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COOPERATION TREATY (PCT)

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“MISSING PART” REQUIREMENTS:

REVISED PROPOSALS CONCERNING RULES 4.18 AND 20

*Document prepared by the International Bureau*

## REVISED PROPOSALS

1. Document PCT/R/WG/6/4 contains proposals designed to align procedures under the Patent Cooperation Treaty (PCT) with those under the Patent Law Treaty (PLT) in cases where elements or parts of an international application are missing. On reflection, it appears that the provisions of Rule 20 as proposed to be amended would benefit from further rationalization, taking into account the broader range of circumstances covered by it in comparison with the existing text of the Rule. Revised proposed amendments of Rule 20, and also (consequentially) of Rule 4.18, are presented in the Annex to the present document.
2. By and large, the revised proposals do not differ in their legal effect from those contained in document PCT/R/WG/6/4. Rather, it is intended to set out the various steps to be taken in a more logical and transparent way, reducing duplication of passages in the drafting, and avoiding circuitous references.
3. A more detailed explanation of the proposed revised general structure of Rule 20 appears in the following paragraphs. Certain changes in the proposed procedures themselves, as distinct from the drafting of the provisions, are explained further below. References to particular provisions are, except where otherwise specified, to those set out in the Annex.

Proposed amendments set out in document PCT/R/WG/6/4 relating to Rules other than Rules 4.18 and 20 would in general be maintained, subject to future review if it is decided to proceed with the revised proposals concerning Rules 4.18 and 20.

*Revised Structure of Rule 20*

4. Certain procedures relating to “missing elements” (the entire description or claims) and “missing parts” (of the description, claims or drawings, including completely missing drawings), are substantially the same in the Annex as in document PCT/R/WG/6/4, although in that document they appear in separate and differently worded provisions. Those procedures are all dealt with in the Annex in a more uniform way, in relation to both missing elements and missing parts, in Rule 20.3 (concerning invitations to correct) and Rule 20.5 (concerning incorporation by reference).

5. The making of a final (positive or negative) determination under Article 11(1) must await the conclusion, where applicable, of other procedures relating to the late furnishing, or incorporation by reference, of missing elements and missing parts. That final determination therefore seems to be better placed towards the end of Rule 20; see Rules 20.6 and 20.7 as they appear in the Annex.

6. A clear distinction is made between, on the one hand, defects under Article 11(1)(i), (ii) and (iii)(a) to (c) (relating to nationality and residence requirements, language, indication that application is intended as an international application, designations of countries, and name of applicant) and, on the other hand, defects under Article 11(1)(iii)(d) and (e) (missing elements – description and claims). Invitations to correct the former are dealt with in the Annex in Rule 20.2 and invitations to correct the latter, together with invitations relating to missing parts, in Rule 20.3.

7. The incorporation by reference of missing elements and of missing parts follows the same general principles and procedures. The provisions concerned are therefore proposed in the Annex to be combined in Rule 20.5.

8. The consequences of furnishing missing elements in cases where they cannot be incorporated by reference are different from the consequences in relation to missing parts. The inclusion of missing elements always affects the according of a filing date and is thus left, in the Annex, to Rule 20.6 (relating to positive determinations under Article 11(1)) and Rule 20.7 (relating to negative determinations under Article 11(1)). The inclusion of missing parts may or may not affect the filing date, and is dealt with in Rule 20.4.

9. The opportunity has been taken to co-locate in Rule 20.6 certain provisions which all relate to the making of a positive determination under Article 11(1). Rule 20.6(a) to (c) are in substance the same as Rule 20.2(a) to (c) in document PCT/R/WG/6/4. Rule 20.6(b) and (d) are the same in substance as, respectively, Rules 20.3(c) and 20.7(e) in document PCT/R/WG/6/4.

*Changed Procedures in Comparison with Document PCT/R/WG/6/4*

10. As a result of making a distinction between different kinds of defects under Article 11(1)(1) (see paragraph 6, above), the content of the invitation sent to the applicant is different in the two cases. Under Rule 20.2, the applicant is invited to correct defects under Article 11(1)(i), (ii) and (iii)(a) to (c) by way of furnishing a correction under Article 11(2).

Under Rule 20.3, the applicant is invited to make any of several possible responses in connection with missing elements or missing parts. The possible responses include furnishing a correction under Article 11(2), furnishing the missing part (for inclusion in the application under Rule 20.4), and making a request under Rule 20.5 (for the incorporation by reference of the missing element or missing part). Under both of Rules 20.2 and 20.3, the applicant is also invited to make observations.

