PCT at the EPO (advanced)

PCT New Rule 20.5bis – Incorporation by reference at the EPO

Paola Giancane, Lawyer, PCT Affairs, EPO

Eva Bach, Lawyer, Patent Law, EPO

13 October 2020
Presenter (1/2)

Paola Giancane

- Lawyer in PCT Affairs Department since 2013, EPO (Munich)
- Law degree in European and International Law at the University of Pisa (Italy)
- LLM in European Law at the College of Europe (Bruges - Belgium)
- Previous work experience: EUIPO (Alicante – Spain), European Commission (DG COMP, Brussels - Belgium), Van Bael and Bellis (Brussels - Belgium)
- Contact: pgiancane@epo.org
Presenters (2/2)

Eva Bach

 Bá Lawyer, Dir. Patent Law, Dept. Filing & Euro-PCT, EPO Munich

 Bá Joined the EPO in 2002

 Bá Studied law in Munich and Paris

 Bá Université Panthéon Assas (Paris II), Licence en Droit

 Bá Graduated with second state law exam in Munich

 Bá Contact: ebach@epo.org
Moderator

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Examiner for Medical Devices, EPO Munich

Technical Expert for PCT Affairs Department

Joined the EPO in 2017

Studied Mechanical Engineering and worked as researcher at TU Munich (Germany) with stays in the USA and in Japan

Contact: tlueddemann@epo.org
## Agenda

1. History and context
2. New Rule 20.5bis PCT: possible scenarios
3. Incompatibility with national law
4. Procedure before the EPO as RO
5. Procedure before the EPO as ISA
6. Procedure before the EPO as SISA and IPEA
7. Procedure before the EPO as DO
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History and context

- New R. 20.5bis PCT: adopted by PCT Union Assembly in 2019; entered into force on 01.07.2020

- Background: different interpretation of R. 20.5 PCT among receiving Offices - ‘truly’ missing vs not filed

- Now clear differentiation between these two situations: increased legal certainty

- New R. 20.5bis PCT allows the applicant to correct an erroneously filed element or part of the international application
History and context

Definitions:

⇒ Erroneously filed element: the whole description or the full set of claims

⇒ Erroneously filed part: part of the description, part of the claims or part of the drawings (including all drawings)
## Agenda

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New Rule 20.5bis PCT: possible scenarios

Scenario 1:
Correct element or part not furnished for the purpose of incorporation by reference

Scenario 2:
Correct element or part furnished for the purpose of incorporation by reference

Request for correction of an erroneously filed element or part
New Rule 20.5bis PCT: possible scenarios

Scenario 1: Correct element or part not furnished for the purpose of incorporation by reference

Rule 20.5bis(b) PCT
Filed on or before the date on which all requirements of Article 11(1) PCT are fulfilled but within time limit under Rule 20.7 (para. 3.a) of the Notice

Rule 20.5bis(c) PCT
Filed after the date on which all requirements of Article 11(1) PCT are fulfilled but within time limit under Rule 20.7 (para. 3.b) of the Notice

Scenario 2: Correct element or part furnished for the purpose of incorporation by reference

Rule 20.5bis(d) PCT
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New Rule 20.5bis PCT: possible scenarios

Scenario 1: Correct element or part not furnished for the purpose of incorporation by reference

Rule 20.5bis(b) PCT
Filed on or before the date on which all requirements of Article 11(1) PCT are fulfilled but within time limit under Rule 20.7 (para. 3.a) of the Notice

Int. filing date: date on which all of the requirements of Article 11(1) are fulfilled

- Correct element/part included
- Wrong element/part removed (kept in the file)

Rule 20.5bis(c) PCT
Filed after the date on which all requirements of Article 11(1) PCT are fulfilled but within time limit under Rule 20.7 (para. 3.b) of the Notice

Scenario 2: Correct element or part furnished for the purpose of incorporation by reference

Rule 20.5bis(d) PCT
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New Rule 20.5\textit{bis} PCT: possible scenarios

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New Rule 20.5bis PCT: possible scenarios

