

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

**Twelfth Session**  
**Geneva, June 11 to 14, 2019**

### **ERRONEOUSLY FILED ELEMENTS AND PARTS OF THE INTERNATIONAL APPLICATION**

*Document prepared by the International Bureau*

#### **SUMMARY**

1. The present document sets out proposed amendments to the Regulations to permit the incorporation by reference of correct elements or parts in the case of erroneously filed elements or parts of the international application.

#### **BACKGROUND**

2. At its ninth session, held in May 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 erroneously filed claims and/or the description of the international application (or any part thereof, or any erroneously filed drawings) with the equivalent “correct” version of the claims, the description or the drawings (or any part thereof) as contained in the priority application. The proposals were met with concerns by some delegations with regard to a number of PLT related issues.

3. At its tenth session, held in May 2017, the Working Group considered an assessment of those PLT related issues prepared by the International Bureau (document PCT/WG/10/10). Following a divergence of views on the assessment expressed by delegations, the Working Group requested the International Bureau to convene a workshop dedicated to the issue of erroneously filed elements or parts of an application during the eleventh session of the Working Group.

4. The workshop was held during the eleventh session of the Working Group, held in June 2018. In summarizing its findings (see document PCT/WG/11/26, paragraph 71), the Chair of the workshop stated, *inter alia*, that:

- (a) there had been agreement among all speakers, representing the views of users of the PCT system, that there was a need for a safety net where an applicant made a mistake and erroneously filed a wrong description or a wrong set of claims;
- (b) there had been agreement that, in the case of erroneously filed elements or parts of an application, incorporation by reference of the correct elements or parts, if completely contained in the priority application, should be allowed;
- (c) there had been minor differences as to the details governing the correction process (such as to whether the erroneously filed element or part should remain in the application, in addition to the correct element or part, or should be removed; whether receiving Offices should be permitted to charge a fee for any request for correction, or whether the applicant should be required to submit an explanation as to why the mistake had occurred), but that those differences appeared negligible, as long as there was agreement to address the “what” by introducing a new correction procedure for the incorporation of correct elements or parts.

5. Subsequent discussions by the Working Group at its eleventh session were based on document PCT/WG/11/21, in particular paragraph 30, setting out five proposed conditions for the correction of an international application in the case of erroneously filed elements and parts. In summarizing the discussions, the Chair of the Working Group concluded (see document PCT/WG/11/26, paragraph 74):

- (a) “that there was general agreement that, should a new Rule allowing for the incorporation by reference of correct elements or parts be added to the Regulations, the Receiving Office Guidelines should be modified to clarify that Rule 20.5 only covered “truly” missing parts;
- (b) “that there was significant but not unanimous support not to allow the “replacement” of the erroneous element or part from the application, but further discussion appeared to be needed on this matter;
- (c) “that there was general agreement that any incorporation by reference of correct elements or parts should only be permitted within the time limits provided for in present Rule 20.7;
- (d) “that there was agreement that the International Searching Authority should be entitled to charge an additional fee for the search of the international application including the correct elements or parts incorporated by reference where that Authority had already started the search on the basis of the erroneously filed element or part, as long as such a fee was not otherwise precluded by Article 17; and
- (e) “that further discussion appeared to be needed on whether receiving Offices should be given the opportunity to submit a notification of incompatibility in respect of any new provision allowing for the incorporation of correct elements or parts.”

6. In concluding the discussions at the eleventh session, “the Working Group invited the International Bureau to prepare draft amendments to the Regulations for the next session of the Working Group, taking into account the discussions at the present session and further consultations with interested stakeholders, as required” (see document PCT/WG/11/26, paragraph 76).

## PROPOSED AMENDMENTS TO THE REGULATIONS

7. The Annex to the present document sets out proposed amendments to the Regulations allowing for the incorporation by reference of correct elements or parts. The main features of those proposals are outlined in the following paragraphs. More detailed explanations are given in “Comments” on proposed amendments to particular Rules set out in the Annex.

