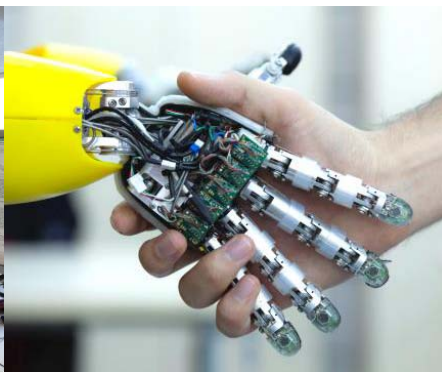




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'Real-file' examples from the international phase at the EPO

Questions by applicants about the PCT procedure



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Restoration of the right of priority

- Patent Law Treaty (PLT) introduces the concept of restoration of the right of priority (Article 13)
- Implemented in the PCT since 01.04.2017 (Rule 26bis.3)
- Incompatibility with national law:
 - To date 14 Offices acting as RO: BE, BR, CO, CU, CZ, DE, DZ, GR, ID, IN, IT, KR, NO, PH
 - To date 15 Offices acting as DO/EO: BR, CA, CN, CO, CU, CZ, DE, DZ, ID, IN, KR, MX, NO, PH, TR

Objectives

- **Maintain the right of priority** even if the international application is filed after the expiry of the priority year, for a period of up to 2 months from the 12-month time limit under Paris Convention
- Harmonisation
- In practice, however, there are two criteria for harmonisation:
 - non-intentionality and
 - due care

Decision by RO: admissibility

- **International filing date within 2 months from the date on which the priority period expired**
- **Within this 2-month period:**
 - Filing **request** for restoration
 - Paying **fee** for restoration (RO/EP: 640 EUR); time limit for payment may be extended by 2 months (exceptionally)
 - Furnishing **statement of reasons**; may be supported by declarations or other evidence

Decision by RO: merits (1/4)

- RO applies at least one of these two criteria:
 - ‘failure to file within the priority period occurred **in spite of due care** required by the circumstances having been taken’
 - ‘failure to file within the priority period was **unintentional**’
- Interpretation available in PCT/GL/RO (166 ff)

Decision by RO: merits (2/4)

- RO/EP applies only 'due care' criterion in line with EPC law and practice (Article 122 EPC)
- Non-compliance with the time limit must result either from:
 - an exceptional circumstance, or
 - an isolated mistake within a normally satisfactory system for monitoring time limits

Decision by RO: merits (3/4)

- Primary responsibility lies with the applicant:
 - proper instructions to the agent

- Agent has to show due care by virtue of the delegation:
 - expertise entails higher standard

- ‘Due care’ of the agent in dealing with an assistant: isolated mistake by an assistant dealing with a routine task, and:
 - suitable person selected for the task
 - properly instructed
 - reasonably supervised

Decision by RO: merits (4/4)

- General guidance:
 - The circumstances of a case must be considered as a whole
 - Relevant situation: the situation as it stood before the time limit expired
 - Due care must not be interpreted in an excessive manner
 - Reference: average, reasonably competent applicant and agent
 - PCT/RO/158

Real examples: Postal services

Example 1: Irregularity in mail service	Example 2: Force majeure
<ul style="list-style-type: none">• Agent selected a well-known postal delivery service• Proper instructions were delivered• The package was wrongly stored by the delivery service• The international application was filed past the priority period	<ul style="list-style-type: none">• Agent selected a well-known postal delivery service• Proper instructions were delivered• The postal delivery service went on strike• The international application was filed past the priority period

Real examples: Unrepresented individual applicant

Example 3: Ignorance of the law	Example 4: Missed entry in diary
<ul style="list-style-type: none">• Individual applicant• Not familiar with the PCT• Invoked ignorance of the consequences of missing the priority period	<ul style="list-style-type: none">• Individual applicant• Aware of the importance of filing prior to the expiry of the priority period• Monitored time limits using his computer diary• Miscalculated the 12-month time limit

