

## **Patent Cooperation Treaty (PCT) Working Group**

**Tenth Session**  
**Geneva, May 8 to 12, 2017**

**CORRECTION OF THE INTERNATIONAL APPLICATION IN CASE OF “ERRONEOUSLY”  
FILED ELEMENTS AND PARTS: ASSESSMENT OF PATENT LAW TREATY (PLT) RELATED  
ISSUES**

*Document prepared by the International Bureau*

### **SUMMARY**

1. The present document sets out an assessment of a number of PLT related issues with regard to the proposal to amend the PCT Regulations to allow for the incorporation by reference of “correct” elements and parts, and the “removal” of the corresponding “wrongly filed” elements or parts, of the international application.

### **BACKGROUND**

2. At its ninth session, held in Geneva from May 17 to 20, 2016, the Working Group discussed, based on document PCT/WG/9/13, a proposal for amendments to the PCT Regulations which would allow the applicant, in very limited and exceptional circumstances, to (in essence) replace any wrongly filed claims and/or the description of the international application (or any part thereof) with the equivalent “correct” version of the claims and/or the description (or any part thereof) as contained in the priority application.

3. As noted in the Summary by the Chair of the session (see paragraphs 124 to 130 of document PCT/WG/9/27), several delegations and representatives of users supported the proposal in general, noting that the proposed new approach would be a reasonable and applicant-friendly way to allow applicants to correct errors made when filing an international application. Several other delegations, while generally supporting the aim of the proposal, expressed concerns about possible abuse of the new provision, which should only apply in limited and exceptional cases. One delegation considered that there was no need to amend the Regulations, since the current provisions provided for the incorporation of a correct element or part as a “missing” element or part.

4. One delegation stated that it had serious concerns as to the compatibility of the proposal with the Patent Law Treaty (PLT). Citing PLT Article 2(1), it noted that PLT Contracting Parties were not free to create additional and more far-reaching possibilities to amend the scope of disclosure without changing the filing date and expressed concerns about the widening of the gap between the filing date related requirements applicable to international applications on the one hand and those applicable to national and regional applications on the other.

5. One other delegation suggested that further clarification should be provided by the Secretariat as to the effect of the proposal on Offices of PLT Contracting Parties under Article 6(1) of the PLT.

6. Given the divergence of views expressed by delegations and the concerns raised by some delegations with regard to a number of PLT related issues, the Working Group requested the Secretariat to carry out an assessment of those PLT related issues, for consideration by the Working Group at its tenth session. While noting that the interpretation of the PLT falls within the exclusive competence of the PLT Contracting Parties, and that the International Bureau is thus not competent to give a definitive interpretation of the PLT, the present document sets out a preliminary assessment of the PLT related issues, as requested by the Working Group.

## **ASSESSMENT OF PLT RELATED ISSUES**

### **APPLICABILITY OF THE PLT TO PCT APPLICATIONS**

7. At the outset, it is to be noted that the question of compatibility with the PLT of the proposal set out in paragraph 2, above, does not arise with regard to the proposal itself, since the PLT does not govern PCT filing date related requirements.

8. Pursuant to PLT Article 3(1)(b), as far as international applications are concerned, the PLT only applies in a PLT Contracting State in respect of the time limits for national phase entry and any procedure after national phase entry has commenced, "subject to the provisions of the PCT". Thus, as far as filing date requirements are concerned, the filing date requirements set out in PLT Article 5 do not apply to international applications, neither during the international phase nor during the national phase. In other words, the filing date requirements of international applications and of national or regional applications filed with or in respect of a PLT Contracting State are governed by two distinct and different regimes, the PCT for international applications and the PLT for national or regional applications.