8. It is proposed to amend the Regulations by adding new Rule 20.5*bis* to deal with the furnishing of a correct element or part of the application in the case of erroneously filed elements or parts. Along the lines of current Rule 20.5, covering the case of furnishing of a “truly” missing part of the application, proposed new Rule 20.5*bis* would cover three different scenarios:

(a) the furnishing of a correct element or part on or before the date on which all filing date requirements are fulfilled (that is, on or before an international filing date can be accorded to a purported international application); in that case, the erroneously filed element or part would be removed from the application, the correct element or part would be included in the application, and the international application would be accorded as the international filing date the date (on or after the date of receipt of the correct element or part) on which all filing date requirements were fulfilled (see proposed new Rule 20.5*bis*(b));

(b) the furnishing of a correct element or part after the date on which all filing date requirements were fulfilled (that is, after the international filing date has been accorded to the international application); in that case, the erroneously filed element or part would be removed from the application, the correct element or part would be included in the application, and the international filing date would be corrected to the (later) date on which the correct element or part was received (see proposed new Rule 20.5*bis*(c)); as in the case of a missing part, the applicant would be given the opportunity to request that the correct element or part be disregarded (so as to maintain the original filing date) (see proposed new Rule 20.5*bis*(e));

(c) the valid incorporation by reference of a correct element or part as contained in an earlier application; in that case, the correct element or part would be considered to have been included in the purported international application on the date on which one or more elements of the application were first received by the receiving Office, and the receiving Office would accord as the international filing date the date on which all filing date requirements were fulfilled; the erroneously filed element or part would remain in the international application, in addition to the “correct” element or part incorporated by reference, since a designated Office which had submitted a “notice of incompatibility” with regard to the incorporation by reference of correct elements or parts would not recognize such incorporation, so that the international application would have to proceed before such an Office as originally filed, that is, including the erroneously filed element or part (see proposed new Rule 20.5*bis*(d)).

9. It is further proposed:

(a) to amend Rule 20.5 so as to clarify that this Rule only applies to the furnishing of “truly” missing parts of an application, but not to the furnishing of correct elements or parts in the case of erroneously filed elements or parts;

(b) to give both receiving Offices and designated/elected Offices the possibility to submit a notification of incompatibility of the provisions covering incorporation by reference of “correct” elements or parts in the case of erroneously filed elements or parts, provided that Member States would be invited to also adopt an Understanding according to which any receiving Office which submitted such a notice of incompatibility would agree

to any request by the applicant to transmit an application in relation to which the applicant had confirmed the incorporation of a correct element or part in the case of erroneously filed element or part to the International Bureau under Rule 19.4(a)(iii);

(c) where the incorporation by reference of a correct element or part in the case of an erroneously filed element or part is notified to the International Searching Authority only after it has begun to draw up the international search report, to permit the Authority to charge an additional search fee (in an amount to be determined by that Authority but not to exceed the search fee); so as to put the furnishing of both “truly” missing parts and correct elements or parts on an equal footing, it is further proposed to apply the same provision also to the case where the incorporation by reference of a “truly” missing part is notified to the Authority only after it has begun to draw up the international search report.

*10. The Working Group is invited to comment on the proposed amendments to the PCT Regulations set out in the Annex to this document.*

[Annex follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS<sup>1</sup>

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<sup>1</sup> Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

## Rule 4

### The Request (Contents)

4.1 to 4.17 [No change]

4.18 *Statement of Incorporation by Reference*

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), [or an element or part of the description, claims or drawings referred to in Rule 20.5bis\(a\)](#) 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.

*[COMMENT: It is proposed to amend Rule 4.18 so as to include a reference to the incorporation by reference of a correct element or part under proposed new Rule 20.5bis.]*

4.19 [No change]

## Rule 12

### Language of the International Application and Translations for the Purposes of International Search and International Publication

12.1 [No change]

12.1bis *Language of Elements and Parts Furnished under Rule 20.3, 20.5, [20.5bis](#) or 20.6*

An element referred to in Article 11(1)(iii)(d) or (e) furnished by the applicant under Rule 20.3(b), [20.5bis\(b\)](#), [20.5bis\(c\)](#) or 20.6(a) and a part of the description, claims or drawings furnished by the applicant under Rule 20.5(b), [20.5\(c\)](#), [20.5bis\(b\)](#), [20.5bis\(c\)](#) or 20.6(a) shall be in the language of the international application as filed or, where a translation of the application is required under Rule 12.3(a) or 12.4(a), in both the language of the application as filed and the language of that translation.

*[COMMENT: It is proposed to amend Rule 12.1bis so as to include references to Rules 20.5bis(b) and (c) relating to the furnishing of a correct “elements or parts” in the case of an erroneously filed element or parts. It is further proposed to add a reference to Rule 20.5(c) (unrelated to the proposed amendments related to erroneously filed elements or parts), as it would appear that the inclusion of this reference was overlooked when Rule 12.1bis was added in the context of the provisions dealing with incorporation by reference of missing elements or parts.]*

12.2 to 12.4 [No change]

## Rule 20

### International Filing Date

20.1 and 20.2 *[No Change]*

20.3 *[No Change] Defects under Article 11(1)*

(a) Where, in determining whether the papers purporting to be an international application fulfill the requirements of Article 11(1), the receiving Office finds that any of the requirements of Article 11(1) are not, or appear not to be fulfilled, it shall promptly invite the applicant, at the applicant's option:

- (i) to furnish the required correction under Article 11(2); or
- (ii) where the requirements concerned are those relating to an element referred to in Article 11(1)(iii)(d) or (e), to confirm in accordance with Rule 20.6(a) that the element is incorporated by reference under Rule 4.18;

and to make observations, if any, within the applicable time limit under Rule 20.7. 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.