Real examples: Represented applicant

Example 5: Wrong instructions	Example 6: Combined circumstances
<ul style="list-style-type: none">• Agent requests applicant to instruct whether an international application should be filed• Applicant replies in the affirmative, but indicates the wrong file number• Agent requests clarification twice• Applicant calls agent on the day of the deadline to confirm the request to file• Agent files application past midnight	<ul style="list-style-type: none">• Agent receives a request to file with amendments on the last day of priority period• The online filing system delivers an error message• The master key to the fax room is nowhere to be found• The fax is in 'save energy' mode• The application is only transmitted past midnight

Real examples: Exceptional circumstances

Example 7: Sudden illness	Example 8: Not so sudden illness
<ul style="list-style-type: none">• Small company• Agent stayed on duty in spite of pain, medical certificate was submitted (confidential)• Online transmission was received shortly past midnight of the last day of the priority period	<ul style="list-style-type: none">• Large company• Agent absent through illness on the date of expiry of the priority period• No deputy designated• International application filed upon return of the agent

Real examples: Cross-check mechanism

Example 9: Small company	Example 10: Big company
<ul style="list-style-type: none">• Two agents and one assistant• The assistant monitors time limits• Time limits are docketed in an electronic calendar• The wrong time limit was inadvertently entered• This was only noticed after expiry of the time limit, during a weekly review of open files	<ul style="list-style-type: none">• Several agents and assistants, numerous files• One assistant monitors time limits for one agent• Time limits are docketed in an electronic calendar• The wrong time limit was inadvertently entered• This was only noticed after expiry of the time limit, during a weekly review of open files

Real examples: Agent with assistant (1/2)

Example 11: Supervision	Example 12: Foreseeable absence
<ul style="list-style-type: none">• Assistant miscalculates priority date• Wrong date entered in the state of the art electronic tool for monitoring time limits• Experienced assistant without formal training• Written instructions by email• Periodical checks of the work carried out by the assistant	<ul style="list-style-type: none">• Main assistant on maternity leave• New temporary replacement hired• Ordered to continue monitoring time limits in the same way as she had done in her former position• No further measures taken• Time limit inadvertently missed

Real examples: Agent with assistant (2/2)

Example 13: Technically qualified assistant

- The assistant is an engineer training for the EQE (passed paper D)
- Instructed to draft the application
- Agent out of office on the last day of the priority period
- Assistant instructed to sign and submit the application using the smart card of the agent

Restoration at the DO: effect (Rule 49ter.1 PCT)

- Restoration by RO under **‘due care’ criterion**:
 - in principle, effective in all DOs (except those that notified incompatibility with national law)
 - however, the DO can review the decision by the RO if it reasonably doubts that one of the substantive requirements for restoration is complied with.

- Restoration by RO under **‘unintentional’ criterion**:
 - only effective in DOs that apply this criterion
 - if DO does apply the due care criterion, priority not considered restored

Practice at DO/EP

- 'Due care' criterion
- The applicant must file **a new request for restoration upon entry** where:
 - no request was filed during the international phase
 - RO granted under the 'unintentional' criterion
 - RO rejected the request for restoration
- In addition, DO may review a decision to restore when it has reasonable doubts as to whether one of the substantive requirements for restoration was complied with

Omitted parts or elements: background

- The PLT introduces the concept of incorporation by reference of missing parts (Article 5)
- Inclusion of accidentally omitted parts that are contained in an earlier application from which priority is validly claimed, without affected the international filing date

Omitted parts or elements: PCT framework

- Since 01.04.2007 implemented in the PCT, where the provision encompasses missing elements and missing parts
- Incompatibility with national law:
 - To date 8 Offices acting as RO: BE, CU, CZ, DE, ID, IT, KR, MX
 - To date 8 Offices acting as DO/EO: CN, CU, CZ, DE, ID, KR, MX, TR

Missing element

- The **whole description** or the **full set of claims**
- If RO finds that an **element is missing** in the papers purporting to be an international application, it invites the applicant:
 - **to furnish** the required element: the international filing date (IFD) will be the date on which the missing element is furnished, or
 - **to confirm** that the element is incorporated by reference: if the conditions for incorporation are met, the IFD will be the date of receipt of the purported application

Missing part

- Definition: **part of the description, part of the claims or part or all of the drawings**
- If RO finds that a **part is missing** in the international application, it invites the applicant:
 - **to furnish** the missing part: the international filing date (IFD) will be the date on which the missing part is furnished, or
 - **to confirm** that the part is incorporated by reference: if the conditions for incorporation are met, the IFD is maintained