### **WIDENING OF THE GAP BETWEEN PCT AND PLT FILING DATE REQUIREMENTS?**

9. A broader concern, however, which had been raised during the discussions by the Working Group at its ninth session (see paragraph 4, above), would appear to be that, should the proposed new PCT approach set out in paragraph 2, above, be adopted, this might indeed result in a widening of the gap between the PCT filing date requirements on the one hand and the PLT filing date requirements on the other, should it not be possible for (or should it not be desired by) a PCT Member State which is also a PLT Contracting Party to align its national or regional law accordingly in respect of national or regional applications filed with or for that State.

### **Differences in PCT and PLT Filing Date Requirements**

10. At the outset, it has to be noted that, already today, the PCT and PLT provide for different filing date requirements. For example, in order to obtain an international filing date, PCT Article 11(1) requires that an international application contains a part which on the face of it appears to be a claim or claims, and that it is in the language, or one of the languages, prescribed by the receiving Office. Neither requirement is found in PLT Article 5.

11. Similarly, different requirements apply under the PCT and the PLT with regard to the question as to whether the original filing date can be retained where missing elements or parts of an application are subsequently filed. For example:

(a) Whereas, under the PCT, it is possible to incorporate by reference, without loss of the international filing date, an entire “element” of the application (the description and/or the claims), under the PLT, the relevant filing date provision (Article 5(6)) does not provide for the retention of the original filing date where an entire “element” is missing; on the other hand, under the PLT, a PLT Contracting Party shall allow for the replacement of the description and drawings by a simple reference to a previously filed application (so-called “reference filing” under PLT Article 5(7)), a concept which does not exist under the PCT.

(b) Whereas, under the PCT, the inclusion of a statement of incorporation by reference in the international application, on the date of filing, is a mandatory requirement for the valid incorporation by reference of any missing element or part, under the PLT, any Contracting Party may, but is not obliged to, require such an indication of incorporation by reference as a condition for the inclusion of a missing part without the loss of the original filing date (PLT Rule 2(4)) (it is worth noting that, because of this difference between the PCT and the PLT, while the expression “incorporation by reference” of missing elements or parts is appropriate in the PCT context, it may not be so in the PLT context, since it does not accurately reflect that, under PLT Article 5(6) and PLT Rule 2(4), “incorporation by reference”, that is, the inclusion in the application, upon filing, of an indication of the incorporation by reference of any missing part of the description or any missing drawing, may or may not be a prerequisite for the inclusion of such missing part in the application without loss of filing date; in some PLT Contracting States it is, in others it is not).

12. Notwithstanding the fact that the PCT and PLT already today provide for different filing date requirements, given that one of the main objectives of the PLT was and is to have maximum synergy between formality requirements applicable to international applications on the one hand and national and regional applications on the other, any change in the PCT filing date requirements which would further widen the gap between the PCT and the PLT filing date requirements might indeed be seen as an unwelcomed development.

13. The question thus arises whether, should the proposal set out in paragraph 2, above, be adopted, it would be possible for a PCT Member State which is also a PLT Contracting Party to align its national or regional law accordingly, in compliance with the PLT, in respect of national or regional applications filed with or for that State.

14. Before considering that question, it would appear useful, so as to put things into context, to look at the legislative history of the relevant PLT provision, that is, PLT Article 5(6) (“Filing Date Where Missing Part of Description or Drawing is Filed”).

#### Legislative History of PLT Article 5(6)

15. The content of an application as of its filing date is decisive for subsequent procedures before the Office, in particular for the determination of the patentability of the claimed invention. No new matter can be added to the application after the filing date, since that could allow the applicant to expand the scope of patent protection over what was disclosed in the application on the filing date. In practice, however, applicants make mistakes and might inadvertently omit certain parts from the application as originally filed. In cases where such an omission is immediately identified, rectifying such a mistake at an early stage is in the interest of not only the applicant but also of the Office and the public at large. Therefore, already at an early stage of the PLT negotiations, a provision was included in the draft PLT under the Article dealing with filing date requirements. Modeled after PCT Article 14(2), it covered the case of one or more missing drawings and provided for the re-dating of the filing date of an application to the date on which a missing drawing was submitted.<sup>1</sup>

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<sup>1</sup> PLT/CE/II/5, paragraph 154, PLT/CE/III/6, paragraph 58 and PLT/CE/IV/2, Article 4(3)(b).