(b) Where, following an invitation under paragraph (a) or otherwise:

(i) the applicant furnishes to the receiving Office the required correction under Article 11(2) after the date of receipt of the purported international application but on a later date falling within the applicable time limit under Rule 20.7, the receiving Office shall accord that later date as the international filing date and proceed as provided in Rule 20.2(b) and (c);



*[Rule 20.3(b), continued]*

(ii) an element referred to in Article 11(1)(iii)(d) or (e) is, under Rule 20.6(b), considered to have been contained in 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, the receiving Office shall accord as the international filing date the date on which all of the requirements of Article 11(1) are fulfilled and proceed as provided in Rule 20.2(b) and (c).

(c) 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 paragraph (a) since the requirements of Article 11(1) were fulfilled when the papers were received, it shall proceed as provided in Rule 20.2.

*20.4 [No Change] Negative Determination under Article 11(1)*

If the receiving Office does not receive, within the applicable time limit under Rule 20.7, a correction or confirmation referred to in Rule 20.3(a), or if a correction or confirmation 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

*[Rule 20.4, continued]*

(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.

## 20.5 Missing Parts

(a) Where, in determining whether the papers purporting to be an international application fulfill the requirements of Article 11(1), the receiving Office finds that a part of the description, claims or drawings is or appears to be missing, including the case where all of the drawings are or appear to be missing [\("missing part"\)](#) but not including the case where an entire element referred to in Article 11(1)(iii)(d) or (e) is or appears to be missing [and not including the case referred to in Rule 20.5bis\(a\)](#), it shall promptly invite the applicant, at the applicant's option:

- (i) to complete the purported international application by furnishing the missing part;  
or
- (ii) to confirm, in accordance with Rule 20.6(a), that the part was incorporated by reference under Rule 4.18;

and to make observations, if any, within the applicable time limit under Rule 20.7. 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.

*[Rule 20.5(a), continued]*

*[COMMENT: It is proposed to amend Rule 20.5 so as clarify that this Rule only applies to a missing part of the description, the claims and or the drawings, and all drawings which are missing, but not to the case “referred to in Rule 20.5bis.(a), that is, the case where an entire element referred to in Article 11(1)(i) (the description) or Article 11(1)(ii) (the claim(s)) has or appears to have been erroneously filed, and not to the case that a part of the description, claims or drawings or all of the drawings have been or appear to have been erroneously filed. Cases of erroneously filed elements or part are covered by proposed new Rule 20.5bis (see below).]*

(b) Where, following an invitation under paragraph (a) or otherwise, the applicant furnishes to the receiving Office, on or before the date on which all of the requirements of Article 11(1) are fulfilled but within the applicable time limit under Rule 20.7, a missing part referred to in paragraph (a) so as to complete the [purported](#) international application, that part shall be included in the application and the receiving Office shall accord as the international filing date the date on which all of the requirements of Article 11(1) are fulfilled and proceed as provided in Rule 20.2(b) and (c).

*[COMMENT: It is proposed to amend paragraph (b) by inserting the word “purported” so as to clarify that the applicant, by furnishing a missing part on or before the date on which an international filing date is accorded, completes a “purported international application” (which only becomes an “international application” once a filing date has been accorded. See also Rule 20.5bis(b), below, which also refers to the correction of a “purported international application”).]*

(c) [No change] Where, following an invitation under paragraph (a) or otherwise, the applicant furnishes to the receiving Office, after the date on which all of the requirements of Article 11(1) were fulfilled but within the applicable time limit under Rule 20.7, a missing part referred to in paragraph (a) so as to complete the international application, that part shall be included in the application, and the receiving Office shall correct the international filing date to the date on which the receiving Office received that part, notify the applicant accordingly and proceed as provided for in the Administrative Instructions.

*[Rule 20.5, continued]*

(d) [No change] Where, following an invitation under paragraph (a) or otherwise, a part referred to in paragraph (a) is, under Rule 20.6(b), considered to have been contained in the purported 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, the receiving Office shall accord as the international filing date the date on which all of the requirements of Article 11(1) are fulfilled and proceed as provided in Rule 20.2(b) and (c).