11. It does not appear to be necessary, in the context of the revised Rule 20.3, to complicate the drafting by spelling out that a missing part of the claims includes the case where one or more entire claims are missing, and that a missing part of the drawings includes the case where one or more entire drawings are missing. If the matter is felt to be in need of clarification, that could be done by way of an understanding to be expressed by the Assembly at the time of the adoption of the amended Rule.

12. Rule 20.6(c) in document PCT/R/WG/6/4 included a requirement that the applicant must, in connection with a request for incorporation by reference of missing elements or missing parts, furnish the relevant priority document. In effect, that provision did little more than restate, in different words and in a different context, the obligation which applies in any event under Rule 17.1. On further consideration, it seems preferable to avoid restating the requirement that Rule 17.1 be complied with and, rather, to spell out the consequence of non-compliance with Rule 17.1 in the context of the Rule concerning incorporation by reference (Rule 20.5 in the present document). That consequence, as expressed in revised Rule 20.5(c), would be that a designated Office may, in the national phase, disregard the incorporation by reference. That is parallel to the consequence already provided by existing Rule 17.1(c), namely, the disregarding of the priority claim itself, and Rule 20.5(c) also imports *mutatis mutandis* the safeguards for applicants that are contained in existing Rule 17.1(c) and (d).

13. Rule 20.8 as set out in the Annex, relating to time limits under Rule 20, is the same in substance as Rule 20.7 in document PCT/R/WG/6/4, but a proviso has been added relating to the late furnishing of corrections and requests for incorporation by reference. The substance of that proviso appeared in document PCT/R/WG/6/4 as Rule 20.3(d), but it seems more appropriate to include it in Rule 20.8.

*14. The Working Group is invited to consider the revised proposals relating to Rules 4.18 and 20 contained in the Annex.*

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

“MISSING PART” REQUIREMENTS:

REVISED PROPOSALS CONCERNING RULES 4.18 AND 20<sup>1</sup>

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<sup>1</sup> The revised proposals contained in this Annex are presented only as a “clean copy” without highlighting of changes in comparison with either the existing text of Rules 4.18 and 20 or with the proposals contained in document PCT/R/WG/6/4. However, footnotes are included to indicate the location of corresponding provisions in document PCT/R/WG/6/4.

**Rule 4**

**The Request (Contents)**

4.1 to 4.17 [As in document PCT/R/WG/4]

4.18 *Statement for the Purposes of Incorporation by Reference*<sup>2</sup>

The request may contain a statement that, if an element or a part of the application referred to in Rule 20.3(i) or (ii) is missing from the international application, the same element or part contained in an earlier application the priority of which is claimed in the international application is, subject to compliance with the requirements of Rule 20.5(a) and (b), incorporated by reference in the international application.

4.19 [As in document PCT/R/WG/4]

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<sup>2</sup> Rule 4.18 is the same as Rule 4.18 in document PCT/R/WG/6/4 except for changes consequential on the revised drafting of Rule 20.

**Rule 20**

**International Filing Date**

20.1 *Determination Under Article 11(1)*<sup>3</sup>

(a) Promptly after receipt of the papers purporting to be an international application, the receiving Office shall determine whether the papers comply with the requirements of Article 11(1).

(b) For the purposes of Article 11(1)(iii)(c), it shall be sufficient to indicate the name of the applicant in a way which allows the identity of the applicant to be established even if the name is misspelled, the given names are not fully indicated, or, in the case of legal entities, the indication of the name is abbreviated or incomplete.

(c) For the purposes of Article 11(1)(ii), it shall be sufficient that the part which appears to be a description (other than any sequence listing part thereof) and the part which appears to be a claim or claims be in a language accepted by the receiving Office under Rule 12.1(a).

(d) If, on October 1, 1997, paragraph (c) is not compatible with the national law applied by the receiving Office, paragraph (c) shall not apply to that receiving Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by December 31, 1997. The information received shall be promptly published by the International Bureau in the Gazette.

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<sup>3</sup> The text of Rule 20.1 is the same as Rule 20.1 in document PCT/R/WG/6/4.

*20.2 Invitation to Correct Defects Under Article 11(1)(i), (ii) and (iii)(a) to (c)*<sup>4</sup>

Where, in determining whether the papers purporting to be an international application comply with the requirements of Article 11(1), the receiving Office finds that any of the requirements of Article 11(1)(i), (ii) or (iii)(a) to (c) are not met, it shall promptly invite the applicant to furnish the required correction under Article 11(2) and to make observations, if any, within the applicable time limit under Rule 20.8. If that time limit expires after the expiration of 12 months from the filing date of any application whose priority is claimed, the receiving Office shall call that circumstance to the attention of the applicant.

