Amendments under the PCT

Comparison between types of amendments during international phase

Article 19 amendments	Article 34 amendments
- have effect in all DOs (designated offices)	- have effect in all EOs (elected offices)
- claims only	- description, claims, drawings
- filed upon receipt of the ISR	- filed at the earliest with the demand, or during examination by IPEA
- filed directly with IB (not ISA)	- filed directly with IPEA
- formality examination by IB	- formality and substantive examination by IPEA
- published as part of the pamphlet by IB	- are confidential between IPEA and the applicant, are not published during the international phase
- serve as basis for examination by IPEA unless reversed	- serve as basis for examination by IPEA unless superseded

2-3
11.01.96

World Intellectual Property Organization

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

1. All parts of the international application may be amended.
2. 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)).
3. Any later time limits under the national law apply.
4. Different amendments possible for different DOs and EOs.
5. 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.

2-4
11.01.96

World Intellectual Property Organization

Abbreviations:

IPEA = International Preliminary Examining Authority
IPER = international preliminary examination report

	AMENDMENTS TO THE INTERNATIONAL APPLICATION		
	INTERNATIONAL PHASE		NATIONAL PHASE
	AMENDMENTS UNDER PCT CHAPTER I (only if an international search report has been established) PCT Article 19 and Rule 46	**AMENDMENTS UNDER PCT CHAPTER II (only if the applicant files a demand for international preliminary examination) PCT Article 34 and Rules 53.9 and 66**	**AMENDMENTS UPON ENTERING THE NATIONAL PHASE PCT Articles 28 and 41 and Rules 52 and 78**
Which part(s) of the international application may be amended?	Claims only.	Claims, description and drawings.	Claims, description and drawings. Different amendments are possible for different designated/elected Offices.
Where must the amendments be filed?	With the International Bureau.	With the IPEA.	With the designated/elected Offices.
When must the amendments be filed?	Within two months from the date of transmittal of the international search report, or 16 months from the priority date, or before the technical preparations for international publication have been completed, whichever time limit expires/event occurs later.	May be filed with the demand or during international preliminary examination. They should, however, be filed before the IPEA begins to draw up the IPER.	May be filed within one month from the date of fulfillment of the requirements for entry into the national phase. Later time limits may apply—see relevant National Chapter in the *PCT Applicant's Guide*, Vol. II.
In what language must the amendments be filed?	In the language of the international application, if that language is Chinese, English, French, German, Japanese, Russian or Spanish, or in English where the international application was filed in another language.		Where the designated/elected Office requires a translation of the international application, the amendments must be in the language of the translation.
What is the allowable scope of the amendments?	Amendments must not go beyond the disclosure in the international application as filed. Although this requirement is not directly enforceable during the international phase, failure to comply may have adverse consequences during international preliminary examination and in the national phase.	Amendments must not go beyond the disclosure in the international application as filed. Although this requirement is not directly enforceable during the international phase, if any amendment does not comply, the IPEA will make comments in the written opinion and the IPER, and the IPER will be established as if the amendment had not been made.	Amendments must not go beyond the disclosure in the international application as filed unless the national law of the designated/elected State permits them to go beyond that disclosure—see National Chapters in the *PCT Applicant's Guide*, Vol. II.
Where do the amendments have effect?	In all designated/elected Offices.	In all elected Offices.	In those designated/elected Offices with which they are filed.
For what procedures do the amendments serve as a basis?	For examination by the IPEA (unless reversed or superseded) and for examination by the designated/elected Offices in the national phase (unless superseded by later amendments).	For examination by the IPEA, and, in the national phase, by elected Offices (unless superseded by later amendments).	For examination by the designated/elected Offices in the national phase.
May amendments be made more than once?	No.	Yes, depending on when the IPER is established. But note that amendments need not be taken into account by the IPEA if they are received after it has begun to draw up a written opinion or the IPER.	Depends on national law.
Are the amendments confidential?	They are confidential before international publication. After publication of the international application, amendments published by the International Bureau as part of the pamphlet are no longer confidential.	They are confidential until transmittal of the IPER to the elected Offices. Once the IPER has been transmitted to the elected Offices, any amendments which form part of the annexes to the IPER may be made available by any elected Office whose national law so permits.	Depends on national law.

NOTES TO FORM PCT/ISA/220 (continued)

The letter must indicate the differences between the claims as filed and the claims as amended. It must, in particular, indicate, in connection with each claim appearing in the international application (it being understood that identical indications concerning several claims may be grouped), whether

(i) the claim is unchanged;
(ii) the claim is cancelled;
(iii) the claim is new;
(iv) the claim replaces one or more claims as filed;
(v) the claim is the result of the division of a claim as filed.

The following examples illustrate the manner in which amendments must be explained in the accompanying letter:

1. [Where originally there were 48 claims and after amendment of some claims there are 51]:
"Claims 1 to 29, 31, 32, 34, 35, 37 to 48 replaced by amended claims bearing the same numbers; claims 30, 33 and 36 unchanged; new claims 49 to 51 added."
2. [Where originally there were 15 claims and after amendment of all claims there are 11]:
"Claims 1 to 15 replaced by amended claims 1 to 11."
3. [Where originally there were 14 claims and the amendments consist in cancelling some claims and in adding new claims]:
"Claims 1 to 6 and 14 unchanged; claims 7 to 13 cancelled; new claims 15, 16 and 17 added." or
"Claims 7 to 13 cancelled; new claims 15, 16 and 17 added; all other claims unchanged."
4. [Where various kinds of amendments are made]:
"Claims 1-10 unchanged; claims 11 to 13, 18 and 19 cancelled; claims 14, 15 and 16 replaced by amended claim 14; claim 17 subdivided into amended claims 15, 16 and 17; new claims 20 and 21 added."