(e) [No change] Where the international filing date has been corrected under paragraph (c), the applicant may, in a notice submitted to the receiving Office within one month from the date of the notification under paragraph (c), 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, and the receiving Office shall proceed as provided for in the Administrative Instructions.

*20.5bis Erroneously Filed Elements and Parts*

(a) Where, in determining whether the papers purporting to be an international application fulfill the requirements of Article 11(1), the receiving Office finds that an entire element referred to in Article 11(1)(iii)(d) or (e) has or appears to have been erroneously filed, or that a part of the description, claims or drawings has or appears to have been erroneously filed, including the case where all drawings have or appear to have been erroneously filed (“erroneously filed element or part”), it shall promptly invite the applicant, at the applicant’s option:

*[Rule 20.5bis(a), continued]*

(i) to correct the purported international application by furnishing the correct element or part; or

(ii) to confirm, in accordance with Rule 20.6(a), that the correct element or part was incorporated by reference under Rule 4.18;

and to make observations, if any, within the applicable time limit under Rule 20.7. 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.

*[COMMENT: It is proposed to add new Rule 20.5bis(a) to cover the cases of erroneously filed elements or parts, that is: (i) an erroneously filed entire element referred to in Article 11(1)(iii)(d) (description); (ii) an erroneously filed entire element referred to in Article 11(1)(iii)(e) (claims); (iii) an erroneously filed part of the description, claims or drawings, including the case that all drawings have or appear to have been erroneously filed.]*

(b) Where, following an invitation under paragraph (a) or otherwise, the applicant furnishes to the receiving Office, on or before the date on which all of the requirements of Article 11(1) are fulfilled but within the applicable time limit under Rule 20.7, a correct element or part so as to correct the purported international application, that correct element or part shall be included in the application, the erroneously filed element or part concerned shall be removed from the application and the receiving Office shall accord as the international filing date the date on which all of the requirements of Article 11(1) are fulfilled and proceed as provided in Rule 20.2(b) and (c) and as provided for in the Administrative Instructions.

*[COMMENT: Paragraph (b) covers the case that the applicant furnishes a "correct" element or part to the receiving Office on or before the date on which all of the filing date requirements are fulfilled and an international filing date is accorded. In such a case, the erroneously filed element or part can be removed from the purported international application and the correct*

*[Rule 20.5bis(b), continued]*

*element or part can be included in the purported international application. Example: the applicant files a purported international application, however, without any claims; in addition, the receiving Office notices that pages 2 and 3 of the description appear to have been erroneously filed, since it appears that those pages do not at relate at all to the subject matter of the remainder of the purported international application. Upon the invitation by the receiving Office under Rule 20.5bis(a) (see above), the applicant furnishes the two “correct” pages of the description and, one week later, a set of claims. Pursuant to paragraph (b), the two “correct” pages would be included in the application, the two erroneously filed pages of the description would be removed (in accordance with the procedure to be provided for in the Administrative Instructions), and the application would be accorded as the international filing date the date on which all Article 11(1) requirements were fulfilled, that is, the date on which the receiving Office had received the set of claims.]*

(c) Where, following an invitation under paragraph (a) or otherwise, the applicant furnishes to the receiving Office, after the date on which all of the requirements of Article 11(1) were fulfilled but within the applicable time limit under Rule 20.7, a correct element or part so as to correct the international application, that correct element or part shall be included in the application, the erroneously filed element or part concerned shall be removed from the application, and the receiving Office shall correct the international filing date to the date on which the receiving Office received that correct element or part, notify the applicant accordingly and proceed as provided for in the Administrative Instructions.

*[COMMENT: Paragraph (c) covers the case that the applicant furnishes a “correct” element or part to the receiving Office after the date on which all of the filing date requirements were fulfilled and after an international filing date has been accorded. In such a case, the erroneously filed element or part can be removed from the purported international application, the correct element or part can be included in the purported international application and the international filing date will be corrected to be the date on which the correct element or part was received by the receiving Office. Example: the applicant files a complete international application which is accorded an international filing date. However, the receiving Office notices that pages 2 and 3 of the description appear to have been erroneously filed, since it appears that those pages do not at relate at all to the subject matter of the remainder of the purported international application. Upon the invitation by the receiving Office under Rule 20.5bis(a) (see above), the applicant furnishes the two “correct” pages of the description. Pursuant to paragraph (c), the two “correct” pages would be included in the application, the two erroneously filed pages of the description would be removed (in accordance with the procedure to be provided for in the Administrative Instructions), and the international filing date would be corrected to the date on which the receiving Office had received the two “correct” page of the description.]*

[Rule 20.5bis, continued]

(d) Where, following an invitation under paragraph (a) or otherwise, a correct element or part is, under Rule 20.6(b), considered to have been contained in the purported 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, the erroneously filed element or part concerned shall remain in the application, and the receiving Office shall accord as the international filing date the date on which all of the requirements of Article 11(1) are fulfilled and proceed as provided in Rule 20.2(b) and (c) and as provided for in the Administrative Instructions.

