



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

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PCT Rules – Erroneously filed elements or parts thereof

FICPI believes that applicants should be permitted to correct very formal and obvious mistakes without losing substantive rights. In this regard, FICPI supports the objectives of the Patent Law Treaty (PLT), and welcomed the introduction of PLT-type provisions into the PCT. Clearly, those provisions added to the PCT were intended to serve the same purpose as the PLT, namely to make the patent system more user-friendly while preserving a proper balance between the interests of various stakeholders.

For FICPI, this extends to the substitution of erroneously filed elements or parts thereof with the correct element or part as contained wholly in one or more priority applications, provided that the requirements of Rule 20 are met, with certain safeguards, as indicated by FICPI at the workshop organised by the International Bureau in June last year. FICPI is concerned that the amendments to the PCT Rules proposed by the PCT Working Group to be considered at this meeting will not achieve the intended purpose of aligning practices with respect to the incorporation by reference of elements or parts to be found in a priority application, but will instead introduce further uncertainty and divergence of practices within Offices.

The increased use of ePCT increases the risk for incorrect documents to be uploaded from a computer. Accordingly, there is a need for a remedial provision. Of particular concern is the situation where the incorrect document is a different kind of document (e.g. a claim instead of a description) or is clearly related to a different invention. In such circumstances there will still be uncertainty as to whether the “element” of the subject application is missing or erroneously filed, even with the proposed rule changes. In the business world, if such a document was inadvertently sent to a party, it would be either returned by that party without keeping a copy, or all copies would be destroyed by the party. FICPI believes that it is appropriate for WIPO or a Receiving Office to take similar action, and does not support a process that would result in retaining such an incorrect document in WIPO’s database. In FICPI’s view, neither publishing the document marked “erroneously filed” as proposed, nor retaining the document unpublished in the WIPO file following a request under Rule 48.2(1), serves the interests of any of the stakeholders.

Therefore, FICPI believes it is appropriate for the International Bureau and the PCT Working Group to resolve this problem by introducing additional or alternative rule changes into the PCT Regulations, so as to achieve a better alignment between the various PCT Authorities with respect to the incorporation by reference of elements or parts to be



found in a priority application. The incorrect document should be totally removed from the application, possibly by introducing a new rule to cover such removal.

About FICPI

Founded over 100 years ago, **FICPI** is the international representative association for IP attorneys in private practice throughout the world, with about 5,500 members in 86 countries and regions, including Europe, China, Japan, South Korea and USA.

FICPI aims to study all administrative or legislative reforms and all improvements to international treaties and conventions, with the object of facilitating the exercise by inventors and IP owners of their rights, of increasing their security, and of simplifying procedure or formalities.

In pursuance of this aim, **FICPI** strives to offer well balanced opinions on proposed international, regional and national legislation based on its member' experience with a great diversity of clients having a wide range of different levels of knowledge, experience and business needs of the IP system.

IMPORTANT NOTE:

The views set forth in this paper have been provisionally approved by the Bureau of FICPI and are subject to final approval by the Executive Committee (ExCo). The content of the paper may therefore change following review by the ExCo.

The International Federation of Intellectual Property Attorneys (FICPI) is the global representative body for intellectual property attorneys in private practice. FICPI's opinions are based on its members' experiences with a great diversity of clients having a wide range of different levels of knowledge, experience and business needs of the IP system.

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The Australian Federation of Intellectual Property Attorneys, FICPI Canada, Association of Danish Intellectual Property Attorneys (ADIPA), Suomen Patenttiasiamiesyhdistys ry, Association de Conseils en Propriété Industrielle (ACPI), Patentanwaltskammer, Collegio Italiano dei Consulenti in Proprietà Industriale, Japanese Association of FICPI, Norske Patentingeniørers Forening (NPF), Associação Portuguesa dos Consultores em Propriedade Industria I (ACPI), F.I.C.P.I South Africa, the International Federation of Intellectual Property Attorneys – Swedish Association, Verband Schweizerischer Patent und Markenanwälte (VSP) and the British Association of the International Federation of Intellectual Property Attorneys are members of FICPI.

FICPI has national sections in Argentina, Austria, Belgium, Brazil, Chile, China, Czech Republic, Greece, Hungary, India, Ireland, Israel, Malaysia, Mexico, Netherlands, New Zealand, Romania, Russia, Singapore, South Korea, Spain, Turkey and the United States of America, a regional section covering for the Andean States (Bolivia, Colombia, Ecuador, Perú and Venezuela), a provisional national section in Poland and individual members in a further 41 countries and regions.

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