

National Workshop on the Patent Cooperation Treaty (PCT) System

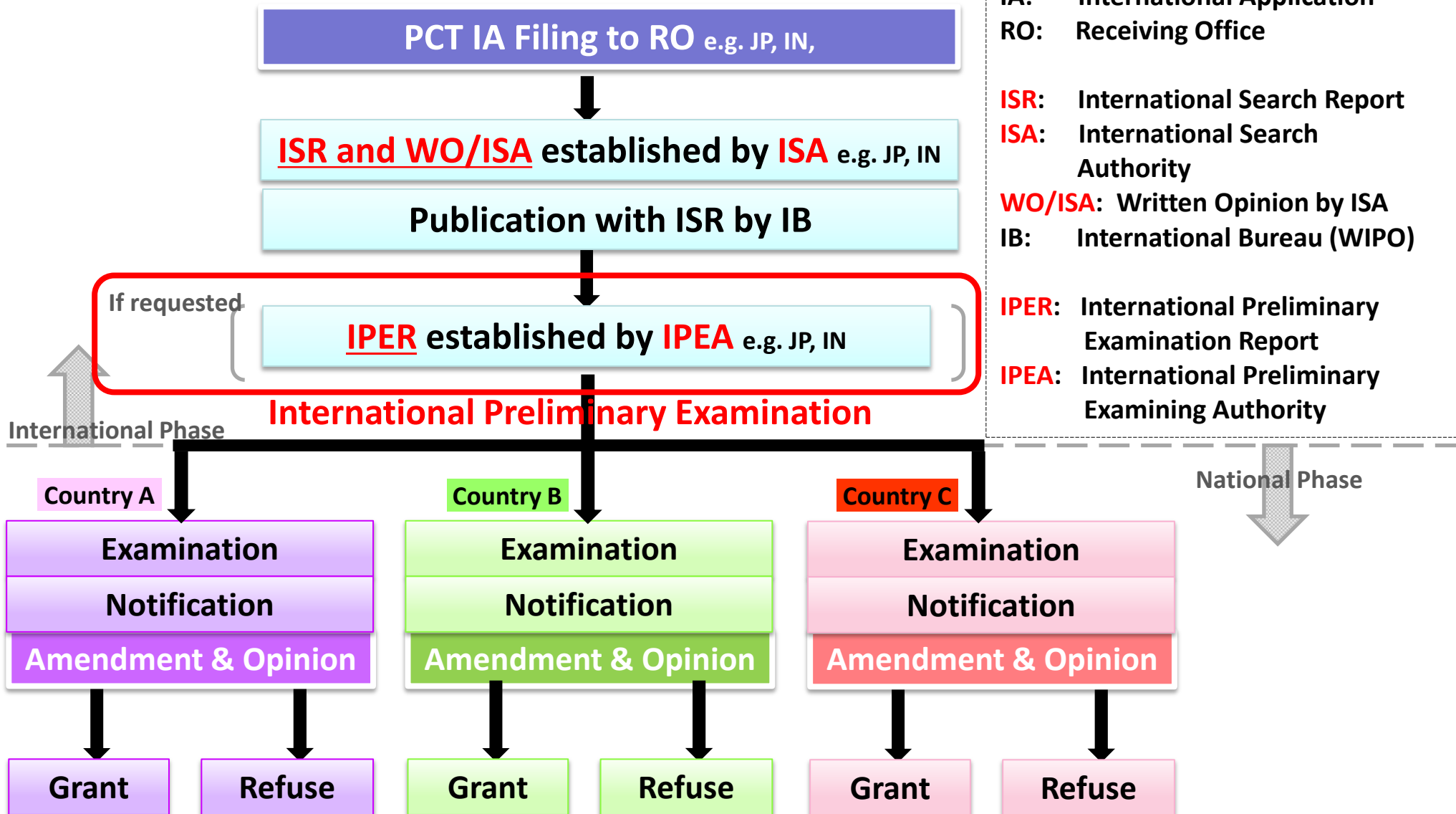
Amendments under Article 34 of the PCT

November 29, 2016
Japan Patent Office

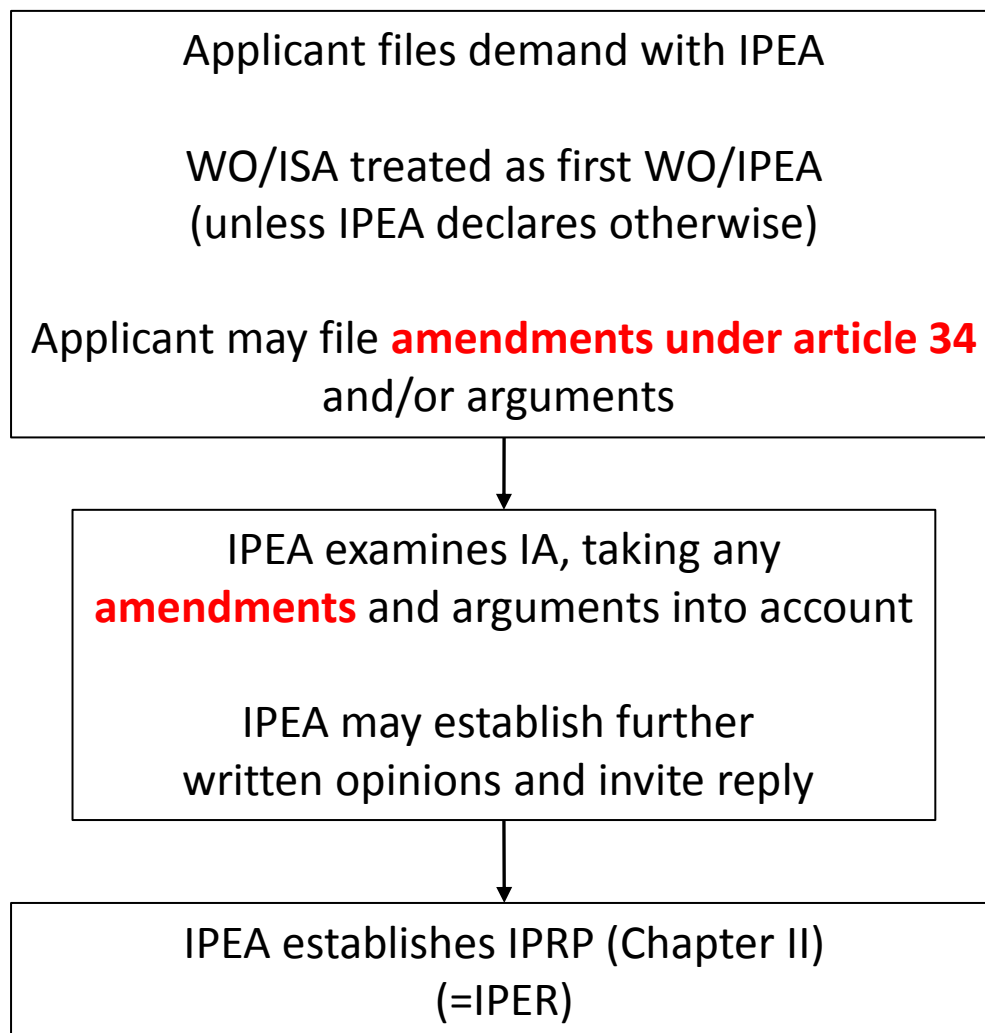
- I. International Preliminary Examination
- II. Amendments under Article 34

I. International Preliminary Examination

A. Flow of Examination of PCT Application



B. Flow of International Preliminary Examination



Abbreviation:

IPEA International Preliminary Examining Authority

WO/ISA written opinion of the ISA

WO/IPEA written opinion of the IPEA

IA international application

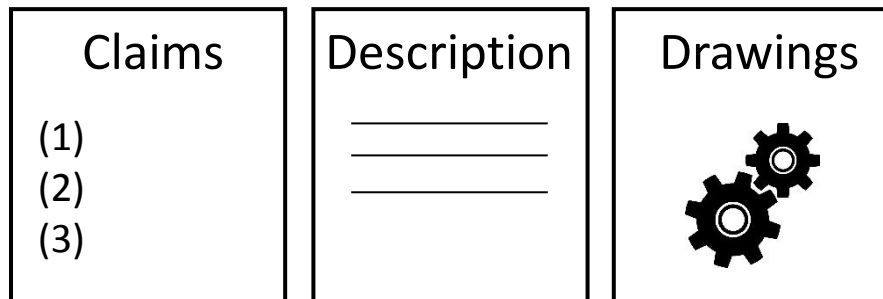
IPRP international preliminary report on patentability