*[COMMENT 1: Paragraph (d) covers the case that the applicant furnishes a “correct” element or part to the receiving Office and validly confirms the incorporation by reference of the “correct” element or part concerned, in which case that element or part is considered to have been contained in the purported 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. In such a case, it is necessary that the erroneously filed element or part remains in the international application, in addition to the “correct” element or part incorporated by reference, since a designated Office which has submitted a “notice of incompatibility” of paragraph (d) with the applicable national law will not recognize that incorporation by reference, so that the international application will have to proceed before such an Office as originally filed, that is, including the erroneously filed element or part. Example: the applicant files a complete international application which is accorded an international filing date. However, the receiving Office notices that pages 2 and 3 of the description appear to have been erroneously filed, since it appears that those pages do not at relate at all to the subject matter of the remainder of the purported international application. Upon the invitation by the receiving Office under Rule 20.5bis(a) (see above), the applicant furnishes the two “correct” pages of the description and validly confirms the incorporation by reference of those “correct” parts of the description.]*

*[Comment 2: After national phase entry before a designated Office which did not submit a notification of incompatibility of paragraph (d), the international application would proceed in the national phase on the basis of the international application as “corrected”, that is, with the two “correct” pages of the description (marked as “incorporated by reference – Rule 20.5bis(d)); the two erroneously filed pages (which are still contained in the international application, marked as “erroneously filed – Rule 20.5bis”) will have to be removed from the application by way of an amendment of the international application filed by the applicant as part of the national phase processing. After national phase entry before a designated Office which did submit a notification of incompatibility of paragraph (d), the international application would proceed in the national phase on the basis of the international application as filed, that is, including the two erroneously filed pages; the two “correct” pages (which are still contained in the international application, marked as “incorporated by reference – Rule 20.5bis(d))” will have to be removed from the application by way of an amendment of the international application filed by the applicant as part of the national phase processing.]*

*[Rule 20.5bis, continued]*

(e) Where the international filing date has been corrected under paragraph (c), the applicant may, in a notice submitted to the receiving Office within one month from the date of the notification under paragraph (c), request that the correct element or part be disregarded, in which case the correct element or part shall be considered not to have been furnished, the erroneously filed element or part concerned shall be considered not to have been removed from the application and the correction of the international filing date under paragraph (c) shall be considered not to have been made, and the receiving Office shall proceed as provided for in the Administrative Instructions.

*[COMMENT: As is the case under current Rule 20.5(e) in relation to missing parts, where the international filing date has been corrected under proposed new Rule 20.5bis(c) (see above), the applicant would be given an opportunity to request that a correct element or part be disregarded in order to keep the original filing date (accorded to the international application including the erroneously filed element or part). In such a case, the receiving Office would simply “undo” all it had done under paragraph (c) and the application would proceed on the basis of the international filing date originally accorded to the international application including the erroneously filed element or part.]*

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

(a) [No change] The applicant may submit to the receiving Office, within the applicable time limit under Rule 20.7, a written notice confirming that an element or part is incorporated by reference in the international application under Rule 4.18, accompanied by:

(i) a sheet or sheets embodying the entire element as contained in the earlier application or embodying the part concerned;

(ii) where the applicant has not already complied with Rule 17.1(a), (b) or (b-bis) in relation to the priority document, a copy of the earlier application as filed;



*[Rule 20.6(a), continued]*

(iii) where the earlier application is not in the language in which the international application is filed, a translation of the earlier application into that language or, where a translation of the international application is required under Rule 12.3(a) or 12.4(a), a translation of the earlier application into both the language in which the international application is filed and the language of that translation; and

(iv) in the case of a part of the description, claims or drawings, an indication as to where that part is contained in the earlier application and, where applicable, in any translation referred to in item (iii).

(b) [No change] Where the receiving Office finds that the requirements of Rule 4.18 and paragraph (a) have been complied with and that the element or part referred to in paragraph (a) is completely contained in the earlier application concerned, that element or part shall be considered to have been contained in the purported 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.

(c) Where the receiving Office 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), 20.5bis(b) or 20.5bis(c), as the case may be.

