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PROPOSALS WITH RESPECT TO MISSING ELEMENTS AND PARTS

Document prepared by the United States of America

SUMMARY

1. This document contains several proposals for amendment of the Regulations under the PCT as they relate to missing elements and parts. Specifically, the document contains two proposals as follows: (i) a proposal to require that the priority claim positively identify the prior application on the international filing date; and (ii) a proposal to provide a mechanism for the receiving Office to invite applicant to submit a correction of the confirmation of incorporation in certain situations. Finally, the document contains a recommendation that the Receiving Office Guidelines be amended to instruct receiving Offices on the treatment of applications that, after incorporation by reference, have two (2) sets of descriptions, claims, and/or drawings.

BACKGROUND

2. On April 1, 2007, the Regulations under the PCT, and specifically Rules¹ 4 and 20, were amended with respect to providing missing elements or parts of the international application. Under the Rules, applicants could insert missing elements or parts and receive a

¹ References in this document to "Articles" and "Rules" are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT ("the Regulations"), or to such provisions as proposed to be amended or added, as the case may be.

new international filing date. Additionally, the Rules were amended to provide a mechanism whereby applicants could introduce missing elements or parts without the loss of the original filing date. Specifically, if applicant included an incorporation by reference statement in the PCT request and the missing subject matter was completely contained in an application to which priority was claimed on the international filing date, the missing elements or parts could be submitted without the loss of the original filing date. In the course of processing applications under the amended Rules, the United States Patent and Trademark Office (USPTO) has identified three (3) issues that need to be addressed.

Issue 1: Specificity of the Priority Claim

3. Currently, Rule 4.18 is not specific with respect to what extent the priority application must be identified at the time of filing. Instead, it merely requires that the international application “[claim] the priority of an earlier application.” Further, in accordance with the correction provisions of Rule 26*bis*, in order for an application to claim priority of an earlier application, it is sufficient for the PCT request form to merely identify any one of the date of filing, the application number, and the country, Authority or Office of filing.

4. Given these facts, the following scenario could occur:

a) Applicant files a plurality of national applications, each drawn to different subject matter, in country X.

b) Within one year of the first filed national application, applicant files an international application request form which in Box VI only sets forth country X as the country of filing, and which includes a statement of incorporation by reference under Rule 4.18. However, the request is not accompanied by a description, claims, drawings or abstract.

c) Within the time periods under Rules 20.7 and 26*bis*, applicant decides which prior application should be pursued as an international filing, and files a correction under Rule 26*bis* and a confirmation of incorporation by reference under Rule 20.6.

5. Under this fact pattern there is absolutely no legal certainty for the International Authorities or the designated Offices as to what subject matter constituted the international application on its filing date. In fact, a strong argument could be made that the application was not in compliance with Articles 5 to 7 on the international filing date.

6. Therefore, it is proposed that the Rules be amended to require that the prior application be sufficiently identified so as to allow the receiving Office to be able to positively identify, on the international filing date, the prior application to which priority is being claimed and which is being incorporated by reference. Ideally, the best identifier for the prior application is its application number. However, in many instances, applicant has not received the application number of the prior application at the time of filing the international application. Therefore, it would seem proper to allow the use of other identifiers (e.g., an attorney docket number), provided that the International Authorities and national Offices can be certain as to what subject matter constituted the international application on the international filing date.

Issue 2: Correction of the Confirmation of Incorporation by Reference

7. The USPTO, acting in its capacity as a receiving Office, has encountered situations where an applicant requests incorporation by reference of an element or part of the application, but the notice confirming the incorporation by reference of the earlier application is not in compliance with Rule 20.6(a). Specifically, in many instances the confirmation does not comply with Rule 20.6(a)(i) in that the element or part as submitted contains minor differences from the earlier application and as such cannot be considered to be completely contained in the earlier application.

8. For example, in situations where the entire description has been omitted, applicant will often submit a copy of the description which includes an additional sentence referencing the earlier filed application. The presence of the single additional sentence renders the description as not being “completely contained in the earlier application” and therefore not acceptable to be entered as of the original application receipt date under the incorporation by reference provisions. Since Rule 20 does not currently provide a mechanism for correction of a confirmation of incorporation by reference, there is no mechanism whereby the receiving Office can invite applicant to resubmit the missing element/part without the different subject matter. Under this scenario, the receiving Office has no alternative other than to accord the international application a later international filing date for such an easily correctable offense.