IPER international preliminary examination report

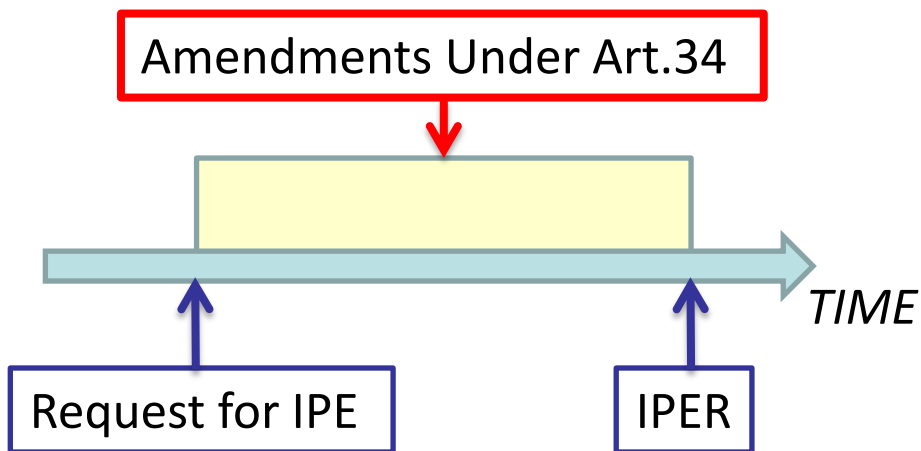
II. Amendments under Article 34

A. Subject and Period for Amendments

The applicant shall have a right to amend the claims, the description, and the drawings, in the prescribed manner and within the prescribed time limit, before the international preliminary examination report is established. The amendment shall not go beyond the disclosure in the international application as filed. <Art. 34(2)(b)>



Subject for Amendments



Period for Amendments

II. Amendments under Article 34

B. Comparison with Amendments under Article 19

	Article 34	Article 19
Subject of amendments	Claims, Description and Drawings	Claims
Period for amendment	Before the IPER is established	Whichever of the following expires later: <ul style="list-style-type: none">• Two months from the date of transmittal of the ISR• 16 months from the priority date
Opportunity to amend	Without restriction	Only one opportunity

Main differences between amendments under Article 34 and Article 19

II. Amendments under Article 34

C. Substantive Requirements (1/3)

- The amendment shall not go beyond the disclosure in the international application as filed. <Art. 34(2)(b)>
- An amendment should be regarded as introducing subject matter which extends beyond the content of the application as filed, and therefore unacceptable, if the overall change in the content of the application (whether by way of addition, alteration or excision) results in the skilled person being presented with information, which was not expressly or inherently presented in the application as filed even when taking into account matter which is implicit to a person skilled in the art in what has been expressly mentioned. <Guideline 20.12>

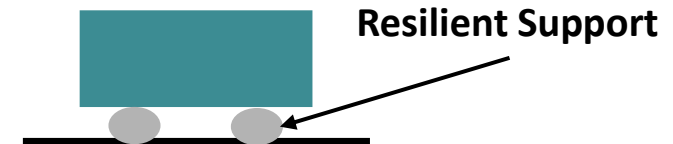
II. Amendments under Article 34

C. Substantive Requirements (2/3)

- The subject matter newly presented may be introduced by explicitly mentioning matter, which was either not previously mentioned at all, or only implied. <Guideline 20.13>

Claim 1:

Apparatus mounted on resilient supports.



Unacceptable

Claim 1 (amended):

Apparatus mounted on resilient supports which are helical springs.



Premise

- Any particular kind of resilient support was not disclosed.