*[COMMENT: The proposed amendment of paragraph (c) is consequential on the proposed addition of new Rule 20.5bis.]*

## 20.7 Time Limit

(a) The applicable time limit referred to in Rules 20.3(a) and (b), 20.4, 20.5(a), (b) and (c), 20.5bis(a), (b) and (c), and 20.6(a) shall be:

(i) where an invitation under Rule 20.3(a), ~~or~~ 20.5(a) or 20.5bis(a), as applicable, was sent to the applicant, two months from the date of the invitation;

(ii) where no such invitation was sent to the applicant, 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.

*[COMMENT: The proposed amendment of paragraph (a) is consequential on the proposed addition of new Rule 20.5bis.]*

(b) [No change]

## 20.8 Incompatibility with National Laws

(a) [No change] If, on October 5, 2005, any of Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), and 20.6 are not compatible with the national law applied by the receiving Office, the Rules concerned shall not apply to an international application filed with 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 April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.

*[COMMENT: While Rule 20.5(a) is proposed to be amended (see above), in the view of the International Bureau, this should not give receiving Offices a new possibility to submit a notification of incompatibility of the Rules covering incorporation by reference of “truly missing” elements or parts, noting that the proposed amendment to Rule 20.5(a) only clarifies the scope of what is intended to be covered by those Rules, consequential on the proposed addition of new Rule 20.5bis(a)(ii) and (d) covering the incorporation by reference of “correct” elements or parts in the case of erroneously filed elements or parts.]*

[Rule 20.8, continued]

(a-bis) If, on [DATE] any of Rules 20.5bis(a)(ii) and (d) are not compatible with the national law applied by the receiving Office, the Rules concerned shall not apply to an international application filed with 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 [DATE]. The information received shall be promptly published by the International Bureau in the Gazette.

*[COMMENT: Proposed new Rule 20.8(a-bis) would provide receiving Offices the possibility to submit a notification of incompatibility of Rules 20.5bis(a)(ii) and (d) (the provisions covering incorporation by reference of “correct” elements or parts in the case of erroneously filed elements or parts). As had been agreed at the 11<sup>th</sup> session of the Working Group, Member States would be invited to adopt an Understanding according to which any receiving Office which submitted such a notice of incompatibility would agree to any request by the applicant to transmit an application in relation to which the applicant had confirmed the incorporation of a correct element or part in the case of erroneously filed element or part to the International Bureau under Rule 19.4(a)(iii).]*

(a-ter) (a-bis) Where ~~a missing an~~ element or a part cannot be incorporated by reference in the international application under Rules 4.18 and 20.6 because of the operation of paragraph (a) or paragraph (a-bis) of this Rule, the receiving Office shall proceed as provided for in Rule 20.3(b)(i), 20.5(b), ~~or~~ 20.5(c), 20.5bis(b) or 20.5bis(c), as the case may be. Where the receiving Office proceeds as provided for in Rule 20.5(c) or 20.5bis(c), the applicant may proceed as provided for in Rule 20.5(e) or 20.5bis(e), as the case may be.

*[COMMENT: The proposed amendment of current paragraph (a-bis) (proposed to be renumbered as paragraph (a-ter) is consequential on the proposed addition of new Rule 20.5bis and the proposed addition of new paragraph (a-bis) (see above). It is further proposed to add a specific reference to the transmittal of the application to the International Bureau as receiving Office under Rule 19.4(a)(ii); see also paragraph 9(b) in the main body of the present document with regard to the proposed adoption by the PCT Assembly of an Understanding, according to which any receiving Office which submitted such a notice of incompatibility would agree to any request by the applicant to transmit an application in relation to which the applicant had confirmed the incorporation of a correct element or part in the case of erroneously filed element or part to the International Bureau under Rule 19.4(a)(iii).]*

*[Rule 20.8, continued]*

(b) [No change] If, on October 5, 2005, any of Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), and 20.6 are not compatible with the national law applied by the designated Office, the Rules concerned shall not apply in respect of that Office in relation to an international application in respect of which the acts referred to in Article 22 have been performed before that 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 April 5, 2006. The information received shall be promptly published by the International Bureau in the Gazette.

*[COMMENT: While Rule 20.5(a) is proposed to be amended (see above), in the view of the International Bureau, this should not give designated Offices a new possibility to submit a notification of incompatibility of the Rules covering incorporation by reference of “truly missing” elements or parts, noting that the proposed amendment to paragraph (b) only clarifies the scope of what is intended to be covered by those Rules, consequential on the proposed addition of new Rule 20.5bis(a)(ii) and (d) covering the incorporation by reference of “correct” elements or parts in the case of erroneously filed elements or parts.]*

(b-bis) If, on [DATE], any of Rules 20.5bis(a)(ii) and (d) are not compatible with the national law applied by the designated Office, the Rules concerned shall not apply in respect of that Office in relation to an international application in respect of which the acts referred to in Article 22 have been performed before that 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 [DATE]. The information received shall be promptly published by the International Bureau in the Gazette.

