

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

**Eighth Session**  
**Geneva, May 26 to 29, 2015**

### **CLARIFYING THE PROCEDURE REGARDING INCORPORATION BY REFERENCE OF MISSING PARTS**

*Document prepared by the International Bureau*

#### **SUMMARY**

1. As had been requested by the Working Group at its seventh session, the International Bureau has continued to discuss informally with interested Offices how to address the apparently different interpretation by receiving Offices and designated/elected Offices of the Regulations with regard to the incorporation by reference of missing parts. The present document summarizes the results of those discussions, including discussions at the twenty-second session of the Meeting of International Authorities, held in Tokyo from February 4 to 6, 2015.

#### **BACKGROUND**

2. The Working Group, at its sixth and seventh sessions, discussed how to address the apparently different interpretation by receiving Offices and designated/elected Offices of the provisions of Rules 4.18 and 20.5 and 20.6 with regard to the incorporation by reference of missing parts (see documents PCT/WG/6/20 and PCT/WG/7/19). This different interpretation results in different practices by Offices where the international application, on the international filing date, contains the necessary (but erroneously filed) complete claim(s) *element* and/or the necessary (but erroneously filed) complete description *element* (see Article 11(1)(iii)(d) and (e)) but the applicant nevertheless requests the incorporation by reference of all of the claims and/or all of the description contained in the priority application as a “*missing part*” in order to (at a later stage) completely replace the wrongly filed claims and/or description *elements* of the international application as originally filed with the equivalent “correct” version of those elements contained in the priority application.

3. The discussions during sixth and seventh sessions of the Working Group as well as the responses received in reply to a questionnaire sent by the International Bureau, in preparation of the discussions at the seventh session, to all Member States on the issue of incorporation by reference of missing parts (Circular C. PCT 1407, dated March 10, 2014) showed that there is no consensus among Member States on this issue.

4. Some Offices take the view that, under the above Rules, such practice is not permissible. These Offices argue that, by definition, the term “missing part” of the claims *element* or of the description *element* indicate that some part of such *element* was missing but other parts of that *element* had been filed. Incorporation by reference of a “missing part” would thus require that the “missing part” of the claims or description element that was to be incorporated by reference indeed “completed” that (incomplete) element as contained in the international application on the international filing date, rather than replacing it completely. Such practice would result in great difficulties for the International Searching Authority, being faced with an international application with in essence two sets of claims and two descriptions (“Should the search be carried out on both? Should a lack of unity of invention objection be raised?”) or, where such incorporation was granted only after that Authority had already begun with the international search or even only after it had already established the international search report, being faced with the need to carry out a second search without the possibility to charge the applicant a second search fee for its work.

5. Other Offices take the view that such practice is permissible. If not, it would result in the situation that an applicant who did not include any claim(s) and/or any description in the international application as filed would be allowed to have those elements included in the international application by way of incorporation by reference of a missing *element*, whereas an applicant who had attempted to include those elements in the international application as filed but who erroneously had filed the wrong claims and/or the wrong description would not be allowed to correct his mistake by submitting the correct elements. The applicant in the latter situation would thus be penalized for attempting to file a complete international application, albeit with the wrong claims and/or description elements. These Offices also refer to the fact that the Working Group, at its first session (see paragraphs 126 and 127 of document PCT/WG/1/16), had agreed that such practice was indeed permissible (“the Working Group noted that, in a case where the international application, on the international filing date, contained the necessary claim(s) element and description element (see Article 11(1)(iii)(d) and (e)), it was not possible under Rules 4.18 and 20.6(a) for the claims or description contained in a priority application to be incorporated as a missing element. However, it appeared to be possible, in such a case, for part or all of the description, or part or all of the claims, contained in the priority application to be incorporated under those Rules as a missing part.”), and that the Receiving Office Guidelines had been modified accordingly so as to clarify that, in the circumstances where incorporation by reference resulted in a duplicated set of description, claims or drawings, the set incorporated by reference was to be placed sequentially before the originally filed set.

6. During the seventh session of the Working Group, all delegations which took the floor acknowledged that the legal provisions regarding incorporation by reference of missing parts needed to be clarified, but expressed divergent views on how this should be achieved. The discussions at the seventh session concluded with the Working Group requesting the International Bureau to continue to work with interested Offices on the incorporation by reference of missing parts and present a document for the next session of the Working Group.

## **OPTIONS**

7. Since the seventh session, as had been requested by the Working Group, the International Bureau has continued to work with interested Offices, notably the European Patent Office and the United States Patent and Trademark Office, on a possible solution. Following those informal discussions, however, it would appear that the divergent views on how best to address the issue at hand, as set out in paragraphs 4 and 5, above, continue to exist.