16. In the course of the PLT negotiations, delegations deviated from the PCT Article 14(2) model in two important aspects. The first deviation was to apply the above principle of re-dating the filing date not only to a missing drawing but to any missing part of the description<sup>2</sup>, again re-dating the filing date to the date on which the missing part was submitted, noting that the incorporation of the missing part might have introduced new matter in the application beyond what had been disclosed in the application as originally filed.

17. The second deviation from the PCT Article 14(2) model came from the suggestion that, if the inclusion of new matter was the reason for re-dating the filing date to the date on which the missing part of the description or the missing drawing was submitted to the Office, such re-dating should not be made if the missing part or drawing did not introduce new matter into the application.<sup>3</sup> In addition, some delegations considered that, where the priority of an earlier application was claimed, the Office should take into account the content of that earlier application in establishing whether or not the submission of a missing part of drawing involved new matter.<sup>4</sup> By the second session of the Standing Committee on Patents (SCP), those suggestions had been developed into draft PLT Article 4(5)(c) and (d) (see below) and draft Rule 2(3), which regulated exceptions to the principle laid down in draft Article 4(5)(b) that required the re-dating of the filing date. Draft Article 4(5)(c) and (d) read as follows:

Draft Article 4(5)(c) and (d)

“(c) Notwithstanding subparagraph (b) and subject to subparagraph (d), a Contracting Party [may][shall] provide that, where the Office determines, within a time limit prescribed by the Contracting Party, if any, that all missing parts of the description and all missing drawings filed under subparagraph (b) do not contain new matter, the filing date shall be the date on which all of the requirements referred to in paragraphs (1) and (2) are complied with.”<sup>5</sup>

“(d) Where the missing part of the description or missing drawing is filed under subparagraph (b) to rectify an unintentional omission from an application which claims the priority of an earlier application, the Office shall, upon the request of the applicant and subject to the requirements prescribed in the Regulations, consider the contents of that earlier application as having been contained in the application claiming priority in determining, for the purpose of subparagraph (c), whether that part of the description or that drawing contains new matter.”<sup>6</sup>

18. Draft Article 4(5)(c) was drafted in a way that, for the purpose of determining the filing date, the Office was not obliged to check and determine whether new matter was present in the missing part of the description or the missing drawing submitted by the applicant. During the negotiations, some delegations stated that Offices without substantive examination would not be in a position to carry out a determination as to the presence of new matter. Furthermore, some delegations pointed out that even those Offices which carried out substantive examination usually carried out such determination only at a later stage and only after the according of the filing date, generally during the phase of substantive examination. Accordingly, the practical usefulness of a “filing date” provision, providing a general safeguard for the inclusion of a missing part or missing drawing that did not involve new matter, was put into doubt and the text of draft Article 4(5)(c) disappeared from the draft PLT.

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<sup>2</sup> For example, PLT/CE/III/6, paragraph 58 ,PLT/CE/IV/4, paragraph 69 and SCP/1/7, paragraph 126.

<sup>3</sup> PLT/CE/III/6, paragraph 58.

<sup>4</sup> PLT/CE/IV/4, paragraph 69.

<sup>5</sup> SCP/2/3, Article 4(5)(c).

<sup>6</sup> SCP/2/3, Article 4(5)(d).

19. With regard to draft Article 4(5)(d), further requirements under that Article were prescribed in draft Rule 2(3), according to which a PLT Contracting Party was able to require a copy, or a certified copy, of the earlier application and a translation thereof, so that the Office could check whether the missing part or the missing drawing was contained in the earlier application. In the Notes, it was explained that draft Article 4(5)(d) would apply, in particular, in cases of unintentional omission of a sheet of the description or of the drawings from an application filed on paper or of a part of the description filed electronically in a “pageless” format.<sup>7</sup> In short, draft Article 4(5)(d) reflected the approach that, if the missing part of the description or the missing drawing was found to be present in the earlier application the priority of which was claimed, the applicant was in possession of the content that was missing from the original application at the time the earlier application had been filed, at the latest. Therefore, inclusion of that missing content in the application without re-dating the filing date would not lead to an unjustified expansion of the scope of protection.