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<sup>4</sup> Rule 20.2 derives from Rule 20.3(a) and (b) in document PCT/R/WG/6/4, but is restricted in its scope to defects under Article 11(1)(i), (ii) and (iii)(a) to (c), leaving defects under Article 11(1)(iii)(d) and (e) to be dealt with in Rule 20.3. See paragraphs 6 and 10 in the main body of the present document.

20.3 *Invitation in Connection with Missing Elements Under Article 11(1)(iii)(d) and (e) or Missing Parts of Description, Claims and Drawings*<sup>5</sup>

Where, in determining whether the papers purporting to be an international application comply with the requirements of Article 11(1), the receiving Office finds that any of the following elements or parts are or appear to be missing:

- (i) an element referred to in Article 11(1)(iii)(d) or (e);
  
- (ii) a part of the description, claims or drawings, not including the case where an entire element referred to in Article 11(1)(iii)(d) or (e) is or appears to be missing but including the case where all of the drawings are or appear to be missing;

it shall promptly invite the applicant, as applicable and at the applicant's option, to furnish the missing element by way of a correction under Article 11(2), to furnish the missing part or to make a request under Rule 20.5, and to make observations, if any, within the applicable time limit under Rule 20.8. If that time limit expires after the expiration of 12 months from the filing date of any application whose priority is claimed, the receiving Office shall call that circumstance to the attention of the applicant.

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<sup>5</sup> Rule 20.3, insofar as it relates to missing parts, derives from Rule 20.5 in document PCT/R/WG/6/4. Insofar as it relates to missing elements, the subject matter of Rule 20.3 was not dealt with in express terms in document PCT/R/WG/6/4, but rather was covered in that document by Rule 20.3(a) and (b). See paragraphs 4, 6 and 10 in the main body of the present document.

20.4 *Later Furnishing of Missing Parts of Description, Claims and Drawings*<sup>6</sup>

(a) Where the applicant, whether in response to an invitation under Rule 20.3 or otherwise, furnishes to the receiving Office a missing part referred to in Rule 20.3(ii):

- (i) on or before the date on which all of the requirements of Article 11(1) are complied with, that part shall be included in the international application;
- (ii) after the date on which all of the requirements of Article 11(1) are complied with but within the applicable time limit under Rule 20.8, that part shall be included in the international application and, subject to Rule 20.5, the international filing date shall be corrected to the date on which the receiving Office received it.

The receiving Office shall promptly notify the applicant and the International Bureau accordingly.

(b) Where the international filing date has been corrected under paragraph (a)(ii), the applicant may, in a notice submitted to the receiving Office within one month from the date of the notification under paragraph (a), request that the missing part concerned be disregarded, in which case the missing part shall be considered not to have been furnished and the correction of the international filing date under that paragraph shall be considered not to have been made. The receiving Office shall promptly notify the applicant and the International Bureau accordingly.

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<sup>6</sup> Rule 20.4 derives from Rule 20.5(c) to (e) in document PCT/R/WG/6/4.

20.5 *Incorporation by Reference of Missing Elements and Missing Parts*<sup>7</sup>

(a) Where:

- (i) on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, the international application claims the priority of an earlier application and contains a statement under Rule 4.18 for the purposes of incorporation by reference; and
- (ii) an element or a part of that earlier application is the same as, respectively, an element or a part referred to in Rule 20.3(i) or (ii) that is missing from the international application;

that element or part shall, on the request of the applicant in accordance with paragraph (b), be considered to have been contained in the international application on that date and the receiving Office shall promptly notify the applicant and the International Bureau accordingly.

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<sup>7</sup> Rule 20.5(a), (b) and (d) corresponds to Rule 20.6(a), (b) and (d) in document PCT/R/WG/6/4. The text of Rule 20.5(c) is new, but is intended to deal with the same issue as that raised in document PCT/R/WG/6/4 in connection with Rule 20.6(c). See paragraphs 7 and 12 in the main body of the present document.

