rights of third parties
- requirements for incorporation : Rule 20.6(b)
 - priority claimed on the date on which one or more elements ... were first received (Rule 4.18)
 - “completely contained” (Rule 20.6(b))
- any incorporation would be allowed prior to publication
- clear indication in publication

- clearly exceptional and few cases: not a heavy burden for ROs and IAs
- appropriate to clarify the practice of IAs during IS and IPE

- GL/PCT-EPO B-III, 2.3.3 Incorporating missing parts or a missing element completely contained in the priority document
- ... The examiner checks whether the RO's assessment of the "completely contained" criterion was correct (see GL/PCT-EPO H-II, 2.2.2). If a RO has erroneously considered that the missing part(s) or the missing element were completely contained in the priority document, the search should be extended to include documents which would be relevant if the application were to be redated (such documents can be cited as "L" in the ISR).



Elements of the solution

- include a Rule to allow correction of “erroneously filed part or parts” under clear conditions
- any correction of the erroneously filed element or part should be allowed only in pre-publication phase
- incorporate the “correct part” without removing the “erroneously filed part”.
- the international publication should include both the incorporated part and the “erroneously filed part”
- the incorporated part is to be considered for the international search

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PCT/WG/11/21: Suggestion by EPO

- amend the PCT Receiving Office Guidelines / Rule 20.5
- not allow the “replacement” of the erroneous element or part but only the incorporation by reference of the correct element or part
- the “incorporation by reference” only be allowed in the pre-publication phase
- the International Searching Authority should be entitled to charge an additional fee if the search of the erroneous filing has already been started
 - clarify that the “correct” elements will be considered for the IS

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- receiving Offices and designated Offices should be allowed to submit a notification of incompatibility where their national law does not allow the correction of erroneous filings
- notification of incompatibility by a RO: Would it be possible to transmit the International Application to the IB following Rule 19.4(a)(iii)?

**Thank you
for your attention!**