



# Amendments and rectification of obvious mistakes

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# Poll questions





## Amendments under the PCT

- Amendments under Article 19
- Amendments under Article 34
- How to make amendments
- Amendments upon National Phase Entry

# Why make amendments during the international phase?

- An Article 19 amendment is effective in all designated States
- Claims amended under Article 19 will appear in the international publication
- The applicant may want to get an opinion by the International Preliminary Examining Authority based on amended application

# Amendments under Article 19 (Rule 46) (1)

- One opportunity to amend the claims only after receipt of the international search report and written opinion of the ISA
- Amended claims must not go beyond disclosure of the international application as filed (Article 19(2)) (compliance with that requirement is, however, not checked at this point)
- Amended claims may be accompanied by a statement (Article 19(1), Rule 46.4)
- Normally must be filed within two months from the date of transmittal of the international search report and written opinion of the ISA (Rule 46.1)

# Amendments under Article 19 (Rule 46) (2)

- Filed directly with the IB (Rule 46.2)
- Generally used to better define provisional protection, where available
- Published as part of the international application at 18 months, together with the claims as originally filed (Rule 48.2(f))

# Amendments under Article 34 (Rules 53.9 and 66.3 to 66.9) (1)

- Description, claims and drawings may be amended in connection with the international preliminary examination under Chapter II
- They should be filed
  - together with the demand for international preliminary examination so that examination will be based on the application as amended (Rule 53.9); or
  - at least before the expiration of the time limit to file a demand (Rule 54*bis*.1(a))
- Attention: amendments need not be taken into account by the examiner if they are received after he has begun to draw up another written opinion or the report (Rule 66.4*bis*)

# Amendments under Article 34 (Rules 53.9 and 66.3 to 66.9) (2)

- Amendments shall not go beyond the disclosure of the international application as filed (Article 34(2)(b))
- If an amendment goes beyond the disclosure in the international application as filed, the international preliminary examination report shall be established as if that amendment had not been made, and the report shall so indicate
- The report shall also indicate the reasons why the amendment is considered to go beyond the disclosure in the international application as filed (Rule 70.2(c))



# Comparison between types of amendments during international phase

## Chapter I (Article 19)

- have effect in all DOs
- claims only
- filed upon receipt of the ISR and written opinion of ISA
- filed directly with IB (not ISA)
- formality examination by IB
- published as part of the international application by IB
- serve as basis for examination by IPEA unless reversed

## Chapter II (Article 34)

- have effect in all EOs
- description, claims, drawings
- filed best together with the demand, or during examination by IPEA
- filed directly with IPEA
- formality and substantive examination by IPEA
- are confidential between IPEA and the applicant, are not published during the international phase
- serve as basis for examination by IPEA unless superseded

# How to make amendments (Rules 46.5 and 66.8)

- Where claims are amended under Article 19 or 34, they have to be presented in the form of replacement sheets containing a complete set of claims
- Applicants must indicate the basis for the amendments in the application as filed, otherwise the IPRP (Ch.II) may be established as if the amendments had not been made
- In case of cancelation of certain claims, no renumbering of the remaining claims is required
- An accompanying letter explaining what has been amended is required
- Further details: Administrative Instructions Section 205

# Replacement sheets for amendments under Article 19

- May not be filed with the receiving Office
- Must be filed directly with the IB preferably using ePCT
- Requests for rectification of obvious mistakes (Rule 91) are to be distinguished from Article 19 amendments and are sent directly to the ISA

# Replacement sheets containing amendments under Article 34

- Can be filed in ePCT when preparing the demand
- Otherwise, must be filed directly with the competent IPEA
- Requests for rectification of obvious mistakes (Rule 91) are to be distinguished from Article 34 amendments

# Amendments upon entry into the national phase (Articles 28 and 41 and Rules 52 and 78)

- Description, claims and drawings may be amended
- Time limit = normally at least one month from the date of fulfillment of the requirements for entry into the national phase (i.e. not from the time limit under Article 22 or 39(1))
- Any later time limits under the national law apply
- Different amendments possible for different DOs and EOs
- Generally, any claims fee due for the national phase will be calculated on the basis of the number of claims valid at the time of entry into the national phase



# Rectification of obvious mistakes under the PCT

# Requirements to authorize a rectification (Rule 91.1(c))

- The competent authority shall authorize the rectification under Rule 91 of a mistake if, and only if, it is obvious to the competent authority that
  - something else was intended than what appears in the document concerned, and
  - that nothing else could have been intended than the proposed rectification.