"Statement under Article 19(1)" (Rule 46.4)

The amendments may be accompanied by a statement explaining the amendments and indicating any impact that such amendments might have on the description and the drawings (which cannot be amended under Article 19(1)).

The statement will be published with the international application and the amended claims.

It must be in the language in which the international application is to be published.

It must be brief, not exceeding 500 words if in English or if translated into English.

It should not be confused with and does not replace the letter indicating the differences between the claims as filed and as amended. It must be filed on a separate sheet and must be identified as such by a heading, preferably by using the words "Statement under Article 19(1)."

It may not contain any disparaging comments on the international search report or the relevance of citations contained in that report. Reference to citations, relevant to a given claim, contained in the international search report may be made only in connection with an amendment of that claim.

Consequence if a demand for international preliminary examination has already been filed

If, at the time of filing any amendments under Article 19, a demand for international preliminary examination has already been submitted, the applicant must preferably, at the same time of filing the amendments with the International Bureau, also file a copy of such amendments with the International Preliminary Examining Authority (see Rule 62.2(a), first sentence).

Consequence with regard to translation of the international application for entry into the national phase

The applicant's attention is drawn to the fact that, upon entry into the national phase, a translation of the claims as amended under Article 19 may have to be furnished to the designated/elected Offices, instead of, or in addition to, the translation of the claims as filed.

For further details on the requirements of each designated/elected Office, see Volume II of the PCT Applicant's Guide.

NOTES TO FORM PCT/ISA/220

These Notes are intended to give the basic instructions concerning the filing of amendments under Article 19. The Notes are based on the requirements of the Patent Cooperation Treaty, the Regulations and the Administrative Instructions under that Treaty. In case of discrepancy between these Notes and those requirements, the latter are applicable. For more detailed information, see also the PCT Applicant's Guide, a publication of WIPO.

In these Notes, "Article," "Rule" and "Section" refer to the provisions of the PCT, the PCT Regulations and the PCT Administrative Instructions, respectively.

INSTRUCTIONS CONCERNING AMENDMENTS UNDER ARTICLE 19

The applicant has, after having received the international search report, one opportunity to amend the claims of the international application. It should however be emphasized that, since all parts of the international application (claims, description and drawings) may be amended during the international preliminary examination procedure, there is usually no need to file amendments of the claims under Article 19 except where, e.g. the applicant wants the latter to be published for the purposes of provisional protection or has another reason for amending the claims before international publication. Furthermore, it should be emphasized that provisional protection is available in some States only.

What parts of the international application may be amended ?

Under Article 19, only the claims may be amended.

During the international phase, the claims may also be amended (or further amended) under Article 34 before the International Preliminary Examining Authority. The description and drawings may only be amended under Article 34 before the International Preliminary Examining Authority.

Upon entry into the national phase, all parts of the international application may be amended under Article 28 or, where applicable, Article 41.

When ? Within 2 months from the date of transmittal of the international search report or 16 months from the priority date, whichever time limit expires later. It should be noted, however, that the amendments will be considered as having been received on time if they are received by the International Bureau after the expiration of the applicable time limit but before the completion of the technical preparations for international publication (Rule 46.1).

Where not to file the amendments ?

The amendments may only be filed with the International Bureau and not with the receiving Office or the International Searching Authority (Rule 46.2).

Where a demand for international preliminary examination has been/is filed, see below.

How ? Either by cancelling one or more entire claims, by adding one or more new claims or by amending the text of one or more of the claims as filed.

A replacement sheet must be submitted for each sheet of the claims which, on account of an amendment or amendments, differs from the sheet originally filed.

All the claims appearing on a replacement sheet must be numbered in Arabic numerals. Where a claim is cancelled, no renumbering of the other claims is required. In all cases where claims are renumbered, they must be renumbered consecutively (Administrative Instructions, Section 205(b)).

The amendments must be made in the language in which the international application is to be published.

What documents must/may accompany the amendments ?

Letter (Section 205(b)):

The amendments must be submitted with a letter.

The letter will not be published with the international application and the amended claims. It should not be confused with the "Statement under Article 19(1)" (see below, under "Statement under Article 19(1)").

The letter must be in English or French, at the choice of the applicant. However, if the language of the international application is English, the letter must be in English; if the language of the international application is French, the letter must be in French.

How to make amendments

1. By filing
   - a replacement sheet for every sheet which, on account of an amendment, differs from the sheet previously filed (except where the amendment results in the cancellation of an entire sheet; such an amendment may be communicated in a letter) and
   - an accompanying letter, signed by the applicant or the agent explaining the difference between the replaced sheet and the replacement sheet
2. For numbering of claims in case claims are added, see Section 205 of the Administrative Instructions
3. For numbering of sheets in case sheets are added, see Section 311(b)(ii) of the Administrative Instructions

Amendment of the claims under Article 19 (see Rule 46)

1. One opportunity to amend the claims after receipt of the international search report
2. Amended claims may be accompanied by a statement
3. Normally must be filed within two months from the date of transmittal of the international search report
4. Filed directly with the IB
5. Used to better define provisional protection, where available
6. Published as part of the pamphlet at 18 months
7. Usually not necessary when a demand for international preliminary examination is filed ✓

Amendment of the international application under Article 34 (see Rules 53.9 and 66.3 to 66.9)

1. All parts of the international application may be amended in connection with the international preliminary examination under Chapter II.
2. Amendment may be filed
   - with the demand for international preliminary examination so that examination will be based on the application as amended (i.e. make best use of time for both the examiner and the applicant) (Rule 53.9);
   - during international preliminary examination, in response to a written opinion (Rule 66.3).
3. 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*).