8. There thus now would appear to be two options as to possible ways forward:
  - (a) Option A: leave the situation “as is”, that is, leave the “fate” of requests for incorporation by reference in the situation described in paragraph 2, above, to the (divergent) practices of the receiving Offices; or
  - (b) Option B: amend the PCT Regulations to require all receiving Offices to permit the incorporation by reference in the situation described in paragraph 2, above, for the purposes of the international phase only.
9. Option B is, in essence, the compromise solution set out in paragraph 16 of document PCT/WG/7/19. Despite the fact that this compromise solution had received little support during the seventh session of the Working Group, in the absence of a more promising alternative, it would appear to be the only viable option to address the issue at least for the purposes of the international phase.
10. The basic question to be answered by Member States in this context would appear to be the following: “Where the applicant has made an error (here: erroneously filing the wrong description and/or the wrong set of claims), resulting in the need to abandon the application as filed—likely at a point in time where the priority period had expired, thus potentially leading to a complete loss of rights: should the PCT provide the applicant with a “path/bridge” to reach the national phase (here: allowing the incorporation by reference of the missing description and/or claims for the purposes of the international phase only; and ensuring that an international search is carried out which takes into account the matter which has been incorporated by reference, for the benefit of those designated Offices which, under their applicable national laws, recognize such incorporation) if there is a remedy available under the national law of at least some PCT Contracting States to correct that mistake (here: designated Offices which, under their applicable national laws, allow such incorporation by reference to “stand” for the purposes of national phase procedures)?
11. If Member States were not able to agree on what the answer to that question should be, or if they were to agree that the answer should be “no”, then Option A (“leave situation as is”) would appear to be the only possible way forward.
12. If, on the other hand, Member States were to agree that the answer to that question should be “yes”, then Member States may wish to consider to amend the Regulations to provide for the following:
  - (a) require receiving Offices to permit the incorporation of an entire description and/or of an entire set of claims as a missing part under Rule 20;
  - (b) provide a legal basis for International Searching Authorities to charge an additional search fee if, at the time of incorporation, the International Searching Authority had already commenced with the establishment of the international search report;
  - (c) clarify that designated Offices whose national law does not allow for such incorporation may proceed with the application in the national phase as if such incorporation had not taken place.

## **DISCUSSIONS AT THE TWENTY-SECOND SESSION OF THE MEETING OF INTERNATIONAL AUTHORITIES**

13. The issue of incorporation by reference of missing parts and the two options as to possible ways forward set out in paragraph 8, above, was discussed by the Meeting of International Authorities during its twenty-second session, held in Tokyo from February 4 to 6, 2015. The Summary by the Chair of the meeting summarizes the discussions held as follows (see paragraphs 87 to 91 of document PCT/MIA/22/22, reproduced in the Annex to document PCT/WG/8/2):

“87. Discussions were based on documents PCT/MIA/22/14 Rev. and 14 Add.

“88. Several Authorities supported the proposed compromise solution set out as Option B in document PCT/MIA/22/14 and further refined in document PCT/MIA/22/14 Add. to amend the PCT Regulations to require receiving Offices to permit the incorporation by reference for the purposes of the international phase only. This would provide the applicant with a “bridge” into the national phase before those designated Offices which, under their national laws, allowed the incorporation by reference where the applicant had erroneously filed the wrong set of claims or the wrong description. Several drafting suggestions were offered in case that Option B were to be agreed upon.

“89. One Authority strongly opposed the proposed compromise solution, stating that the incorporation by reference of an entire set of claims or an entire drawing as a missing part was clearly covered not only by the spirit and intent but also by the wording of the current Regulations. The compromise solution would offer nothing to applicants from Member States whose Offices already today allowed such incorporation by reference both in their capacity as receiving Offices and designated Offices and would only benefit applicants from those Member States whose Offices did not do so. It suggested, as an additional Option C, to amend the Regulations to clarify that such incorporation was to be allowed, with effect for both receiving Offices and designated Offices.

“90. It was recognized that one of the root causes of the divergent views and practices on the issue of incorporation by reference of an entire set of claims or an entire description as a missing part might be the differences in approach taken in the Patent Law Treaty (PLT) and the PCT with regard to reference filings (under the PLT) and incorporation of missing elements and parts (under the PCT).

“91. Authorities agreed that, as there was no consensus on the issue and that the current divergent practices of receiving Offices and designated Offices would thus continue to exist, it was important to raise the awareness of applicants about those divergent practices and the possible consequences for applications during both the international and national phases of the PCT procedure. In this context, it was also agreed to review the Receiving Office Guidelines with a view to clarifying those divergent practices of receiving Offices.”

14. In view of the continued strong differences in opinion, the International Bureau believes that continued efforts aimed at finding a fully consistent solution appear disproportionate to the number of cases actually affected. Consequently, it is recommended that no further action is taken at this stage to attempt to align the divergent practices which exist at present. Instead, it is recommended that the International Bureau should work with Member States to modify the Receiving Office Guidelines with a view to clarifying the existing divergent practices of receiving Offices. It is further recommended that the International Bureau should work with Member States with a view to raising the awareness of applicants about those divergent practices and the possible consequences for applications during both the international and national phases of the PCT procedure.

15. *The Working Group is invited to comment on the issues set out in the present document.*

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