# Rectification of obvious mistakes (Rule 91) (1)

- No rectification shall be made except with the express authorization:
  - ❑ of the receiving Office if the mistake is in the request,
  - ❑ of the International Searching Authority if the mistake is in any part of the international application other than the request or in any paper submitted to that Authority,
  - ❑ of the International Preliminary Examining Authority if the mistake is in any part of the international application other than the request or in any paper submitted to that Authority,
  - ❑ of the International Bureau if the mistake is any paper, other than the international application or amendments or corrections to that application, submitted to the International Bureau



# Rectification of obvious mistakes (Rule 91) (2)

- Time limit: 26 months from the priority date (Rule 91.2)
- Clarification as to mistakes which are not rectifiable under Rule 91:
  - missing sheets or elements
  - mistake in the abstract
  - mistake in Article 19 amendments
  - mistake in the priority claims causing a change in the priority date

# Rectification of obvious mistakes (3)

- DO may disregard a rectification “if it finds that it would not have authorized the rectification if it had been the competent authority”, but must give the applicant an opportunity to make observations (Rule 91.3(f))
- Authorized request for rectification:
  - if this is received after technical preparations for publication have been completed, the IB will publish a statement reflecting the rectifications, any replacement sheets and the request for rectification together with the republished front page (Rule 48.2(i))

# Rectification of obvious mistakes (4) (Publication, Rule 48.2)

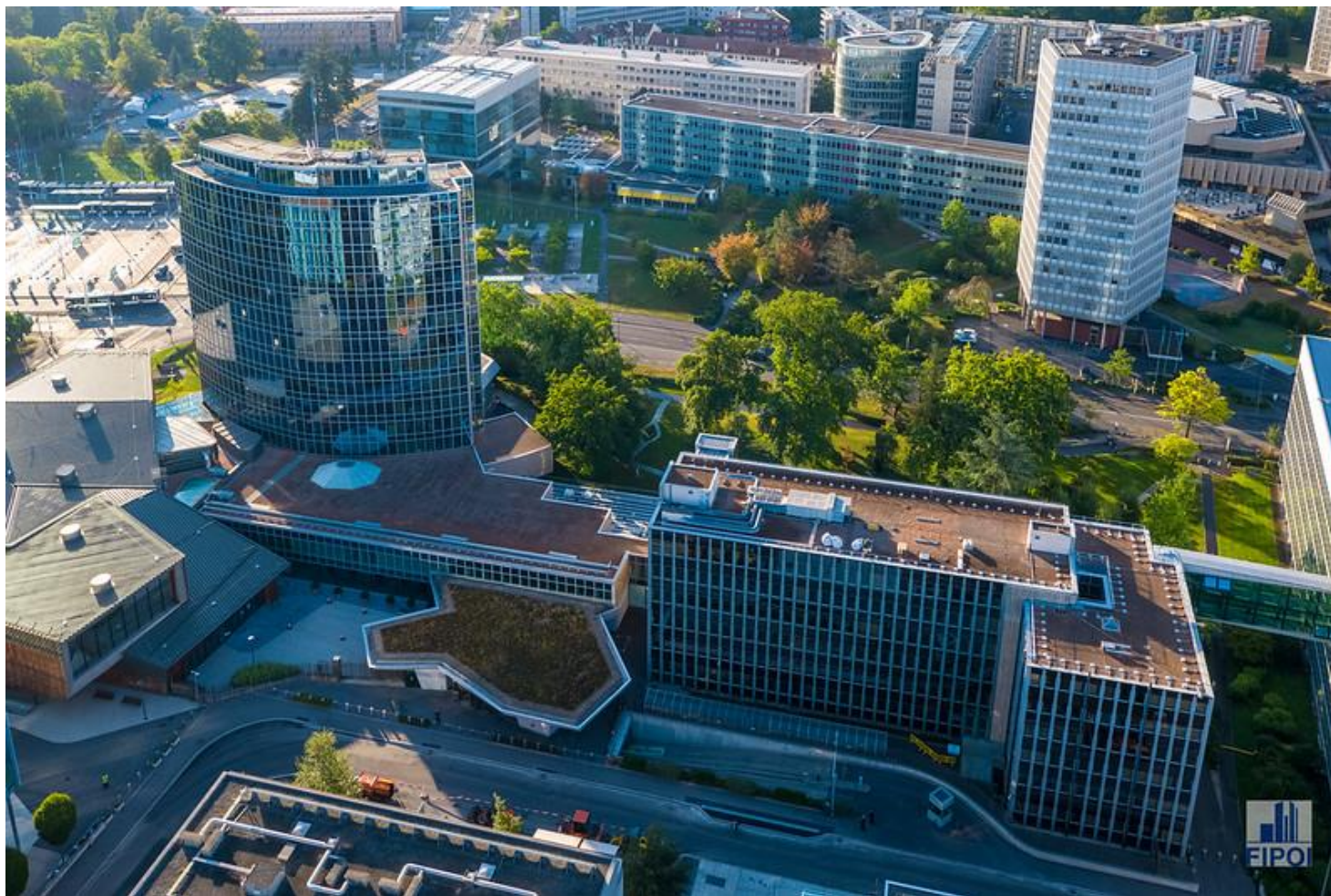
## ■ Refused request for rectification:

- this will be published, upon request by the applicant within two months from the refusal and against payment of a fee, together with the reasons for refusal and any brief comments by applicant (Rule 91.3(d)); if this is received after technical preparations for publication have been completed, it will be promptly published with the republished front page (Rule 48.2(k))

# Poll answers



# Questions?



# PCT Resources

- General questions about the PCT

- Contact the PCT Information Service:

- Telephone: +41 22 338 83 38

- E-mail: [pct.infoline@wipo.int](mailto:pct.infoline@wipo.int)

- Questions about the ePCT

- Contact PCT eServices Help Desk:

- Telephone: +41 22 338 95 23

- E-mail: [pct.eservices@wipo.int](mailto:pct.eservices@wipo.int)

- Subscribe to WIPO Newsletters

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