Correction of Defects Relating to the Filing of the Application

Cases where no international filing date will be accorded

1. lack of at least one applicant who is a national or resident of a PCT Contracting State
2. no description
3. no claims
4. description or claims in non-admitted language
5. no designation
6. no petition that the application is to be processed as a PCT application

Receiving Office Functions

9 Receiving Office

U.S.
EPO
AU
JP
Austria

Help Desk
703-305-3257

9. Not all the requirements of the international application must be examined by the receiving Office. For instance, the receiving Office does not deal with substantive questions such as whether the disclosure of the invention in the application is sufficient and whether the requirement of unity of invention is complied with. It also does not check all the many detailed physical requirements of the international application. Those requirements are only checked to the extent that compliance with such requirements is necessary for the purpose of reasonably uniform international publication.

10. Typical examples of defects which may be corrected without affecting the international filing date are:

(i) non-payment or incomplete payment of fees;

(ii) lack of signature on the request;

(iii) lack of a title of the invention;

(iv) lack of an abstract; and,

(v) physical defects.

11. As stated, in all such cases lack of correction leads to the application being considered withdrawn, except where a physical defect would not prevent reasonably uniform international publication and except for the payment of fees. With regard to the latter, Rule 16*bis* provides that the receiving Office must invite the applicant to pay the missing fees together with a late payment fee. If the applicant still does not pay the fees within the time limit fixed in the invitation, the receiving Office will declare that the international application is being considered withdrawn. This solution protects the applicant against any loss of his application due to an erroneously delayed or incomplete payment of fees.

12. The third step in the procedure before the receiving Office is that it must transmit the "record copy" of the international application to the International Bureau and the "search copy" to the International Searching Authority. The receiving Office keeps a third copy, the "home copy". The transmittals do not take place if and as long as national prescriptions concerning national security apply. The receiving Office will then declare that national security provisions prevent the international application from being treated as such.

13. The receiving Office must mail the record copy promptly to the International Bureau and in any case not later than five days prior to the expiration of the 13th month from the priority date. In many cases the international application claims the priority of an earlier national application and is filed at the end of the twelve month priority period. The receiving Office has thus only a few weeks for its processing tasks.

14. The search copy is transmitted by the receiving Office to the International Searching Authority at the time of the transmittal of the record copy to the International Bureau except where the search fee has not been paid on time, in which case, the transmittal of the search copy takes place after that fee has been paid.

Receiving Office Functions (continued)

- Checks application for compliance with Articles 11 and 14.
- Accords or refuses an International Filing date (Artilce 11(1)).
- Checks if any drawings referred to are included (Article 14(2)).
- Checks for formal defects (Article 14(1)).
- Collects fees for RO, ISA and IB.



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Receiving Office Functions (continued)

- Checks if the required fees are timely paid.
- Obtains national security clearance, if required.
- Forwards the record copy to IB and the search copy to ISA.
- Receives and forwards correspondence from applicants and the international authorities.



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National Security Clearance In RO/US (continued)

- A foreign filing license.
  - Is not required if the international application does not disclose subject matter in addition to that disclosed in a prior US national application filed *more than* 6 months prior to the international filing.
  - In all other instances, e.g. direct foreign filings outside of the PCT or filings in a foreign receiving office, the applicant should petition for a license for foreign filing.



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National Security Clearance In RO/US (continued)

- The petition for a foreign filing license:
  - may be made on the international application transmittal letter Form PTO-1382; and
  - should be accompanied by an identification of any additional subject matter in the international application which was not in the earlier US national application--may also be indicated on the Form PTO-1382.



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Receiving the International Application

- The RO may receive the international application
  - by mail.
  - by electronic transmission (if permitted by the individual receiving Offices).
  - in person.
    - by hand.
    - by commercial delivery.

└ U.S. RO does not receive applications electronically



30.01.96

Receipt Of Papers In RO/US

- The RO/US does not permit the filing by electronic means of any paper which is necessary to receive a filing date for an international application.
- The RO/US only permits filing of the above-mentioned papers in person or by mail.



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PCT International Application Items Acceptable As Facsimile Transmissions In the United States Patent & Trademark Office

Item	Acceptable	Not Acceptable
Filing of International Application		X
Drawings		X
Substitute Sheets (other than Drawings)	X	
Extensions of Time Requests	X	
Powers of Attorney	X	
General Powers of Attorney	X	
Fee Authorizations (other than the basic national fee)	X	
Confirmation of Precautionary Designations	X	
Demands	X	
Responses to Written Opinions	X	
Petitions	X	
Certified Copy of Priority Document		X
Basic National Fee for Entry Into National Stage		X
Copy of International Application for Entry Into National Stage		X
Translations	X	
Oath or Declaration	X	
Authorizations for Other National Fees and Surcharges	X	

Filing Date of Papers Mailed to RO/US

- Papers mailed using the "Express Mail" procedures are considered to be filed in the USPTO on the date they are deposited with the US Postal Service. (See 37 CFR 1.10).

- In all other situations, PCT papers mailed to RO/US will receive as a filing date the date they are physically received in the USPTO.

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Filing Date of Papers Mailed to RO/US (2)

- First Class Certificate of mailing procedures (37 CFR 1.8) do not apply to the filing of:
  - an international application;
  - any paper filed in an international application before the RO/US, ISA/US, or IPEA/US; and
  - the copy of the international application and the basic national fee necessary to enter the national stage.

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Forwarding of the International Application to RO/IB

- If none of the applicants are US residents or nationals, but at least one of the applicants
  - is a national or resident of a PCT Contracting State or
  - has no residence or nationality indicated,
- the RO/US will forward the application to RO/IB under Rule 19.4 and 37 CFR 1.421(a).