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**Scenario 2:** Correct element or part furnished for the purpose of incorporation by reference
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- **Int. filing date:** shifted to the date on which correct element/part was received
- Correct element/part included
- Wrong element/part removed (kept in the file)

**Rule 20.5bis(c) PCT**

**Rule 20.5bis(d) PCT**

- Filed **after** the date on which all requirements of Article 11(1) PCT are fulfilled but within time limit under Rule 20.7 (para. 4 of the Notice)

Unless
- The applicant requests within 1 month that the correct element/part be disregarded under Rule 20.5bis(e) PCT
New Rule 20.5bis PCT: possible scenarios

**Scenario 1:**
Correct element or part not furnished for the purpose of incorporation by reference

**Rule 20.5bis(b) PCT**
- Filed **on or before** the date on which all requirements of Article 11(1) PCT are fulfilled but within time limit under Rule 20.7 (para. 3.a) of the Notice
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- Correct element/part included
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- **Int. filing date:** shifted to the date on which correct element/part was received
- Correct element/part included
- Wrong element/part removed (kept in the file)

**Scenario 2:**
Correct element or part furnished for the purpose of incorporation by reference

**Rule 20.5bis(d) PCT**
- Filed **after** the date on which all requirements of Article 11(1) PCT are fulfilled but within time limit under Rule 20.7 (para. 4 of the Notice)

If the request for incorporation by ref. is granted:
- No shift of int. filing date
- Correct element/part considered to have been contained in the application as filed
- Wrong element/part kept in the int. appl. but marked as “ERRONEOUSLY FILED (RULE 20.5bis)”

**Unless**
- The applicant requests within 1 month that the correct element/part be disregarded under Rule 20.5bis(e) PCT
Example: New Rule 20.5bis PCT

Question 1

May I rely on the receiving Office to check whether the international application contains an erroneously filed element or part?

- yes  "  no
Example: New Rule 20.5bis PCT

Solution

May I rely on the receiving Office to check whether the international application contains an erroneously filed element or part?

† The correct answer is: “no”

† The receiving Office does not specifically check that: it only checks the title of the invention as appearing in the beginning of the description against the one appearing in the request. However, if it finds that any element or part has or appears to have been erroneously filed, it brings the applicant’s attention to this fact.
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Incompatibility with national law: overview

- Receiving and designated Offices had the possibility to file a notification of incompatibility:
  ⇒ if the incorporation by reference of a correct element or part is not compatible with their national law


- Updated information may be found at: [https://www.wipo.int/pct/en/texts/reservations/res_incomp.html](https://www.wipo.int/pct/en/texts/reservations/res_incomp.html)
Incompatibility: procedure before the EPO

The EPO filed a notification of incompatibility as **receiving and designated Office:**

⇒ incompatibility with R. 56 EPC
⇒ inc. by reference of correct element or part not possible

However, no impact on file processing by the EPO as ISA
⇒ search in principle based on correct element or part
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Procedure before the EPO as RO

Scenario 1: Correct element or part not furnished for the purpose of incorporation by reference

Rule 20.5bis(b) PCT
- Filed on or before the date on which all requirements of Article 11(1) PCT are fulfilled but within time limit under Rule 20.7 (para. 3.a) of the Notice
- Int. filing date: date on which all of the requirements of Article 11(1) are fulfilled
  - Correct element/part included
  - Wrong element/part removed (kept in the file)

Scenario 2: Correct element or part furnished for the purpose of incorporation by reference

Rule 20.5bis(c) PCT
- Filed after the date on which all requirements of Article 11(1) PCT are fulfilled but within time limit under Rule 20.7 (para. 3.b) of the Notice
- Int. filing date: shifted to the date on which correct element/part was received
  - Correct element/part included
  - Wrong element/part removed (kept in the file)

Rule 20.5bis(d) PCT
- Filed after the date on which all requirements of Article 11(1) PCT are fulfilled but within time limit under Rule 20.7 (para. 4 of the Notice)

