

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



The background of the slide is a technical drawing of a mechanical assembly, rendered in a light gray color. It features various components, including what appears to be a piston or a similar cylindrical part, with numerous callout numbers such as 80, 84, 86, 82, 24, 30, 86, 34, 32, 52, and 50. The drawing is a cross-section, showing internal details and hatching for different materials or sections.

**FICPI Open Forum**

# **Incorporation by reference of missing elements and parts**

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# Incorporation by reference

- Provisions had origins in the Patent Cooperation Treaty (PCT) reform exercise from 2001-2007.
- Provisions mirror the Patent Law Treaty (PLT).
- Provisions provide a safety net for applicants.
- Applicants, on occasion, make errors which result in the omission of the correct portions of the application.
  - When, for example, assembling applications for filing
  - Amplified with electronic filing

# PCT Rule 4.18 (2007)

- Where the international application . . . claims the priority of an earlier application, the request may contain a statement that . . . where an element . . . or a part of the description, claims or drawings . . . is not otherwise contained in the international application but is completely contained in the earlier application, that element or part is incorporated by reference in the international application.

# PCT Rule 20.6 (2007)

- 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.
- These provisions mirror the PLT, but the PLT does not generally apply to PCT international phase applications.

# Divergent opinions

- USPTO – If some matter in the priority application differs from what is in the international application, it is incorporated by reference and may be inserted in the international application.
- EPO – There were no provisions which would allow the applicant to incorporate an entire set of claims or an entire description contained in the priority document where the international application already contained such an element.

# New Rule 20.5bis(a)-(c)

- The receiving Office (RO) will invite applicant to furnish missing elements or parts.
- If the Art. 11 filing date has not been granted, international filing date will be the date of receipt of missing elements or parts – incorrect material removed.
- If the Art. 11 filing date has been granted, and no incorporation statement has been provided, the filing date is changed to the date the correct elements or parts are submitted–incorrect material removed.

# New Rule 20.5bis(d)

- Where applicant furnishes a “correct” element or part to the receiving Office and validly confirms the incorporation by reference, 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.



# New Rule 20.5bis(d)

- In such a case, the erroneously filed element or part remains in the international application, in addition to the “correct” element or part incorporated by reference.
- A designated office which has submitted a notice of incompatibility will use the original submission.

# New Rule 20.5bis(e)

- Where a filing date has been changed, it is possible to request that the correct element or part be disregarded.
- Original filing date will be retained.

# U.S. position

- The U.S. felt that no changes were necessary to accomplish the desired goal since insertion of a complete element could be considered the addition of a part.
- At most, a minor amendment to Rule 4.18 would have clarified the issue.
- Narrow interpretation favors applicants who omit entire element.
- Third parties not harmed – before publication.

# U.S. position (2)

- The U.S. agreed to the present detailed changes to allow consensus to be reached.
- The ISA/US (U.S. as the International Search Authority) has no current plans to charge a fee under PCT Rule 43.6ter(b).
- The U.S. has no plans to have incompatibility clause(s).
- The U.S. will generally follow past practice.

# US concerns

- Lack of uniform applicability due to possible incompatibility clauses
  - As Receiving Office or designated office
  - Possible to transmit application to IB under PCT Rule 19.4 (understanding by PCT Assembly).
- Conflicts created for practitioners for applications from different applicants
  - U.S. argument - such material could be removed from application under PCT Rule 9.1(iv)

# PCT Working Group: New changes

- Safeguards in case of electronic outages affecting offices
- Proposal to provide for correction or addition of indications under Rule 4.11
- Proposal with respect to the availability of the file held by the International Preliminary Examining Authority

# PCT Working Group: Items under consideration

- Fee reductions for university applicants
- Inventor assistance program
- Appointment as an International Searching and Preliminary Examining Authority (ISA/IPEA) and declaration by receiving Offices as competent ISA/IPEA
- PCT collaborative search and examination

# Questions and comments

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