

WIPO



PCT/WG/2/9

ORIGINAL: English

DATE: April 3, 2009

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

PATENT COOPERATION TREATY (PCT)
WORKING GROUP

Second Session
Geneva, May 4 to 8, 2009

FORM OF AMENDMENTS

Document prepared by the European Patent Office

SUMMARY

1. This Annex to this document contains a proposal by the European Patent Office for a further amendment of Rules 46.5 and 66.8 as adopted by the PCT Assembly on September 30, 2008, and due to enter into force on July 1, 2009 (see document PCT/A/38/6, Annex II), obliging the applicant to identify the basis of amendments in the application as filed.

PROPOSED AMENDMENT RULES 46.5 AND 66.8

2. Where the applicant files amendments to an application without identification or indication of where a basis for these amendments can be found in the application documents, a considerable amount of effort is required from examiners. In particular, where their basis in long applications has not been indicated, the risk of making mistakes when assessing their allowability is increased and very often leads to quality deficiencies.

3. The European Patent Office is now introducing a rule in the Implementing Regulations to the Convention on the Grant of European Patents, obliging the applicant, when filing amendments, to indicate the basis for them in the application as filed. If the applicant does not do so, and the basis cannot be identified without undue effort, the examining division may request the applicant to indicate such basis within a time limit of one month. If the applicant does not respond, the European patent application will be deemed to be withdrawn.

4. As for PCT Chapter II proceedings, Rule 66.8(a) as amended by the PCT Assembly in September 2008 merely states that, when amending the description or the drawings, the letter accompanying the replacement sheets "... shall preferably ... explain the reasons for the amendment". Rule 66.8(c) as adopted by the PCT Assembly in September 2008 declares Rule 46.5 as amended applicable *mutatis mutandis* where amendments to the claims are concerned (see PCT/A/38/6).

5. The European Patent Office proposes to further amend Rules 46.5 and 66.8 as adopted by the PCT Assembly on September 30, 2008, and due to enter into force on July 1, 2009 (see document PCT/A/38/6, Annex II) and to introduce an obligation for the applicant to identify the basis for amendments filed. Where the applicant does not provide such an indication, the Guidelines could state that the International Preliminary Examining Authority would have the option to make a request to do so in the first written opinion. A failure to reply would allow the International Preliminary Examining Authority to ignore the amendments when drawing up the international preliminary examination report. The examiner would decide when it is appropriate to make such a request. Of course, where the basis for the amendments can be retrieved without substantial effort from the content of the application as filed, he would not make such a request and would have no reason to ignore the amendments. No further sanction would apply.

6. *The Working Group is invited to consider the proposals contained in the Annex.*

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:
FORM OF AMENDMENTS¹

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¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference. The proposed amendments are shown relative to the text of Rules 46.5 and 66.8 as adopted by the Assembly on September 30, 2008, with effect from July 1, 2009 (see document PCT/A/38/6, Annex II).

Rule 46²

Amendment of Claims before the International Bureau

46.1 to 46.4 [No change]

46.5 Form of Amendments

(a) [No change] 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) [No change] 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;

(iii) shall indicate the basis for the amendments in the application as filed.

² The proposed amendments are shown relative to the text of Rule 46.5 as adopted by the Assembly on September 30, 2008, with effect from July 1, 2009 (see document PCT/A/38/6, Annex II).

Rule 66³

Procedure before the International Preliminary Examining Authority

66.1 to 66.7 [No change]

66.8 Form of Amendments

(a) Subject to paragraph (b), when amending the description or the drawings, the applicant shall be required to submit a replacement sheet for every sheet of the international application which, on account of an amendment, differs from the sheet previously filed. The replacement sheet or sheets shall be accompanied by a letter which shall draw attention to the differences between the replaced sheets and the replacement sheets, [shall indicate the basis for the amendment in the application as filed](#) and shall preferably also explain the reasons for the amendment.

(b) [No change]

(c) [No change] When amending the claims, Rule 46.5 shall apply *mutatis mutandis*. The set of claims submitted under Rule 46.5 as applicable by virtue of this paragraph shall replace all the claims originally filed or previously amended under Articles 19 or 34, as the case may be.

66.9 [No change]

[End of Annex and of document]

³ The proposed amendments are shown relative to the text of Rule 66.8 as adopted by the Assembly on September 30, 2008, with effect from July 1, 2009 (see document PCT/A/38/6, Annex II).