20. While Member States in general supported this approach, different views were expressed on the nature of draft Article 4(5)(d) and the procedures for obtaining the full benefit of the retention of the original filing date where the content of the missing part or missing drawing was contained in the earlier application the priority of which was claimed.

21. Some delegations argued that draft Article 4(5)(d) should provide for a narrow exception to cover the case that a missing part of the description or a missing drawing was submitted at a very early stage of the patent prosecution for the purposes of determining the filing date. The operation of the procedures should be based on a request by the applicant, who should also indicate where, in the earlier application, the missing part of the description or the missing drawing was placed so that such missing part or drawing which was included in the earlier application could be easily checked by the Office.<sup>8</sup> Other delegations, however, considered that applicants should not be required to make a specific request in order to include any missing part without re-dating the filing date. In their view, the procedure could be completed by an automatic incorporation by referring the contents of the earlier application to the application as filed or by using a check-box on a request form designed to that effect.<sup>9</sup>

22. During the course of the negotiations, there was also a suggestion that draft Article 4(5)(d) should be worded so as to regulate the “allowability of all amendments present in the application”, rather than just regulating the incorporation by reference for the purposes of the filing date.<sup>10</sup> Similarly, there was another suggestion to the effect that, upon the request by the applicant, the content of the earlier application should be considered as if it had been included in the application claiming priority of that earlier application. In other words, matters that were contained in an earlier application could be included in a subsequent application, either in the context of the according of a filing date or at a later stage of the patent prosecution, by way of amendment or correction. Those suggestions, however, were not accepted by the SCP, as a majority was in favor of confining the scope of draft Article 4(5)(d) to the determination of the filing date.

23. Since the delegations could not agree on a standardized operation regarding how a missing part or missing drawing could be included without re-dating the filing date, a compromise text, as found in PLT Article 5(6)(b), was adopted at the PLT Diplomatic Conference, with PLT Rule 2(4) providing a list of permissible requirements that a Contracting Party may, but is not obliged to, apply (for example, a Contracting Party may, but is not obliged to, require an indication of incorporation by reference to the earlier application).

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<sup>7</sup> SCP/2/4, Explanatory Note 4.23.

<sup>8</sup> SCP/2/13, paragraphs 41 and 46.

<sup>9</sup> SCP/2/13, paragraph 41.

<sup>10</sup> PLT/CE/V/5, paragraph 79 and SCP/1/7, paragraph 131.

Compatibility of Proposal with the PLT if Applied to National and Regional Applications

24. In order to answer the question raised in paragraph 13, above, as to whether it would be possible for a PCT Member State which is also a PLT Contracting Party to align its national or regional law to the proposed PCT approach, in compliance with the PLT, in respect of national or regional applications filed with or for that State, it would appear necessary to consider each of the two processes as set out in paragraph 2, above, separately, taking into account the legislative history of PLT Article 5(6) set out above, namely: (i) the incorporation by reference, without loss of filing date, of any “correct” element or part as contained in the priority application; and (ii) the removal of any corresponding “wrongly filed” element or part from the application.

*“Correct” Elements or Parts*

25. Pursuant to PLT Article 2(1), a PLT Contracting Party:

“ ... shall be free to provide for requirements which, from the viewpoint of applicants and owners, are more favorable than the requirements referred to in this Treaty and the Regulations, other than PLT Article 5.”

26. As explained in the Notes on PLT Article 2(1):

“This paragraph states, in express terms, a principle which applies to all of the provisions of the Treaty other than PLT Article 5. It recognizes that the Treaty does not establish a completely uniform procedure for all PLT Contracting Parties but provides assurance for applicants and owners that, for example, an application that complies with the maximum requirements permitted under the Treaty and Regulations will comply with formal requirements applied by any PLT Contracting Party. A similar provision is contained in PCT Article 27(4).”