9. Therefore, it is proposed that Rule 20 be amended to provide a procedure whereby a receiving Office may invite applicant to correct a defective submission under Rule 20.6.

Issue 3: Duplicate Matter

10. The USPTO has encountered numerous international applications where applicants have discovered after filing the application that an incorrect element (e.g., set of claims or drawings) has been inadvertently filed in the application. In an effort to correct the error, applicants will submit the “correct” element(s) under the provisions of Rule 20. However, this results in an application which contains two sets of the element(s). These two sets of the element(s) must be renumbered to be consistent with one another, with the later filed element usually being entered into the application following the originally filed element.

11. In many cases, the originally filed element(s) may be directed to subject matter unrelated to the later filed element(s) and the rest of the application. This can cause confusion and extra workload on the ISA/IPEA, especially when dealing with duplicate claims, as the Authorities are forced to consider claims which the applicant never intended to form part of the application. Further, the placement of the later filed claims after the originally filed claims can cause problems with respect to lack of unity in that the originally filed and undesired set of claims will be considered to be the “main invention” in accordance with Article 17(3). As a result, in order to get the desired later filed claims searched, applicant will have to pay additional search fees.

12. Therefore, it is recommended that specific provision should be made in the Guidelines on the handling of such duplicate matter. Specifically, it is recommended that the Guidelines be modified to provide that, in situations where a submission under Rule 20 results in duplicate elements in the international application, the later filed element(s) be placed sequentially before the originally filed element(s) so as to simplify the processing of the application before the International Authorities.

PROPOSALS WITH RESPECT TO AMENDING RULES 4 AND 20 AND
RECOMMENDATIONS WITH RESPECT TO THE RECEIVING OFFICE GUIDELINES

13. It is proposed that Rules 4 and 20 be amended to address issues 1 and 2 as discussed above. Further, it is recommended that that the Receiving Office Guidelines be modified as discussed above.

14. The Working Group is invited to:

(i) consider the proposals to amend the Rules contained in the Annex; and

(ii) consider whether the Receiving Office Guidelines should be modified as discussed above.

[Annex follows]

ANNEX

PROPOSALS WITH RESPECT TO MISSING ELEMENTS AND PARTS²

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² Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

Rule 4

The Request (Contents)

4.1 to 4.17 [No change]

4.18 *Statement of Incorporation by Reference*

(a) Where the international application, on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office, claims the priority of an earlier application, the request may contain a statement that, where an element of the international application referred to in Article 11(1)(iii)(d) or (e) or a part of the description, claims or drawings referred to in Rule 20.5(a) is not otherwise contained in the international application but is completely contained in the earlier application, that element or part is, subject to confirmation under Rule 20.6, incorporated by reference in the international application for the purposes of Rule 20.6. Such a statement, if not contained in the request on that date, may be added to the request if, and only if, it was otherwise contained in, or submitted with, the international application on that date.

(b) In order for the statement under paragraph (a) to be effective for the purposes of Rule 20.6, the earlier application must be sufficiently identified on the date on which one or more elements referred to in Article 11(1)(iii) were first received by the receiving Office so as to allow the receiving Office to identify a single earlier application to which priority is being claimed.

Rule 20

International Filing Date

20.1 to 20.5 [No change]

20.6 *Confirmation of Incorporation by Reference of Elements and Parts*

(a) and (b) [No change]

(c) Where the receiving Office, subject to paragraph (d), finds that a requirement under Rule 4.18 or paragraph (a) has not been complied with or that the element or part referred to in paragraph (a) is not completely contained in the earlier application concerned, the receiving Office shall proceed as provided for in Rule 20.3(b)(i), 20.5(b) or 20.5(c), as the case may be.

(d) If the receiving Office, prior to proceeding as provided for in paragraph (c), finds that the element or part referred to in paragraph (a) as submitted is not completely contained in the earlier application concerned, the receiving Office may invite applicant to submit, within a period of one month from such an invitation, the sheet or sheets embodying the missing element or part as contained in the earlier application.

20.7 and 20.8 [No change]

[End of Annex and of document]