

Entry into force of new Rule 56a EPC for correcting erroneously filed documents

New Rule 56a EPC will enter into force on 1 November 2022, aligning the EPC with Rule 20.5bis PCT. This new rule allows the correction of erroneously filed application documents or elements (i.e. part of the description or drawings) in EPC procedures for applications filed on or after that date.

Pre-existing Rule 56 EPC, addressing missing parts of the description or missing drawings in a patent application, has a narrow interpretation of erroneously filed documents as only the addition of missing elements is allowable under this rule. From the 1st of November 2022, under Rule 20.5bis PCT and the new Rule 56a EPC, applicants can correct an erroneously filed element contained in an international or European patent application. Under Rule 56 EPC and new Rule 56a EPC, applicants will have the opportunity to file missing parts and/or corrected application documents.

European Procedure under new Rule 56a EPC

Where corrections of erroneously filed application documents or parts are made, the date of filing will be determined based on new Rule 56a EPC.

Rule 56a(1) EPC states that the EPO, more specifically the Receiving Section, will invite the applicant to file the correct documents if it appears that the description, claims or drawings, or parts of those application documents, have been erroneously filed. The correction must be filed within two months of the invitation under Rule 56(1) EPC.

Even if no invitation is issued, the applicant is entitled to file corrected documents/parts within 2 months of the filing date. The question as to whether documents/parts were erroneously filed will depend only on the applicant's statement, when requesting a correction, as to what was intended, without requiring further evidence by the EPO in this regard.

Under R.56a(3) EPC, if the corrected elements are filed within two months of the invitation sent by the EPO, the filing date will be changed to the date of receipt of the correct application documents and the EPO will inform the applicant accordingly. The procedure should therefore be used with care since a change in the filing date could potentially lead to a loss of priority right.

There are three scenarios in which it is possible to keep the original filing date.

First, when the corrections of applications are made on or before the filing date, the date of filing will not be changed under R. 56a(2) EPC.

Second, if the correct elements are completely contained in the priority application and the priority has been claimed on the date of filing, the application will maintain its filing date under R. 56a(4) EPC. Further requirements may apply such as the need for a translation of the priority document. In this case, the correct and erroneously filed elements will both remain in the application as filed and will both be published with the application as filed. The erroneously filed elements can only be removed by amending the application in grant proceedings, subject to Art. 123(2) EPC (added subject-matter).

Finally, the corrections can be withdrawn under R. 56a(5) and (7) EPC in order to maintain the initial filing date. The correction will not be deemed to have been made and the EPO will inform the applicant accordingly.

A possible consequence of the correction of erroneously filed elements is the possible need to pay a further search fee. In particular, under R. 56a(8) EPC, the EPO may invite the applicant to

pay a further search fee if it has already begun to draw a search report before the correction is provided by the applicant. If the time limit for the payment of fees is missed, the application is deemed withdrawn and further processing is available.

Effect of Rule 56a EPC on international patent applications

Rule 20.5bis PCT has effect in two situations during the international phase: when the EPO is the Receiving Office and when the EPO is a designated/elected Office.

The processing of the requests under R.20.5bis PCT will mostly remain unchanged after the entry into force of new Rule 56a PCT when the EPO is the Receiving Office. If the element is furnished on or before the international filing date, the incorrect element will be replaced with the correct one and the international date of filing will be the date on which all the requirements for a date of filing have been fulfilled (R.20.5bis(b) PCT).

If the element is furnished after the international date of filing and there is no request for incorporation by reference of the element, the wrongly filed element will be replaced with the correct one and the international filing date will be moved to the date on which the correct part has been received, unless the applicant requests it to be disregarded (R.20.5bis(c) & (e) PCT).

However, from 1 November 2022, the EPO will start processing requests for incorporation by reference of the corrected element (R.20.5bis(d) PCT). If the requirements are fulfilled, the correct element will be considered to be part of the international application without the need to shift the international filing date. The incorrect element will also remain in the application.

Corrections accepted by the Receiving Office during the international phase are already effective today in proceedings before the EPO as designated or elected Office. This will remain the case. Incorporations by reference of corrected elements by the receiving Office are not currently effective in proceedings before the EPO as designated/elected Office. This will remain the case for international applications filed between 1 July 2020 and 31 October 2022, irrespective of the date of entry into the European phase. The EPO as designated/elected Office will fully apply R.20.5bis PCT for international applications filed on or after 1 November 2022.

Impact of the new Rule 56a EPC for the applicant

For any application filed on or after 1 November 2022, new Rule 56a EPC will unify the procedure for correction of erroneously filed elements between international and direct EP filing, thus facilitating the procedure for international application designating the EPO. It will also provide an additional remedy for the applicant who has erroneously filed an incorrect element in their patent application without the risk of losing their filing date. However, it is worth noting that the “completely contained in the priority document” criteria could still be challenged later on during the proceedings, e.g. by the Search Division or the Examining Division, even if the maintenance of the filing date was accepted by the Receiving Section.