II. Amendments under Article 34

C. Substantive Requirements (3/3)

- If, however, the applicant can show convincingly that the subject matter in question would, ..., be so well known to the person skilled in the art that its introduction could be regarded as an obvious clarification and, therefore, as not extending the content of the application, it is permissible. <Guideline 20.14>

Claim 1 (amended):

Apparatus mounted on resilient supports
which are helical springs.

Acceptable



Premise

- The person skilled in the art can interpret that drawings showed helical springs.

II. Amendments under Article 34

D. Basis of International Preliminary Examination (1/3)

- When, however, the applicant seeks to amend the description (other than references to the prior art), the drawings, or the claims in such a way that subject matter which extends beyond the content of the application as filed is thereby introduced, the international preliminary examination report must be established as if such amendment had not been made. <Guideline 20.10>

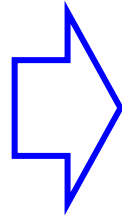
II. Amendments under Article 34

D. Basis of International Preliminary Examination (2/3)

Case 1

Claim 1: A
Claim 2: B
Claim 3: C

As filed



Claim 1: A'
Claim 2: B
Claim 3: C

Amended



Claim 1: A'
Claim 2: B
Claim 3: C

The Basis of IPE

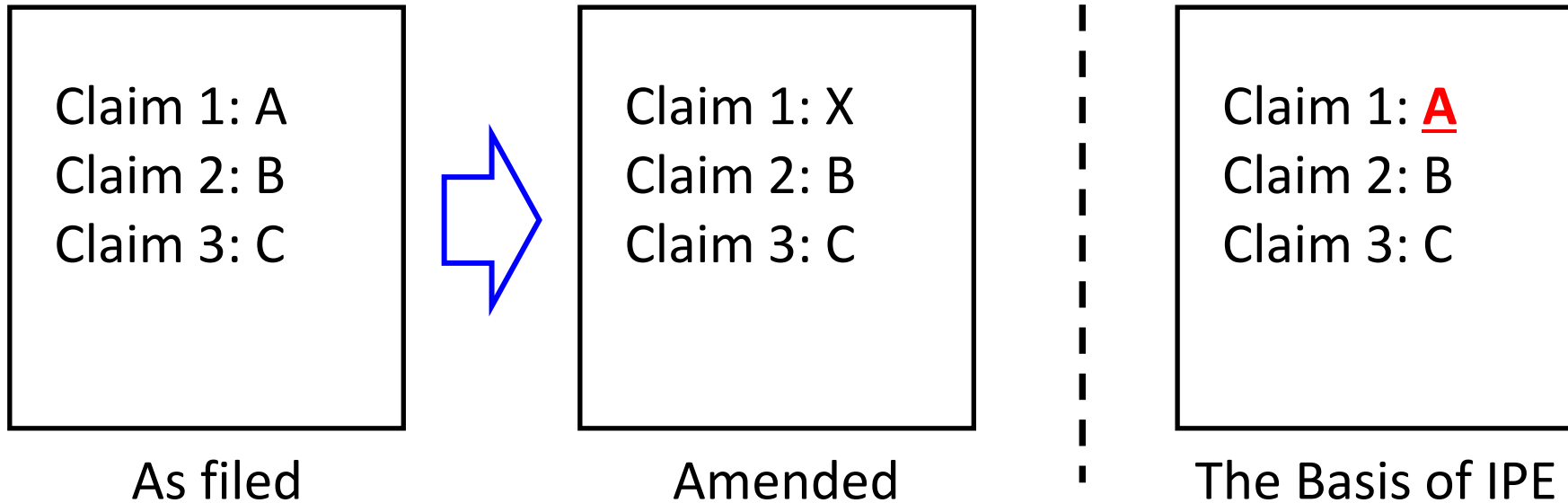
Premise

- The amendment on which A is changed to A' does not constitute addition of the new matter.