27. In other words, the PLT provides for the maximum formal requirements which any PLT Contracting Party may apply in respect of national and regional applications. In respect of those applications, no PLT Contracting Party may require compliance with any formal requirement other than those permitted under the PLT, except any requirement which, from the viewpoint of applicants or owners, is more favorable than the PLT requirements. That latter exception does not, however, apply to any filing date requirement under PLT Article 5; with regard to filing date requirements, no PLT Contracting State may provide for any requirement different from the PLT Article 5 filing date requirements, even if such requirement would be, from the viewpoint of applicants and owners, more favorable than the PLT filing date requirements.

28. Applying this principle to the main elements of the proposed PCT approach with regard to the incorporation of missing (“correct”) elements or parts, the following picture emerges.

*“Correct” part of the description or “correct” drawing*

29. Firstly, the answer to the question as to whether the proposal, to the extent that it would permit the incorporation of a “correct” part of the description and of a “correct” drawing, could be applied, in compliance with the PLT, to national and regional applications filed with or for a PLT Contracting Party, would appear to depend on the answer to the question as to whether a “correct” part of the description or a “correct” drawing which “appears to be missing” from the application as filed could, in all cases, be considered to be a “missing” part or “missing drawing” within the meaning of PLT Article 5(6). This, in turn, would appear to depend on:

(a) whether, in order for a part of the description or a drawing to be considered “missing” from the application as filed, such part or drawing has to be “objectively” missing from the application as filed, in the sense that the Office of filing, when assessing the application as filed (no matter whether such assessment is carried out by the Office when first examining the application as to compliance with filing date requirements or later, after the applicant has drawn attention of the Office to what the applicant claims to be a “missing” part or drawing) must be able to “objectively” determine that a part of the description or a drawing

“appears to be missing” from the application; examples include: (i) a particular set of drawings (“drawings 1 to 11”) is referred to in the description but “drawing 11” is not filed; (ii) features of a drawing referred to in description are not to be found in originally filed drawing and thus it is immediately apparent that the drawing originally filed as “drawing 1” is not the “Fig. 1” referred to in the description; (iii) drawings are referred to in the description (“Figs. 1, 2 and 3”) but different drawings are filed (“Fig. 1a and 1b”); or

(b) whether, in order for a part of the description or a drawing to be considered “missing” from the application as filed, it is sufficient that such part or drawing was, from the applicants perspective, “missing” from the application in the sense that it had been the applicant’s intention to include the “correct” part of the description or the “correct” drawing in the application as filed but a “wrong” part or drawing had been erroneously included in the application instead, without it being possible, however, for the Office of filing to objectively determine whether, as the applicant claims, something was indeed missing from the application as filed; examples include: (i) a description with 15 pages is filed, but the last two pages did not contain the version of the description which the applicant had intended to submit on the filing date; (ii) drawings are filed and referred to in the description (“Figs. 1, 2 and 3”), however, Fig. 3 was not the figure the applicant had intended to file.

30. Unfortunately, there would appear to be no clear cut answer to that question.

(a) On the one hand, it would appear that the approach reflected in draft PLT Articles 4(5)(c) and 4(5)(d) (see paragraph 19, above), which later formed the basis of PLT Article 5(6) as adopted, would speak in favor of an interpretation that, for it to be considered to be a “missing” part within the meaning of PLT Article 5, it is sufficient that that part or drawing was, from the applicant’s perspective, “missing” from the application in the sense that it had been the applicant’s intention to include the “correct” part of the description or the “correct” drawing (note the wording of draft Article 4(5)(d) “where the missing part of the description or missing drawing is filed under subparagraph (b) to rectify an unintentional omission from an application which claims the priority of an earlier application ...”). The focus of these provisions was not whether it was possible for the Office of filing to “objectively” determine, at the time of filing, whether a part of the description or a drawing was missing from the application. Rather, the focus was whether any unintentionally “missing” part or drawing, if later included in the application as filed, would add any new matter to the application when taking into account the contents of the earlier application the priority of which was claimed in the later application. If the missing part was found to be present in that earlier application, the applicant was, at the time of filing of the earlier application, “in possession” of the content which had been unintentionally “missing” from the second application; therefore, inclusion of that “missing” content in the second application without re-dating the filing date would not add new matter and thus not lead to an unjustified expansion of the scope of protection.