*[COMMENT: Proposed new Rule 20.8(b-bis) would provide designated Offices the possibility to submit a notification of incompatibility of Rules 20.5bis(a)(ii) and (d) (the provisions covering incorporation by reference of “correct” elements or parts in the case of erroneously filed elements or parts).]*

(c) Where an element or part is considered to have been incorporated by reference in the international application by virtue of a finding of the receiving Office under Rule 20.6(b), but that incorporation by reference does not apply to the international application for the purposes of the procedure before a designated Office because of the operation of paragraph (b) or paragraph (b-bis) of this Rule, the designated Office may treat the application as if the international filing date had been accorded under Rule 20.3(b)(i) ~~or~~ 20.5(b) or 20.5bis(b), or corrected under Rule 20.5(c) or 20.5bis(c), as the case may be, provided that Rule 82ter.1(c) and (d) shall apply *mutatis mutandis*.

*[Rule 20.8(c), continued]*

*[COMMENT: The proposed amendment of paragraph (c) is consequential on the proposed addition of new Rule 20.5bis and the proposed addition of new paragraph (b-bis) (see above).]*

## Rule 43

### The International Search Report

43.1 to 43.6 *[No Change]*

43.6bis *[No Change]* *Consideration of Rectifications of Obvious Mistakes*

(a) A rectification of an obvious mistake that is authorized under Rule 91.1 shall, subject to paragraph (b), be taken into account by the International Searching Authority for the purposes of the international search and the international search report shall so indicate.

(b) A rectification of an obvious mistake need not be taken into account by the International Searching Authority for the purposes of the international search if it is authorized by or notified to that Authority, as applicable, after it has begun to draw up the international search report, in which case the report shall, if possible, so indicate, failing which the International Searching Authority shall notify the International Bureau accordingly and the International Bureau shall proceed as provided for in the Administrative Instructions.

43.6ter *Consideration of Elements and Parts Incorporated by Reference*

(a) An element or part which is, under Rule 20.6(b), considered to have been contained in 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 shall, subject to paragraph (b), be taken into account by the International Searching Authority for the purposes of the international search and the international search report shall so indicate.

*[Rule 43.6ter, continued]*

(b) The International Searching Authority may invite the applicant to pay additional fees where the fact that an element or part referred to in paragraph (a) is considered to have been contained in 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 is notified to that Authority only after it has begun to draw up the international search report. The invitation shall invite the applicant to pay the additional fees within one month from the date of the invitation and indicate the amount of those fees to be paid. The amount of those additional fees shall be determined by the International Searching Authority but shall not exceed the search fee; the additional fees shall be payable directly to that Authority. Provided any such additional fees have been paid within the prescribed time limit, the International Searching Authority shall establish the international search report on the international application including any such element or part referred to in paragraph (a).

*[COMMENT: It is proposed to add new Rule 43ter so as permit the International Searching Authority to charge an additional search fee (in an amount to be determined by that Authority) where the incorporation by reference of a “truly missing” part, or of a “correct” element or part in the case of an erroneously filed element or part is notified to the International Searching Authority only after it has begun to draw up the international search report. Consideration should be given to the question as to whether there is a need to also amend Rule 43.6bis(b) so as to permit an Authority to charge an additional fee in the case where the rectification of an obvious mistake is notified to the International Searching Authority only after it has begun to draw up the international search report.]*

43.7 to 43.10 *[No Change]*

## Rule 55

### Languages (International Preliminary Examination)

55.1 [No change]

55.2 *Translation of International Application*

(a) [No change] Where neither the language in which the international application is filed nor the language in which the international application is published is accepted by the International Preliminary Examining Authority that is to carry out the international preliminary examination, the applicant shall, subject to paragraph (b), furnish with the demand a translation of the international application into a language which is both:

- (i) a language accepted by that Authority, and
- (ii) a language of publication.

(a-bis) A translation of the international application into a language referred to in paragraph (a) shall include any element referred to in Article 11(1)(iii)(d) or (e) furnished by the applicant under Rule 20.3(b), [20.5bis\(b\)](#), [20.5bis\(c\)](#) or 20.6(a) and any part of the description, claims or drawings furnished by the applicant under Rule 20.5(b), [20.5\(c\)](#), [20.5bis\(b\)](#), [20.5bis\(c\)](#) or 20.6(a) which is considered to have been contained in the international application under Rule 20.6(b).