If the request for incorporation by ref. is granted:
- No shift of int. filing date
- Correct element/part considered to have been contained in the application as filed
- Wrong element/part kept in the int. appl, but marked as "ERRONEOUSLY FILED (RULE 20.5bis)"

The applicant requests within 1 month that the correct element/part be disregarded under Rule 20.5bis(e) PCT
Procedure before the EPO as RO

**Scenario 1:** Correct element or part not furnished for the purpose of incorporation by reference

- **Rule 20.5bis(b) PCT**
  - Filed on or before the date on which all requirements of Article 11(1) PCT are fulfilled but within time limit under Rule 20.7 (para. 3.a) of the Notice
  - **Int. filing date:**
    - date on which all of the requirements of Article 11(1) are fulfilled
  - Correct element/part included
  - Wrong element/part removed (kept in the file)

**Scenario 2:** Correct element or part furnished for the purpose of incorporation by reference

- **Rule 20.5bis(c) PCT**
  - Filed after the date on which all requirements of Article 11(1) PCT are fulfilled but within time limit under Rule 20.7 (para. 3.b) of the Notice
  - **Int. filing date:**
    - shifted to the date on which correct element/part was received
  - Correct element/part included
  - Wrong element/part removed (kept in the file)

- **Rule 20.5bis(d) PCT**
  - Filed after the date on which all requirements of Article 11(1) PCT are fulfilled but within time limit under Rule 20.7 (para. 4 of the Notice)
  - Request not processed by the EPO as RO due to the notification of incompatibility
  - If authorised by the applicant, int. appl. transmitted to the IB as RO (R. 19.4(a)(iii) PCT)
  - If the request for incorporation by ref. is granted by RO/IB:
    - No shift of int. filing date
    - Correct element/part considered to have been contained in the application as filed
    - Wrong element/part kept in the int. appl. but marked as "ERRONEOUSLY FILED (RULE 20.5bis)"

The applicant requests within 1 month that the correct element/part be disregarded under Rule 20.5bis(e) PCT
Procedure before the EPO as RO

 Scenario 1: incorporation by reference is not requested (R. 20.5bis(b) or (c) PCT):
   ⇒ request processed by the EPO as receiving office

 Scenario 2: incorporation by reference is requested (R. 20.5bis(d) PCT):
   ⇒ international application transmitted to the International Bureau as receiving office (R. 19.4(a)(iii) PCT), if the applicant authorises the transmittal
### Practical example: procedure before the EPO as RO

#### Question 2

<table>
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<th>Example 1:</th>
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<td>• The applicant files an international appl. with RO-EP, which however contains the wrong description</td>
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<td>• The correct description is contained in a priority document validly claimed on the date of filing</td>
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</tr>
<tr>
<td>• The applicant finds out after the international filing date is accorded</td>
<td>• The applicant finds out before the international filing date is accorded</td>
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</table>

Would you request in both cases incorporation by reference of the correct description under R. 20.5bis(d)?

- yes  
- no  

European Patent Office
# Practical example: procedure before the EPO as RO

## Solution

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=> **Request under R. 20.5bis(d) PCT, (RO-EP may however not process this request: possible transmittal to RO-IB)**

=> **Request to correct under R. 20.5bis(b) PCT possible**

"no"
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06. Procedure before the EPO as SISA and IPEA
07. Procedure before the EPO as DO
Procedure before the EPO as ISA

Scenario 1: Correct element or part not furnished for the purpose of incorporation by reference

Rule 20.5bis(b) PCT
Filed on or before the date on which all requirements of Article 11(1) PCT are fulfilled but within time limit under Rule 20.7 (para. 3.a) of the Notice

Rule 20.5bis(c) PCT
Filed after the date on which all requirements of Article 11(1) PCT are fulfilled but within time limit under Rule 20.7 (para. 3.b) of the Notice

Scenario 2: Correct element or part furnished for the purpose of incorporation by reference

Rule 20.5bis(d) PCT
Filed after the date on which all requirements of Article 11(1) PCT are fulfilled but within time limit under Rule 20.7 (para. 4 of the Notice)

