

Guidelines2day

Validity of the priority claim and information
on new Rule 56a EPC

Live session on 6 April 2022 (PL95-2022)

Questions and answers

Preamble

This is a collection of questions which were asked during the Q&A part of the presentation but which could **not** be answered during the live session anymore.

In Rule 56a(5) EPC there is a part (a) and (b), followed by a sentence starting with "any filing of the correct application documents". In this sentence, it is mentioned "... or restored ...". What is the meaning of this? Why was it introduced? Such wording cannot be found in PCT Rule 20.5bis.

Under Rule 56a(3) EPC the date of filing is shifted, the correct application documents are included into the application and the erroneously filed documents are deemed not to have been filed. If the applicant then withdraws the correct documents under Rule 56a(7) EPC, the re-dating of the filing date is deemed not to have been made, the correct application documents are deemed not to have been filed and the erroneously filed application documents are restored to the application under Rule 56a(5) EPC.

Under R56a(4), do both the erroneous and the correct parts get published? Is it possible to remove the erroneous part before publication?

Under Rule 56a EPC, the application will be published with the application date and the application documents as corrected under this provision, i.e. according to the outcome of this procedure. In cases falling under Rule 56a(4) EPC where the correct parts are added without change of the filing date, the correct documents and, additionally, the erroneously filed documents will be published. This is because the erroneously filed documents remain part of the application as filed.

Are sequence listings not always part of the description? Even if filed in ST.25/ST.26?

Sequence listings are only part of the description if they are filed on the filing date and not only later for search purposes (see OJ EPO 2021, A97, I, points 9 and 15).

If understood correctly, ST.25 or ST.26 files ***cannot*** be considered under R56a?

Sequence listing that are part of the description can be corrected under Rule 56a EPC.

How is it possible to correct erroneously filed parts before the filing date? When erroneously filed parts have been filed, then normally the filing date will get the filing date of the day when those erroneously filed parts have been filed? Then it would not be possible to correct anymore before the filing date? Or do I miss the point?

Only if the conditions under Rule 40(1) EPC are met, a filing date is accorded. If documents are received but one of the conditions is not met, a filing date is not accorded for the date of receipt. Examples: (1) If no description but only claims are filed and the claims do not qualify as description, no filing date is accorded on the date of receipt of the claims. (2) There is no information identifying the applicant filed or allowing the applicant to be contacted on the date the application documents are received.

Suggestion - Will the EPO provide information advising users that a redated application cannot provide a basis for claiming priority?

Information about Rule 56a EPC will be published in the Official Journal before entry into force of Rule 56a EPC. The priority of an application corrected under Rule 56a EPC can however be claimed in a second filing. A re-dating of an application under Rule 56a EPC may result in the date of filing being outside the twelve-month priority period. In such case the priority claimed in the corrected application may be lost.

Am I correct, that Rule 56a EPC ALSO applies to claims? The Rules says "application documents".

Yes, this is correct, Rule 56a EPC also applies to claims or parts of claims.

Rule 56a includes claims, but 56 not. So, when I have filed 1 page of claims, but missed the second, I cannot get them as missing parts, while I could get corrected claims if there was an error in it. Can you confirm?

Yes, this is true.

I could file without paying the filing fee and if after some days I encounter errors within the filed documents I could simply file a new application with the correct documents and only pay the filing fee for the second application?

Yes, this is correct. The first application would then be deemed to be withdrawn for failure to pay the filing fee under Article 78(2) EPC.

There have been many cases where applicants were different for US vs rest of the world. I was surprised that the referral came only now. Do you know why only now?

There are only few cases where the formal priority issue eventually proves decisive for a case even though it was intensely discussed by the parties. In addition, not all cases where an examining or opposition division decided on priority, the division had to rely on the "PCT joint applicants approach". In cases that are appealed, boards of appeal sometimes take another view on specific issues relating to added matter or sufficiency of disclosure and the question of formal validity of the priority claim does not pose itself. In other appeal cases the boards are asked to decide on the basis of amended claims where the problem does not arise.