*[COMMENT: It is proposed to amend Rule 55.2(a-bis) so as to include references to Rules 20.5bis(b) and (c) relating to the furnishing of a correct “elements or parts” in the case of an erroneously filed element or parts. It is further proposed to add a reference to Rule 20.5(c) (unrelated to the proposed amendments related to erroneously filed elements or parts), as it would appear that the inclusion of this reference was overlooked when Rule 55.2(a-bis) was added in the context of the provisions dealing with incorporation by reference of missing elements or parts.]*

(a-ter) to (d) [No change]

55.3 [No change]



## Rule 76

### Translation of Priority Document;

#### Application of Certain Rules to Procedures before Elected Offices

76.1, 76.2 and 76.3 *[Remain deleted]*

76.4 *[No Change]*

76.5 *[No Change]* *Application of Certain Rules to Procedures before Elected Offices*

Rules 13~~ter~~.3, 20.8(c), 22.1(g), 47.1, 49, 49~~ter~~*bis*, 49~~ter~~ and 51~~bis~~ shall apply, provided that:

(i) any reference in the said Rules to the designated Office or to the designated State shall be construed as a reference to the elected Office or to the elected State, respectively;

(ii) any reference in the said Rules to Article 22, Article 23(2) or Article 24(2) shall be construed as a reference to Article 39(1), Article 40(2) or Article 39(3), respectively;

(iii) the words "international applications filed" in Rule 49.1(c) shall be replaced by the words "a demand submitted;"

(iv) for the purposes of Article 39(1), where an international preliminary examination report has been established, a translation of any amendment under Article 19 shall only be required if that amendment is annexed to that report;

(v) the reference in Rule 47.1(a) to Rule 47.4 shall be construed as a reference to Rule 61.2(d).

*[COMMENT: Rule 20.8(c) as proposed to be amended (see above), covering the case that a designated Office had submitted a notification of incompatibility of the provisions dealing with the incorporation by reference of correct elements or parts with its national law, would, by virtue of Rule 76.5, also apply to any elected Office.]*

## Rule 82ter

### Rectification of Errors Made

#### by the Receiving Office or by the International Bureau

##### 82ter.1 Errors Concerning the International Filing Date and the Priority Claim

(a) [No change] If the applicant proves to the satisfaction of any designated or elected Office that the international filing date is incorrect due to an error made by the receiving Office or that the priority claim has been erroneously considered void by the receiving Office or the International Bureau, and if the error is an error such that, had it been made by the designated or elected Office itself, that Office would rectify it under the national law or national practice, the said Office shall rectify the error and shall treat the international application as if it had been accorded the rectified international filing date or as if the priority claim had not been considered void.

(b) Where the international filing date has been accorded by the receiving Office under Rule 20.3(b)(ii), ~~or~~ 20.5(d) or 20.5bis(d) on the basis of the incorporation by reference under Rules 4.18 and 20.6 of an element or part but the designated or elected Office finds that:

- (i) the applicant has not complied with Rule 17.1(a), (b) or (b-bis) in relation to the priority document;
- (ii) a requirement under Rule 4.18, 20.6(a)(i) or 51bis.1(e)(ii) has not been complied with; or
- (iii) the element or part is not completely contained in the priority document concerned;

the designated or elected Office may, subject to paragraph (c), treat the international application as if the international filing date had been accorded under Rule 20.3(b)(i), ~~or~~ 20.5(b) or 20.5bis(b), or corrected under Rule 20.5(c) or 20.5bis(c), as applicable, provided that Rule 17.1(c) shall apply *mutatis mutandis*.

*[Rule 82ter, continued]*

(c) The designated or elected Office shall not treat the international application under paragraph (b) as if the international filing date had been accorded under Rule 20.3(b)(i), ~~or~~ 20.5(b) [or 20.5bis\(b\)](#), or corrected under Rule 20.5(c) [or 20.5bis\(c\)](#), without giving the applicant the opportunity to make observations on the intended treatment, or to make a request under paragraph (d), within a time limit which shall be reasonable under the circumstances.

(d) Where the designated or elected Office, in accordance with paragraph (c), has notified the applicant that it intends to treat the international application as if the international filing date had been corrected under Rule 20.5(c) [or 20.5bis\(c\)](#), the applicant may, in a notice submitted to that Office within the time limit referred to in paragraph (c), request that the missing part concerned be disregarded for the purposes of national processing before that Office, in which case that part shall be considered not to have been furnished and that Office shall not treat the international application as if the international filing date had been corrected.

*[COMMENT: It is proposed to amend Rule 82ter.1 so as to include references in paragraphs (b), (c) and (d) to Rules 20.5bis(b), (c) and (d) relating to the furnishing of a correct "elements or parts" in the case of an erroneously filed element or parts.]*

[End of Annex and of document]