



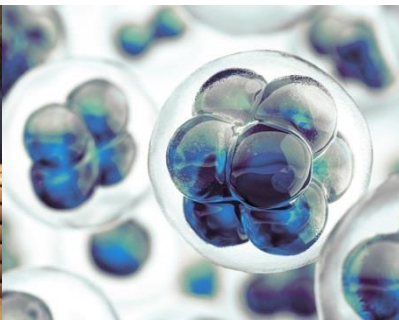
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The new framework for erroneous filings – An EPO perspective

FICPI 18th Open Forum, Vienna



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An EPO perspective on erroneous filings

Agenda

- **Introduction**

- The EPO's approach to finding a solution
 - Legal certainty
 - Transparency
 - Protection of third parties

- Relation between the new PCT framework and the EPC
 - Article 80 EPC
 - Article 123(2) EPC
 - Outlook

Introduction

The EPO's commitment to the public

- EPO acknowledges divergence of RO practices on corrections of erroneously filed application documents
- EPO recognizes users' need for a smart solution
- EPO provided constructive support during legislative process
- Solution caters to the needs of all stakeholders
 - Legal certainty
 - Transparency
 - Protection of third parties
- Equal service levels for Euro-direct and Euro-PCT applications

Rule 20.5 PCT

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The EPO's approach to finding a solution

Legal certainty

- Filing date accorded to elements on file on that date

• Article 11(1) and (2) PCT

- No addition of subject-matter to application-as-filed

• Articles 14(2), 19(2), 34(2) PCT

• Article 123(2) EPC (G 3/89)

- Correction of elements and parts by incorporation by reference must be a strictly regulated exception

• Rule 20.5*bis*(a)(ii) PCT

• Rule 20.5(a) and .5*bis*(d) PCT

• Rule 20.5*bis*(a) to (d), .7 PCT

• Rule 20.5*bis*(d) PCT

- Clear differentiation between “missing parts” and “erroneous” filings
- Clear conditions for correcting erroneous filings
- All elements must remain part of application

The EPO's approach to finding a solution

Transparency

- The basis for any decision must be clear to the public from the file

- **Rules 93 and 94 PCT**
- **Articles 113 and 128 EPC**

- Designated/elected Offices determine the disclosure of the application-as-filed

- **Article 27(5) PCT**

- Removal of erroneous elements from application must be an exception restricted to what was on file before the filing date

- **Rule 20.5*bis*(b) or (c) PCT**

- Removed element must remain in public file and must be translated for review purposes

- **Rule 51*bis*.1(viii) PCT**

The EPO's approach to finding a solution

Protection of third parties

- Publication of application-as-filed informs about possible future scope of protection

- **Article 21 PCT**
- **Articles 153(3) and (4) EPC**

- Third parties may trust that no subject-matter is added to the application-as-filed

- **Articles 14(2), 19(2), 34(2) PCT**
- **Article 123(2) EPC**

- Correction of application-as-filed after publication is not acceptable

- **PCT/WG/11/21 [30]**
- **Rule 20.7 PCT**

- Short time limits to ensure closure of procedure for according filing date in time for publication

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Relation between the new PCT framework and the EPC

Principles governing “application-as-filed”

- Every international application is a European application as of the filing date
- EPO is bound by the PCT as to form and contents
- EPO/DO determines disclosure as of filing date

Article 11(3) PCT and Article 153(2) EPC

Article 27(1) PCT and Article 150(2) EPC

Article 27(5) PCT and Article 123(2) EPC

Determination of the "application-as-filed"

Article 80 EPC

- Article 80 EPC relegates filing date requirements to the Implementing Regulations
- Rule 40(1) EPC = filing date for application documents on file on that date
- Rules 40(2) and 56(3) EPC make narrow exceptions recognized by case law of the boards of appeal
- Rule 56(3) EPC only for "objectively missing" parts according to case law of the boards of appeal

MR/2/00, p. 75

E.g. J 16/13, r. 16; J 27/10, r. 11 sq.

J 27/10, r. 11 sq.

Determination of the "application-as-filed"

Article 123(2) EPC

- **No amendment adding subject-matter to “the contents of the application as filed”**
 - Claims, description and drawings as filed
 - No priority documents even if on file on filing date
- **Article 123(2) EPC applies to corrections under Rule 139, second sentence, EPC**
- **Article 123(2) EPC applies to application documents to which a filing date was accorded**
 - Rule 56(3) EPC is narrow exception under Article 80 EPC
 - Rule 20.5*bis*(d) PCT is a broader exception

G 3/89

G 3/89

Outlook

Assessing the need for a notice of incompatibility and possible future steps

- EPO as RO and DO/EO applies PCT by virtue of EPC
- Compatibility with Articles 80 and 123(2) EPC
- Involvement of EPC contracting states
- Provision of equal service levels for Euro-direct applicants

Rule 20.8(a-bis) and (b-bis) PCT

Article 150 EPC

Article 33(1)(c) EPC

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