(b) On the other hand, it is to be noted that the wording of both PCT Article 14(2) and PLT Article 5(5) (which was modeled after PCT Article 14(2)) requires the presence of an objective element (namely, as far as PCT Article 14(2) is concerned, a finding by the Office that “the international application refers to drawings which, in fact, are not included in that application” and, in the case of PLT Article 5(5), a finding by the Office that “a part of the description appears to be missing from the application, or that the application refers to a drawing which appears to be missing from the application”), which might support an interpretation that, in general, an objective assessment by the Office whether a part of the description or a drawing was missing from the application was required. However, it is to be noted that both Articles only serve to oblige the Office to notify the applicant that it has found that a part of the description or a drawing appears to be missing. A precondition for making such a notification is that the Office finds that something indeed appears to be missing (if the Office does not make any such finding, there is nothing to notify the

applicant about). Against this background, it would appear questionable to interpret both PLT Article 5(5) and PCT Article 14(2) as setting a “general standard” for the determination of what constitutes a missing element or part and to argue that, in general, for a part to be considered “missing” from an application, it had to be possible for the Office, at the time of filing, to objectively assess and determine that something was indeed missing from the application as filed.

*“Correct” entire element (description and claims) of the application*

31. Secondly, as regards the question as to whether the proposal, to the extent that it would permit the incorporation of an entire “correct” element of the application (description and claims) could be applied, in compliance with the PLT, to national and regional applications filed with or for a PLT Contracting Party, the same considerations as those set out in paragraphs 29 and 30, above, would appear to apply. However, the answer to the question is further complicated by the fact that:

(a) PLT Article 5(6) only permits the subsequent submission of a missing part of the description and a missing drawing without loss of the original filing date, but not of a missing (“correct”) entire element of the application (as noted in paragraph 11, above, while a PLT Contracting Party must allow for the replacement of the description and drawings by a simple reference to a previously filed application (so-called “reference filing” under PLT Article 5(7)), that provision is not intended to address cases where an entire element is missing from the application);

(b) if the applicant is not permitted to remove any “wrongly” filed element other than by way of a later amendment, the “correct” element (say, the entire description of the earlier application) incorporated by reference would automatically become a “part” of the “complete” element of the application (that is, the description of the application would consist not only of the “wrong” description as originally filed but also of the “correct” description incorporated by reference);

(c) PLT Article 5(6) does not cover the “claims” element (since the presence of claims is not a filing date requirement under the PLT).

*Removal of Erroneously Filed Elements or Parts*

32. As regards the second “process” (see in paragraph 24, above), namely, the removal of any corresponding “wrongly filed” element or part from the application, it has been shown in the review of the legislative history of PLT Article 5(6), above, that PLT Article 5(6), inspired by PCT Article 14(2), was intended to only cover the filing of a missing part of the description or a missing drawing by the applicant “to rectify its omission from an application” on the filing date. It was intended to only regulate the procedure for the determination of the filing date under specific circumstances but was not intended to address, and does not address, issues not relevant to the determination of the filing date, such as amendments or corrections of the content of the application after the filing date had been accorded (or, more specifically, the removal from the application of any “erroneously” filed elements or parts).

33. In other words, PLT Article 5(6) does not govern amendment or correction procedures, including issues such as time limits within which amendments or corrections may be permitted, to the extent that such procedures are not related to the determination of the filing date; rather, to that extent, PLT Contracting Parties are free to address such procedures under their respective applicable national and regional laws.