Formal requirements: time limit

- If upon invitation by RO/EP: within two months from the date of the invitation
- At the own motion of the applicant: within two months from the international filing date

Formal requirements: confirmation

- Written notice confirming that the element or part is incorporated by reference accompanied by:
 - Sheet(s) embodying the element or part as contained in the priority document
 - A copy of the priority document, if not already submitted
 - A translation if the earlier application is not in the language of the international application
 - An indication of where the missing part is in the priority document

Substantive requirement: ‘completely contained’

- The omitted part or element must be completely contained in the earlier application from which the priority was validly claimed
- It thus must be identical to the corresponding text/drawing in the priority document

Real examples: general (1/2)

Example 1: Missing part unnoticed	Example 2: Addition of priority claim
<ul style="list-style-type: none">• Several pages of the description are missing• The number of pages indicated in the check list of the request is accurate• The applicant found out once the two months from the filing date had expired and he informed the RO accordingly	<ul style="list-style-type: none">• No priority claim in the request form• A few pages of drawings appear to be missing• These are completely contained in an earlier application whose priority is claimed one week after the international filing date

Real examples: general (2/2)

Example 3: Sequence listing	Example 4: Abstract
<ul style="list-style-type: none">• References to a sequence listing in the description• No reference to a sequence listing in the check list• No sequence listing filed on the international filing date• Sequence listing completely contained in the international application whose priority is validly claimed	<ul style="list-style-type: none">• No abstract filed on the international filing date• Abstract completely contained in the international application whose priority is validly claimed

Real examples: drawings

Example 5: Missing drawings	Example 6: Missing feature in a drawing
<ul style="list-style-type: none">• The international application was filed by fax• The fax transmittal was completed shortly past the midnight of the last day of the priority period• The whole set of drawings had been transmitted past midnight• The drawings were completely contained in the priority application	<ul style="list-style-type: none">• A feature of a drawing had been omitted• The number of pages of drawings in the check list was accurate• The RO did not notice that a feature of a drawing was missing• The applicant noticed it shortly after the international publication of the application

Real examples: Erroneous filings

Example 7: Replacing	Example 8: Adding
<ul style="list-style-type: none">• Applicant filed inadvertently the wrong set of claims• The set of claims that he intended to file is contained in an earlier application from which priority is claimed	<ul style="list-style-type: none">• Applicant filed inadvertently the wrong set of drawings• The set of drawings that he intended to file is contained in an earlier application from which priority is claimed

Developments at the PCT Working Group

- Two streams of interpretation of the provisions on missing elements and parts among the receiving Offices
- Proposal to tackle instances of erroneous filings by drafting a new provision

Advice to applicants

- This procedure is time consuming for both users and Offices and requests
- Always check the content of the acknowledgement of receipt after filing an international application

Effect on DO: full review (Rule 82ter.1 PCT)

- DOs may review decisions of ROs which have allowed incorporation by reference if the DO finds:
 - no priority document was furnished
 - the statement of incorporation was missing or not submitted
 - no required translation of the priority document was furnished, or
 - the element or part in question was not completely contained in the priority document

Effect on DO: outcome of review

- If the DO decides that the incorporation by reference did not meet the criteria:
 - The DO may treat the international application as if the international filing date had been accorded on the date on which the missing elements or parts were subsequently furnished
 - The DO has to give the applicant the opportunity to make observations on this outcome and to request that the late furnished missing parts be disregarded
- The above will also apply if the DO filed a notice of incompatibility

Entry into the European phase with the EPO

- Where the priority document is not in an EPO official language, the applicant must provide (Rule 51bis.1 PCT):
 - A translation of the priority document, and
 - In case of missing parts, an indication as to where that part is contained in the translation of the priority document

Obvious mistakes (Rule 91.1 PCT)

- Obvious mistakes can be rectified **within 26 months from priority** if:
 - the mistake is obvious and
 - the rectification is obvious
 - It must be obvious to the competent authority that something else was intended than what appears in the document concerned AND nothing else could have been intended than the proposed rectification
 - Rectification may occur:
 - upon request by the applicant
 - if the competent authority invites the applicant to do so