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Forwarding of the International Application to RO/IB (2)

- The RO/US will retain a fee equal to the transmittal fee as the fee prescribed by Rule 19.4(b).
- The application will not be forwarded until a fee equal to the transmittal fee has been paid to RO/US.
- Fees paid in excess of the transmittal fee will be refunded.



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National Security Clearance In RO/US (MPEP 1832)

- In the RO/US the national security clearance is handled through the use of the foreign filing license.
- A license for foreign filing is not required to ***file*** an international application in the RO/US.

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National Security Clearance In RO/US (continued)

- A foreign filing license may be required before a copy of the international application can be forwarded to:
  - a foreign patent office;
  - the International Bureau; or,
  - another foreign authority.

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Receiving Office Functions

- Specifies competent International Searching Authorities (Article 16(2)).
- Specifies competent International Preliminary Examining Authorities (Article 32(2)).
- Prescribes the acceptable language(s) for International applications filed therein (Rule 12.1(a)).
- Fixes the amount of the transmittal fee (Rule 14.1(b)).



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Receiving Office Functions (continued)

- Checks to determine that the receiving Office is competent for the International application.
  - Processes the application if the applicant is a resident or national of a Contracting State for which the RO is competent (Rule 19.1 and 19.2).
  - Forwards the application to IB as RO in certain instances where no applicant has proper residence or nationality (Rule 19.4).



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Functions of the Receiving Office

1. This section deals with the three main procedural steps before the receiving Office.

2. The first procedural step is that the receiving Office receives the international application from the applicant.

3. The second step is that the receiving office checks the international application to determine whether it meets the prescribed requirements as to form and content of international applications. This check is of a formal nature only and does not go into the substance of the invention. It therefore extends only to a certain number of rather elementary requirements specified in the Treaty as forming part of that check.

4. The check is divided into two parts. The first part concerns the requirements of according a filing date (Article 11). The second part concerns the formal and physical requirements (Article 14). That check by the receiving Office may show that the international application does not meet certain requirements as to form and content and that the fees are not, or not fully, paid. In that case, the receiving Office communicates with the applicant in order to give him an opportunity to correct any defect

5. If, possibly after correction, the check by the receiving Office shows that the international application meets the requirements of Article 11(1) for giving the application an international filing date, the receiving Office accords the international filing date.

6. The conditions for according an international filing date are:

(i) the applicant is a resident or national of the Contracting State for which the receiving Office acts, and has consequently the right to file with that receiving Office;

(ii) the international application is in the prescribed language;

(iii) the international application contains at least the following elements:

(a) an indication that it is intended to be an international application;

(b) the specific designation of at least one Contracting State under Rule 4.9(a),

(c) the name of the applicant in a form allowing the applicant's identity to be established;

(d) a part which on the face of it appears to be a description; and,

(e) a part which on the face of it appears to be a claim or claims

7. If one of those requirements is only complied with after correction, the international filing date will be the date on which the correction was received. In other words, in these cases a defect which is corrected later affects the international filing date. If not all such defects are properly corrected the application will not be treated as an international application.

8. For all the other cases non-compliance with the formal requirements does not affect the international filing date. In other words, if the applicant corrects a defect in such cases the international filing date remains unchanged. If the applicant does not correct, or does not correct properly, the defect, the international application will, however, be considered withdrawn by the receiving Office. Extension of the time limit fixed by the receiving Office for the correction of defects under Article 14 may be requested.

Correction procedures

- Transmittal of international application by non-competent Office to International Bureau as receiving Office (Rule 19.4)
- Invitation from the receiving Office to correct formal defects, extension of time usually available (Rule 26.2)
- Invitation from the receiving Office to pay unpaid fees together with late payment fee (Rule 16*bis*)
- Confirmation of precautionary designations (Rule 4.9(c))
- Rectification of obvious errors (Rule 91)
- Review by and opportunity to correct before the designated/elected Offices (Articles 24(2), 25, 26 and 48, Rules 82*bis* and 82*ter*)

Corrections of indications in priority claim (Rule 4.10(b) and (c))

1. Missing or erroneous date or country (Rule 4.10(b)):

   – if at least the filing date or the country of the earlier application is indicated, and

   – if resulting from an obvious error ("whenever the correction is obvious from a comparison with the earlier application"),

   the RO may, at the request of the applicant, make the correction of the indication(s) in the request within the following time limits:

kind of error	correction must be made
date is missing	before transmittal of record copy to IB
date is erroneous	before 16 months from the correct priority date
country is missing	before 16 months from the correct priority date
country is erroneous	before 16 months from the correct priority date

2. Missing number of the earlier application (Rule 4.10(c)):

   may be furnished to IB or RO within 16 months from the priority date (if erroneous number, see Rule 91.1).

Defects which can be corrected without affecting the international filing date

1. filing of international application with non-competent Office (Rule 19.4)
2. errors in the indication of the applicant's nationality and/or residence (Section 329 of the Administrative Instructions)
3. non-admitted language for the request, abstract, text matter in drawings (Rule 12.1(b))
4. missing or erroneous designation (provided precautionary designation statement was made in the request) (Rule 4.9(b) and (c))
5. incomplete or erroneous priority claim (Rule 4.10(b) and (c))
6. unpaid or not fully paid fees (Rule 16*bis*)
7. missing signature in the request (Rule 4.15)
8. formal defects (Rule 11)
9. missing title of the invention
10. missing abstract

| invitation to correct

Defects which cannot be corrected without loss of international filing date

- missing sheets of
  - description
  - claims
  - drawings
- failure to claim priority