ISR and WO-ISA based on correct element or part

If correction notified by the RO to the ISA

Before the start of the search (par. 5.a) of the Notice

After the start of the search but additional fee paid (par. 5.b) of the Notice
Procedure before the EPO as ISA

Scenario 1: Correct element or part not furnished for the purpose of incorporation by reference

Rule 20.5bis(b) PCT
Filed **on or before** the date on which all requirements of Article 11(1) PCT are fulfilled but within time limit under Rule 20.7 (para. 3.a) of the Notice

Rule 20.5bis(c) PCT
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Scenario 2: Correct element or part furnished for the purpose of incorporation by reference

Rule 20.5bis(d) PCT
Filed **after** the date on which all requirements of Article 11(1) PCT are fulfilled but within time limit under Rule 20.7 (para. 4 of the Notice)

ISR and WO-ISA based on correct element or part

If correction notified by the RO to the ISA

Before the start of the search
(par. 5.a) of the Notice

After the start of the search **but additional fee paid**
(par. 5.b) of the Notice

The EPO as ISA will also complete the initiated search and issue a **non-official** ISR/WO-ISA based on the int. appl. initially transmitted
(par. 6 of the Notice)
Practical example: procedure before the EPO as ISA

Question 3

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<td>• International application contains wrong claims</td>
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<td>• Incorporation by reference of the correct claims accepted by the RO (R. 20.5bis(d) PCT)</td>
<td>• Correction accepted by the RO (R. 20.5bis(c) PCT) – shift of filing date</td>
</tr>
<tr>
<td>• ISA/EP notified after the start of the search and additional fee not paid</td>
<td>• ISA/EP notified after the start of the search and additional fee not paid</td>
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Would the search in these cases be based on the correct claims?

- yes  - no
Practical example: procedure before the EPO as RO

Solution

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<tr>
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<td>• ISA/EP notified after the start of the search and additional fee not paid</td>
</tr>
<tr>
<td>=&gt; Correct claims disregarded = search based on the initially filed ones</td>
<td>=&gt; Correct claims disregarded = declaration of no search</td>
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"no"
## Agenda

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Procedure before the EPO as SISA and IPEA

EPO as IPEA:
- International preliminary examination is based on the correct element or part if the international search itself is based on correct element or part

EPO as SISA:
- Supplementary international search is based on the correct element or part if the international search itself is based on correct element or part
Agenda

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### The EPO as designated office: scenarios

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<th>Rule 20.5bis(b) or (c) PCT</th>
<th>Rule 20.5bis(d) PCT</th>
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| Corrections accepted by RO under Rule 20.5bis(b) or (c) PCT (RO = EPO or other) | Corrections accepted by RO under Rule 20.5bis(d) PCT (RO = EPO),  
  - incorporation by reference  
  - no shift of filing date in international phase |

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R. 20.5bis(a)(ii) and (d) PCT  
R.20.8(b-bis) PCT  
R. 20.8(c) PCT  
OJ EPO 2020, A81
The EPO as designated office: scenarios

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

- Corrections accepted by RO under Rule 20.5bis(b) or (c) PCT (RO = EPO or other)
- Corrections are **effective** before the EPO as designated Office
- No change of the filing date or of the content of disclosure as filed

**Rule 20.5bis(d) PCT**

- Corrections accepted by RO under Rule 20.5bis(d) PCT (RO = EPO),
  - incorporation by reference
  - no shift of filing date in international phase
- Notification of incompatibility
- Corrections are **not effective** before the EPO as designated Office under Rule 20.8(c) PCT

Following slides

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R. 20.5bis(a)(ii) and (d) PCT
R.20.8(b-bis) PCT
R. 20.8(c) PCT
OJ EPO 2020, A81
The EPO as designated office (R. 20.5bis(d) PCT)

Where corrections are not effective the applicant has two options on entry into the European phase:

⇒ proceed with the correct documents, whereby the date of filing is shifted to the date of receipt of these documents

or

⇒ proceed with the erroneously filed documents, whereby the initial date of filing is maintained
The EPO as designated office (R. 20.5bis(d) PCT)

Recommended procedure

Applicants inform about their choice within 31-months (at the latest before the EPO issues the communication Rules 20.8(c) PCT and 82ter.1(c) and (d))

⇒ The communication informing the applicants on their options under Rules 20.8(c) PCT and 82ter.1(c) and (d) PCT is not sent

⇒ The processing of the Euro-PCT application continues immediately (depending on whether a decision on the date of filing is issued or not)

⇒ There may be a positive effect on the calculation of the page fee
The EPO as designated office (R. 20.5bis(d) PCT)

Standard procedure

An applicant **does not** inform the EPO about their choice in time

- the EPO considers
  - date of filing: date of receipt of the correct documents
  - application as filed: correct documents, not erroneously filed

**Right to be heard:** communication under Rules 20.8(c) PCT and 82ter.1(c) and (d) PCT

- informs the applicants about above handling and their options
- **2 months** time limit to reply
The EPO as designated office (R. 20.5bis(d) PCT)

EPO issues communication under Rules 20.8(c) PCT and 82ter.1(c) and (d) PCT

- Applicant does not react
- Applicant requests within 2 months from communication that the correct application documents be disregarded (R. 82ter.1(d) PCT)
- Applicant files observations (R. 82ter.1(c) PCT)

R. 20.8(c) PCT
R. 82ter.1(c) and (d) PCT
OJ 2020, A81
The EPO as designated office (R. 20.5bis(d) PCT)

- EPO issues communication under Rules 20.8(c) PCT and 82ter.1(c) and (d) PCT
- Applicant does not react
- Applicant requests within 2 months from communication that the correct application documents be disregarded (R. 82ter.1(d) PCT)
- Applicant files observations (R. 82ter.1(c) PCT)

**Interlocutory decision**
- **Filing date**: changed to initial filing date
- **Application as filed**: considered to include erroneously filed application documents but not correct application documents

Application continues as indicated in communication
**The EPO as designated office (R. 20.5bis(d) PCT)**

- EPO issues communication under Rules 20.8(c) PCT and 82ter.1(c) and (d) PCT

  - Applicant does not react
  - Applicant requests within 2 months from communication that the correct application documents be disregarded (R. 82ter.1(d) PCT)
  - Applicant files observations (R. 82ter.1(c) PCT)

  - Application continues as indicated in communication
  - Interlocutory decision
    - **Filing date**: changed to initial filing date
    - **Application as filed**: considered to include erroneously filed application documents but not correct application documents
  - Interlocutory decision

- Processing of the Euro-PCT application continues on this basis
Summary of possible scenarios at the EPO

Corrections accepted by RO under Rule 20.5bis(b) or (c) PCT
(RO = EPO or other)

- Corrections are effective before the EPO as designated or elected Office
- No change of the filing date or of the content of disclosure as filed (par. 8 of the Notice)

Corrections accepted by RO under Rule 20.5bis(d) PCT
(RO ≠ EPO)

- Corrections are not effective before the EPO as designated or elected Office under Rule 20.8 (c) PCT (pars. 9ff of the Notice)
- Filing date: considered to be the date on which the correct application documents were received
- Application as filed: considered to include the correct application documents but not the erroneously filed application documents

The applicant may abridge the procedure and indicate his choice on entry into the European phase: Communication setting a time limit will not be sent (pars. 16ff of the Notice)

EPO issues communication informing applicant thereof (pars. 10ff of the Notice)

Applicant does not react

Applicant requests within 2 months from communication that the correct application documents be disregarded (R. 82ter.1(d)) PCT

Interlocutory decision
- Filing date: changed to initial filing date
- Application as filed: considered to include erroneously filed application documents but not correct application documents

Applicant files observations (R. 82ter.1(c) PCT)

Application continues as indicated in communication

Interlocutory decision

European Patent Office
Example 5: Recommended procedure - applicant proceeds with correct application documents and with later filing date

- International phase: Wrong description erroneously filed on international filing date. Correct description is filed later and incorporated by reference (Rule 20.5bis(d) PCT). No change of the filing date.