II. Amendments under Article 34

D. Basis of International Preliminary Examination (3/3)

Case 2



Premise

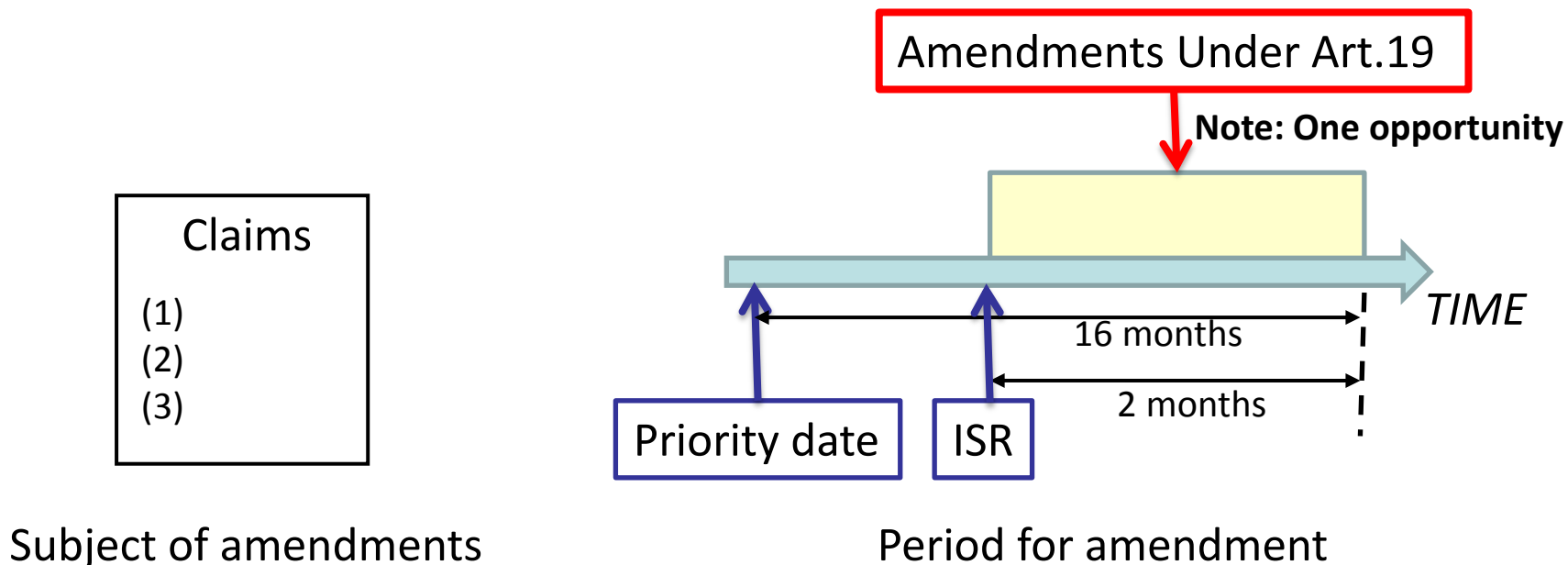
- The amendment on which A is changed to X constitutes addition of the new matter.

E. Actions after Decision of the Basis of IPE

- Top-up Searches <Guideline 19.15>
- Considering the Following:
 - Priority
 - Unity of invention
 - Novelty
 - Inventive step
 - Industrial applicability
 - etc.
- Further written opinion (if necessary) <Guideline 19.24>

Appendix

The applicant shall, after having received the international search report, be entitled to one opportunity to amend the claims of the international application by filing amendments with the International Bureau within the prescribed time limit. <Art. 19(1)>



- In general, the examiner should carry out a top-up search during the international preliminary examination process. <Guideline 19.15>
- The main objective of the top-up search is to discover any relevant documents referred to in Rule 64 which have become available to the International Preliminary Examining Authority for search subsequent to the date on which the international search report was established. <Guideline 19.19>

- However, where the applicant has made a credible attempt to overcome or rebut the objections in the written opinion of the International Searching Authority, but failed to satisfy the examiner that all the relevant criteria are met, a further written opinion may ... be issued... <Guideline 19.24>

(In JPO)

If the below (i) to (iii) is applied, the examiner establishes the further written opinion in order to give the applicant the opportunity to resolve negative opinion.

- (i) Substantially meaningful amendment has been made.
- (ii) The applicant is making the substantially meaningful arguments in the written reply.
- (iii) The new negative opinion which has not been pointed out in the WO/ISA is pointed out.