34. However, it is to be noted that, as presently drafted, proposed new PCT Rule 20.5*bis* would require the receiving Office to address the issue of a possible removal from the application of any “erroneously” filed elements or parts in the context of “determining whether the papers purporting to be an international application fulfill the requirements of Article 11(1)” (see document PCT/WG/9/13, Annex I, pages 2 and 3). More specifically, the receiving Office

would be required to draw the applicant's attention to any element or part of the application which "has or appears to have been erroneously filed". Furthermore, it would require the receiving Office, upon request of the applicant, to remove any such erroneously filed element or part before according an international filing date to the application. In other words, it would appear that new PCT Rule 20.5*bis*, as presently drafted, would address issues relevant to the determination of the filing date, not least because the removal from the application, upon request of the applicant, of any erroneously filed element or part would impact on the contents, and thus the disclosure, of the application to which a filing date is accorded.

35. The question thus arises whether it would be possible for a PCT Member State which is also a PLT Contracting Party to align its national or regional law to the proposed PCT approach, as set out in proposed Rule 20.5*bis*, noting that, pursuant to PLT Article 2(1) (as explained in paragraph 27, above), no PLT Contracting State may provide for any filing date requirement different from the PLT Article 5 filing date requirements, even if such requirement would be, from the viewpoint of applicants and owners, more favorable than the PLT filing date requirements. The answer to that question would appear to depend on the interpretation of the word "requirements" in PLT Article 2(1).

36. On the one hand, the term "requirements" could be interpreted as meaning those filing date requirements under the PLT with which applicants or owners must comply. This view appears to be supported by the fact that PLT Article 2(1) is drafted from the viewpoint of applicants and owners and further supported by the wording of PLT Explanatory Note 2.01, which states that the provision "provides assurance for applicants and owners that [...] an application that complies with the maximum requirements permitted under the Treaty and the Regulations will comply with formal requirements applied by any Contracting Party."

37. On the other hand, the term "requirements" under PLT Article 2(1) could also be interpreted to cover filing date related requirements prescribed in the PLT that can be imposed not only on applicants and owners but also those which can be imposed on Offices.

38. If one were to side with the former interpretation, a mandatory requirement for an Office to invite the applicant to remove any erroneously filed element or part from the application and, if so requested by the applicant, to remove any such element or part from the application (as is under proposed new PCT Rule 20.5*bis*) would be outside of the scope of PLT Article 2(1). However, if one were to side with the latter interpretation, such a mandatory requirement for an Office, to be applied in the context of determining the filing date, could be considered as being more favorable to the applicant than what is prescribed in PLT Article 5 and thus contrary to PLT Article 2(1).

### *Conclusion*

39. The above assessment of the PLT related filing date issues would appear to suggest that there is no clear cut answer to the question as to whether it would be possible, in compliance with the PLT, for a PCT Member State which is also a PLT Contracting Party to align its national or regional law in respect of national or regional applications to the new PCT approach, if adopted. The answer to that question would appear to a great extent depend on the interpretation of the PLT, notably with regard to the questions as to:

(a) whether, in order for a part of the description or a drawing to be considered "missing" from the application as filed, such part or drawing has to be "objectively" missing from the application as filed (see paragraph 29(a), above) or whether it is sufficient that such part or drawing was, from the applicants perspective, "missing" from the application (see paragraph 29(b), above); and

(b) whether the term "requirements" in PLT Article 2(1) is to be interpreted as meaning "requirements for applicants or owners" (see paragraph 36, above) or whether it is to be interpreted to also include "requirements for Offices" (see paragraph 37, above).

40. Noting that the interpretation of the PLT falls within the exclusive competence of the PLT Contracting Parties, ultimately, these questions remain for the PLT Contracting Parties to consider and decide.

41. The answer to at least the second question might also depend on the exact design of the new PCT approach; for example, consideration could be given to the question as to whether it would be possible to deal with the issue of the removal from the application of any erroneously filed element or part outside of the procedures related to the determination of the filing date.