Obvious mistakes: competent authority

- **RO:** for mistakes in the **PCT request** or in a correction thereof
- **ISA:** for mistakes in the **description, claims or drawings** or in a correction thereof
- **IPEA:** for mistakes in the **description, claims or drawings** or in a correction thereof or in **amendments filed under Articles 19 or 34 PCT**
- **RO, ISA, IPEA or IB:** for mistakes in **any other document**

Obvious mistakes: documents to be considered

- In case of a mistake in the **description, claims and drawings** and, where applicable, a correction thereof: the content of the **description, claims and drawings** and, where applicable, the correction or amendment concerned
- In case of a mistake in the **request** or a correction thereof, or in a document under Rule 91.1(b)(iv) PCT: the content of the **international application**, where applicable of the correction, and **any other document (including the priority document) available on the applicable date**

Obvious mistakes: relevant date

- In case of a mistake in a part of the international application: **the international filing date**
- In case of a mistake in a document other than the international application: **the date on which the document was submitted**

Obvious mistakes: exclusions

- The mistake consists in the **omission of one or more elements or parts**
- The mistake is in the **abstract**
- The mistake is in an amendment filed under Article 19 PCT (unless the application is in PCT Chapter II)
- The mistake is in a **priority claim** or in a notice correcting or adding a priority claim where the rectification would cause a change in the priority date

Obvious mistake: effect of rectification

- The authority shall **promptly decide and notify** the decision taken. Reasons must be given in case of refusal
- If the obvious mistake is rectified, it shall be **effective**:
 - if in the international application, from the **international filing date**
 - if on another document, from the **date on which it was submitted**
- In case of **refusal**, the IB shall, upon request submitted within 2 months from the date of refusal, **publish the request for rectification, the reasons for refusal and any further brief comment submitted by the applicant**

Obvious mistakes: designated Office

- The DO may disregard the rectification if:
 - processing or examination has started prior to the date of notification of the decision
 - it finds that it would not have authorised it had it been the competent authority, but not before giving the opportunity to file observations to the applicant

Real examples:

Example 1: Deletion	Example 2: Name of applicant
<ul style="list-style-type: none">• The applicant requests the deletion of an erroneously filed paragraph in the description• The paragraph is not present in the earlier application from which priority is claimed	<ul style="list-style-type: none">• The second applicant listed in the request form had transferred its rights to another person months before the international filing date• A few inventors worked for the alleged applicant• Oversight when filling in the request form• Same mistake in the priority document, which had been corrected after the international filing date

Real examples: mixed languages

Example 3: Technical terms	Example 4: One sentence
<ul style="list-style-type: none">• Shortly before publication of the international application, the IB drew the attention of the RO to a series of technical terms in German• The international application had been drafted in English	<ul style="list-style-type: none">• The RO spotted a full sentence of the description drafted in English in an international application filed in French

Withdrawal of the international application (Rule 90bis PCT)

- When: Prior to 30 months from the priority date
- How:
 - Filing a notice of withdrawal with receiving Office, International Bureau or International Preliminary Examining Authority if ongoing PCT Chapter II
 - Waiver does not apply
- Effect:
 - Upon receipt of the notice by the applicant
 - International publication will not take place if the notice reaches the IB before technical preparations for publication are completed

Real examples: preventing publication (1/2)

Example 1: Conditional withdrawal	Example 2: Short time frames
<ul style="list-style-type: none">• Applicant requests withdrawal on condition that the application is not published• The notice of withdrawal is received at RO/EP at 15 months from the priority date• The notice of withdrawal is signed by all applicants	<ul style="list-style-type: none">• Applicant requests withdrawal on condition that the application is not published• The notice of withdrawal is received at RO/EP 15 days prior to the date scheduled for international publication• The notice of withdrawal is signed by all applicants

Real examples: preventing publication (2/2)

Example 3: Non payment of fees	Example 4: Deemed common representative
<ul style="list-style-type: none">• Applicant announces that the international search fee will not be paid and he thus requests that the processing of the application is discontinued• The notice is signed by the single applicant	<ul style="list-style-type: none">• Notice of withdrawal signed by deemed common representative• Conditional withdrawal subject to non-publication

Many thanks for your attention!

Feel welcome to contact me: iaurialansac@epo.org