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**PCT/A/38/2 Add.**  
**ORIGINAL:** English  
**DATE:** August 15, 2008

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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**  
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION**  
**(PCT UNION)**

**ASSEMBLY**

**Thirty-Eighth (22<sup>nd</sup> Extraordinary) Session**  
**Geneva, September 22 to 30, 2008**

**FURTHER PROPOSED AMENDMENTS OF THE PCT REGULATIONS**

*prepared by the International Bureau*

## SUMMARY

1. This document, which is an addendum to document PCT/A/38/2, contains further proposals for amendment of the Regulations under the Patent Cooperation Treaty (PCT)<sup>1</sup>. The proposals relate to the following matters:

- (a) revised wording of Rule 46.5 as proposed in document PCT/A/38/2;
- (b) revised wording of Rule 70.16 as proposed in document PCT/A/38/2.

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<sup>1</sup> References in this document to “Articles” and “Rules” are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case may be.

## FURTHER AMENDMENT OF RULE 46.5

2. In document PCT/A/38/2, it is proposed to amend Rule 46.5 so as to require applicants to submit a replacement sheet or sheets containing a complete set of claims in replacement of all the claims originally filed rather than, as at present, replacement sheets only for those sheets of claims which, on account of an amendment, differed from sheets previously filed. Following comments received, the following corrections of a drafting nature, which concern the English version of document PCT/A/38/2 only, are proposed to improve the clarity of the English. It is proposed to revise the wording of Rule 46.5(a) by deleting the word “the” before the word “claims”, so that it reads: “... a replacement sheet or sheets containing a complete set of claims ...”. Furthermore, it is proposed to revise the wording of paragraph (b)(ii) by deleting the word “the” before the word “account”, so that it reads: “... which, on account of the amendments, ...”.

3. The proposed revised wording of Rule 46.5 is contained in Annex I to this document and supersedes that set out in Annex II of the English version of document PCT/A/38/2. A “clean” text of proposed amended Rule 46.5 (without underlining or striking through) appears in Annex II to this document.

## FURTHER AMENDMENT OF RULE 70.16

4. In document PCT/A/38/2, it is proposed to amend Rule 70.16, consequential on the proposed amendments of Rules 46.5 and 66.8. Upon further consideration, it is proposed to revise the wording of Rule 70.16 so as to clarify what needs to be annexed to the international preliminary examination report where the international application has been amended under Articles 19 and/or 34.

5. The proposed revised wording of Rule 70.16 is contained in Annex I to this document and supersedes that set out in document PCT/A/38/2, Annex II. A “clean” text of proposed amended Rule 70.16 (without underlining or striking through) appears in Annex II to this document.

## ENTRY INTO FORCE AND TRANSITIONAL ARRANGEMENTS

6. As to the entry into force of amended Rules 46.5 and 70.16 and transitional arrangements, reference is made to the proposed decisions contained in Annex III of document PCT/A/38/2, paragraph 7, sub-paragraph 3, concerning entry into force and transitional arrangements in respect of the proposed amendments of Rules 46.5, 66.8 and 70.16 set out in Annex II of document PCT/A/38/2. It is proposed that those decisions also apply in respect of Rules 46.5 and 70.16 as proposed to be further amended in this document.

*7. The Assembly of the PCT Union is invited to adopt the proposed amendments of the Regulations under the PCT set out in Annex I to this document and to decide that those amendments shall enter into force as set out in Annex III of document PCT/A/38/2, paragraph 7, sub-paragraph 3, with the same transitional arrangements.*

[Annexes follows]

ANNEX I

PROPOSED AMENDMENTS OF THE PCT REGULATIONS<sup>2</sup>

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<sup>2</sup> Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. A “clean” copy of the proposed amended provisions (without underlining or striking through) appears in Annex II.

**Rule 46**  
**Amendment of Claims before the International Bureau**

46.1 to 46.4 [No change]

46.5 *Form of Amendments*<sup>3</sup>

(a) The applicant, when making amendments under Article 19, shall be required to submit a replacement sheet or sheets containing a complete set of claims in replacement of all the claims originally filed ~~for every sheet of the claims which, on account of an amendment or amendments under Article 19, differs from the sheet originally filed.~~

(b) The replacement sheet or sheets shall be accompanied by a letter ~~accompanying the replacement sheets~~ which:

(i) shall identify the claims which, on account of the amendments, differ from the claims originally filed, and shall draw attention to the differences between the claims originally filed ~~replaced sheets~~ and the claims as amended ~~replacement sheets~~;

(ii) shall identify the claims originally filed which, on account of the amendments, are cancelled. ~~To the extent that any amendment results in the cancellation of an entire claim sheet, that amendment shall be communicated in a letter.~~

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<sup>3</sup> Paragraphs (a) and (b) have been further amended as set out in paragraph 2 in the main body of this document.