*[Rule 20.5, continued]*

(b) A request under paragraph (a) shall be submitted to the receiving Office within the applicable time limit under Rule 20.8 and shall be accompanied by:

(i) sheets embodying the missing element or missing part;

(ii) a copy of the earlier application, unless that earlier application was filed with the receiving Office in its capacity as a national Office or is, before the expiration of that time limit, available to the receiving Office in the form of the priority document;

(iii) where the earlier application is not in the same language accepted by the receiving Office under Rule 12.1(a) for the international application, a translation of the earlier application into that language;

(iv) in the case of a missing part, an indication as to where the missing part is contained in the earlier application.

(c) Where the requirements of none of paragraphs (a), (b) and (b-*bis*) of Rule 17.1 are complied with, a designated Office may disregard the operation of paragraph (a) of this Rule, provided that Rule 17.1(c) and (d) shall apply *mutatis mutandis*.

*[Rule 20.5, continued]*

(d) If, on [*date of adoption of these modifications by the PCT Assembly*], paragraphs (a) and (b) are not compatible with the national law applied by the receiving Office, those paragraphs shall not apply to that receiving Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [*three months from the date of adoption of these modifications by the PCT Assembly*]. The information received shall be promptly published by the International Bureau in the Gazette.

20.6 *Positive Determination Under Article 11(1)*<sup>8</sup>

(a) If the determination under Article 11(1) is positive, the receiving Office shall stamp the request as prescribed by the Administrative Instructions.

(b) The copy whose request has been so stamped shall be the record copy of the international application.

(c) The receiving Office shall promptly notify the applicant of the international application number and the international filing date. At the same time, it shall send to the International Bureau a copy of the notification sent to the applicant, except where it has already sent, or is sending at the same time, the record copy to the International Bureau under Rule 22.1(a).

(d) Where one or more of the requirements of Article 11(1) are not complied with on the date of receipt of the purported international application but are complied with on a later date falling within the applicable time limit under Rule 20.8, the international filing date shall, subject to Rule 20.5, be that later date and the receiving Office shall proceed as provided in paragraphs (a) to (c) of this Rule.

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<sup>8</sup> Rule 20.6(a) to (c) corresponds to Rule 20.2(a) to (c) in document PCT/R/WG/6/4. Rule 20.6(d) corresponds to Rule 20.3(c) in that document. Rule 20.6(e) corresponds to Rule 20.8 in document PCT/R/WG/6/4.

*[Rule 20.6, continued]*

(e) If the receiving Office later discovers, or on the basis of the applicant's reply realizes, that it has erred in issuing an invitation under Rule 20.2 or 20.3 since the requirements of Article 11(1) were fulfilled when the papers were received, it shall proceed as provided in paragraphs (a) to (c) of this Rule.

20.7 *Negative Determination Under Article 11(1)*<sup>9</sup>

If the receiving Office does not receive, within the applicable time limit under Rule 20.8, a correction under Article 11(2) or a request in accordance with Rule 20.5(a) and (b), or if such a correction or request has been received but the application still does not fulfill the requirements of Article 11(1), the receiving Office shall:

(i) promptly notify the applicant that the application is not and will not be treated as an international application and shall indicate the reasons therefor;

(ii) notify the International Bureau that the number it has marked on the papers will not be used as an international application number;

(iii) keep the papers constituting the purported international application and any correspondence relating thereto as provided in Rule 93.1; and

(iv) send a copy of the said papers to the International Bureau where, pursuant to a request by the applicant under Article 25(1), the International Bureau needs such a copy and specially asks for it.

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<sup>9</sup> Rule 20.7 corresponds to Rule 20.4 in document PCT/R/WG/6/4.

20.8 *Time Limit for Correcting Defects or Furnishing or Incorporating Missing Elements or Missing Parts*<sup>10</sup>

The applicable time limit referred to in Rules 20.2, 20.3, 20.4(a)(ii), 20.5(b), 20.6(d) and 20.7 shall be:

- (i) where an invitation under Rule 20.2 or 20.3, as applicable, was sent to the applicant, [one month] [two months] from the date of the invitation;
- (ii) where no such invitation was sent to the applicant, [one month] [two months] from the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office;

provided that any correction under Article 11(2), or any request under Rule 20.5, that is received by the receiving Office after the expiration of the applicable time limit under this Rule but before that Office sends a notification to the applicant under Rule 20.7(i) shall be taken into account in determining whether the papers purporting to be an international application comply with the requirements under Article 11(1).

[End of Annex and of document]

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<sup>10</sup> The chapeau and items (i) and (ii) of Rule 20.8 correspond to Rule 20.7 in document PCT/R/WG/6/4. The proviso at the end of Rule 20.8 derives from Rule 20.3(d) in that document. See paragraphs 12 and 13 in the main body of the present document.