42. Furthermore, noting that the PLT filing date requirements provide options for PLT Contracting Parties as to the implementation of the PLT under the applicable national or regional law, the “size” of any gap between, on the one hand, the PCT filing date requirements applicable to international applications and the PLT compliant filing date requirements applicable to national or regional applications on the other would very much depend on implementation choices made by PLT Contracting States; thus, the answer to the question as to whether adoption of the new PCT approach would widen that gap might very well differ from PLT Contracting State to PLT Contracting State.

#### EFFECT OF PROPOSAL, IF ADOPTED, ON OFFICES OF PLT CONTRACTING PARTIES UNDER PLT ARTICLE 6(1)

43. As noted in paragraph 5, above, during the considerations by the Working Group at its ninth session, one delegation suggested that further clarification should be provided by the Secretariat as to the effect of the proposal on Offices of PLT Contracting Parties under Article 6(1) of the PLT.

44. In general, the PLT is structured in such a way that PLT Article 5 provides the filing date requirements whereas PLT Article 6 regulates other formality requirements relating to an application, that is, formality requirements which do not have any impact on the filing date determination but nevertheless need to be complied with within a given time limit.

45. When looking at the possible effect of the proposed PCT approach, if adopted, on Offices of PLT Contracting States, it is again necessary to consider each of the two processes as set out in paragraph 2, above, separately, namely, (i) the incorporation by reference, without loss of filing date, of any missing (“correct”) element or part as contained in the priority application; and (ii) the removal of any corresponding “wrongly filed” element or part from the application.

46. As regards the incorporation by reference, without loss of filing date, of any missing (“correct”) element or part as contained in the priority application, in view of what is stated in paragraph 44, above, namely, that PLT Article 6(1) does not apply to any filing date requirements, adoption of the proposed PCT approach would not have any effect on Offices of PLT Contracting Parties under PLT Article 6.

47. As regards the removal of any “wrongly filed” element or part from the application, PLT Article 6 would only have an effect on Offices of PLT Contracting Parties if that part of the proposed PCT approach would concern “form or contents” of an application. In this context, it is to be noted that the wording of PLT Article 6(1) is modeled after PCT Article 27(1). It is therefore implicit that the expression “form or contents” of an application in PLT Article 6(1) is to be construed in the same way as that expression found in PCT Article 27(1).<sup>11</sup> The Notes to that Article in the Records of the Washington Diplomatic Conference on the Patent Cooperation Treaty contain the following explanation:

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<sup>11</sup> PLT Explanatory Notes, 6.02.

“The requirements relating to form and contents are principally provided for in Articles 3 (The International Application), 4 (The Request), 5 (The Description), 6 (The Claims), 7 (The Drawings), and 8 (Claiming Priority), and the Rules pertaining to these Articles (mainly Rules 3 to 13). The words “form or contents” are used merely to emphasize something that could go without saying, namely, that the requirements of substantive patent law (criteria of patentability, etc.) are not meant.”

48. During the negotiations of the PLT, an attempt was made to specify precisely which provisions of the PCT would fall under the scope of “form or contents” of an application under PCT Article 27(1). However, that attempt was not successful. Thus, the interpretation of the term “form or contents” of an application in PLT Article 6(1) remains a matter for the PLT Contracting Parties.

49. This notwithstanding, in general, the procedures of removing any content from an application after its filing date appear to be amendment or correction procedures, that is, procedures which, in general, are not considered to concern “requirements relating to form or contents” of an application, although, as a result of an amendment or correction, the substantive “content” of the application – in the sense of substantive information contained in the application – may be altered.

50. Therefore, the procedures governing the removal of any “wrongly filed” element or part from the application under the proposed PCT approach would not have any effect on Offices of PLT Contracting Parties under PLT Article 6(1).

*51. The Working Group is invited to note the contents of the present document.*

[End of document]