**Rule 70**  
**International Preliminary Report on Patentability**  
**by the International Preliminary Examining Authority**  
**(International Preliminary Examination Report)**

70.1 to 70.15 [No change]

70.16 *Annexes to the Report*<sup>4</sup>

(a) Each replacement sheet under Rule 66.8(a) or (b) ~~and each replacement sheet containing amendments under Article 19~~ shall, unless superseded by later replacement sheets under Rule 66.8(a) or (b) or amendments resulting in the cancellation of entire sheets under Rule 66.8(b), be annexed to the report.

(a-bis) Replacement sheets under Rule 46.5(a) shall, unless superseded or containing amendments under Article 19 which have been considered as reversed by replacement sheets under Rule 66.8(c) an amendment under Article 34, be annexed to the report. Replacement sheets under Rule 66.8(c) shall, unless superseded by later replacement sheets under Rule 66.8(c), be annexed to the report. Letters and letters under Rule 46.5(b) or Rule 66.8(a) or (c) shall not be annexed to the report.

(b) Notwithstanding paragraphs (a) and (a-bis) paragraph (a), each superseded or reversed replacement sheet referred to in those paragraphs that paragraph shall also be annexed to the report where the International Preliminary Examining Authority considers that the relevant superseding or reversing amendment goes beyond the disclosure in the international application as filed and the report contains an indication referred to in Rule 70.2(c). In such a case, the superseded or reversed replacement sheet shall be marked as provided by the Administrative Instructions.

70.17 [No change]

[Annex II follows]

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<sup>4</sup> Rule 70.16 has been further amended as set out in paragraph 4 in the main body of this document.

ANNEX II

PROPOSED AMENDMENTS OF THE PCT REGULATIONS  
(clean text)

Proposed amendments of the PCT Regulations are set out in Annex I, in which additions and deletions are shown, respectively, by underlining and striking-through of the text concerned. This Annex contains, for convenient reference, a “clean” text of the relevant Rules as they would stand after amendment.

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**Rule 46**  
**Amendment of Claims before the International Bureau**

46.1 to 46.4 [No change]

46.5 *Form of Amendments*

(a) The applicant, when making amendments under Article 19, shall be required to submit a replacement sheet or sheets containing a complete set of claims in replacement of all the claims originally filed.

(b) The replacement sheet or sheets shall be accompanied by a letter which:

(i) shall identify the claims which, on account of the amendments, differ from the claims originally filed, and shall draw attention to the differences between the claims originally filed and the claims as amended;

(ii) shall identify the claims originally filed which, on account of the amendments, are cancelled.

**Rule 70**  
**International Preliminary Report on Patentability**  
**by the International Preliminary Examining Authority**  
**(International Preliminary Examination Report)**

70.1 to 70.15 [No change]

70.16 *Annexes to the Report*

(a) Each replacement sheet under Rule 66.8(a) or (b) shall, unless superseded by later replacement sheets under Rule 66.8(a) or (b) or amendments resulting in the cancellation of entire sheets under Rule 66.8(b), be annexed to the report.

(a-*bis*) Replacement sheets under Rule 46.5(a) shall, unless superseded or considered as reversed by replacement sheets under Rule 66.8(c), be annexed to the report. Replacement sheets under Rule 66.8(c) shall, unless superseded by later replacement sheets under Rule 66.8(c), be annexed to the report. Letters under Rule 46.5(b) or Rule 66.8(a) or (c) shall not be annexed to the report.

(b) Notwithstanding paragraphs (a) and (a-*bis*), each superseded or reversed replacement sheet referred to in those paragraphs shall also be annexed to the report where the International Preliminary Examining Authority considers that the relevant superseding or reversing amendment goes beyond the disclosure in the international application as filed and the report contains an indication referred to in Rule 70.2(c). In such a case, the superseded or reversed replacement sheet shall be marked as provided by the Administrative Instructions.

70.17 [No change]

[End of Annex II and of document]