- Entry into EP phase: Applicant requests
  - Filing date: date of receipt of correct documents
  - Application as filed: correct documents, but not erroneously filed documents

- Applicant is informed that European phase processing will continue accordingly
Procedure before the designated Office (R. 20.5bis(d) PCT)

Question 4

An applicant opts to proceed with the later filing date and with the correct part but not with the erroneously filed part.

Can the applicant re-introduce content only disclosed in the erroneously filed part by amending the application during European phase processing?

\[ \text{yes} \quad \text{no} \]
Procedure before the designated Office (R. 20.5bis(d) PCT)

Solution

An applicant opts to proceed with the later filing date and with the correct part but not with the erroneously filed part.

Can the applicant re-introduce content only disclosed in the erroneously filed part by amending the application during European phase processing?

" no

The EPO establishes the documents forming part of the application as filed under this new procedure. These documents define the content of the application as filed within the meaning of Article 123(2) EPC.
Procedure before the designated Office (R. 20.5bis(d) PCT)

Question 5

An applicant opts to proceed with the correct part and with the later filing date.

Can it happen that the priority date is lost?

yes  no
Procedure before the designated Office (R. 20.5bis(d) PCT)

Solution

An applicant opts to proceed with the correct part and with the later filing date.

Can it happen that the priority date is lost?

• yes

Changing the filing date to the date of receipt of the correct application documents may result in the loss of a priority right claimed. Restoration of the right of priority under Rule 49ter.2 PCT may be available. A corresponding request must be filed within 1 month from expiry of the 31-month time limit or within 1 month from an effective request for early processing (Rule 49ter.2(b)PCT).
Practical examples: procedure before the designated office

Example 6: Standard procedure - applicant proceeds with initial filing date and with the erroneously filed documents

- International phase: Wrong claims erroneously filed on international filing date. Correct claims are filed later and incorporated by reference (Rule 20.5bis(d) PCT). No change of the filing date.

- Entry into EP phase: Communication issued under Rules 20.8(c) and 82ter.1(c) and (d) PCT

- Applicant requests within 2 months that the correct application documents be disregarded and the initial filing date be maintained

- Interlocutory decision issued accordingly (Filing date: initial filing date, application as filed: includes erroneously filed claims but not correct claims)
Question 6

- An applicant opts to proceed in the European phase with the initial filing date and with the **erroneously filed part**.
- The EPO was ISA and the ISR was performed on the basis of the **correct application documents**.
- There is **non-unity** between the subject-matter of the ISR and the invention claimed in the European phase.

Will the EPO perform a search with regard to the invention claimed in the European phase?

- yes  
- no
Procedure before the designated Office (R. 20.5bis(d) PCT)

Solution

- An applicant opts to proceed in the European phase with the initial filing date and with the **erroneously filed part**.
- The EPO was ISA and the ISR was performed on the basis of the **correct application documents**.
- There is **non-unity** between the subject-matter of the ISR and the invention claimed in the European phase.

Will the EPO perform a search with regard to the invention claimed in the European phase?

- **yes**

The EPO will perform a search upon payment of a search fee (Rule 164(2) EPC).
Wrap-up

• Possibility to correct an erroneous filing under the PCT since 01.07.2020

• EPO as RO and DO filed a notification of incompatibility with regard to the possibility to incorporate by reference a correct element/part

• EPO as RO: if incorporation by reference is requested, international application may be transmitted, if the applicant so wishes, to the IB as RO

• EPO as ISA: no impact of the notification of incompatibility – in principle, search based on correct element or part

• EPO as DO: corrections accepted by RO as incorporation by reference are not effective. The applicant may choose whether to proceed with initial filing date and erroneously filed application documents or with later filing date and with correct application documents.
Further questions

Questions

now via chat to "All Panelists"

later via mail

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