

Amendment of description, claims and drawings of Treaty applications

Introduction

1. This guideline outlines IPONZ consideration of amendments of the description, claims and drawings made to Treaty applications prior to entry into national phase.
2. The following amendments to Treaty applications may be made during the international phase:
 - the correction of defects in the description, claims and drawings at the invitation of the receiving office under Rule 26 of the PCT Regulations.
 - the rectification of an obvious mistake under Rule 91.1 of the PCT Regulations.
 - amendments to the claims under Article 19.
 - amendments to the description, claims and drawings under Article 34.

Correction of defects in the international application

3. Rule 26 of the PCT Regulations allows for the correction of certain defects in the international application at the invitation of the receiving office. The time available for correction of these defects is limited to two months from the time the invitation to correct is issued. These corrections, if made to the description (including sequence listings), claims and drawings, are not considered to be amendments to the complete specification under section 40.

Rectification of obvious mistakes in an international application

4. Rule 91 of the PCT Regulations allows for the rectification of obvious mistakes in the international application.
5. The competent authority may authorise the rectification of an obvious mistake in the description (including sequence listings), claims or drawings or in a correction thereof, or in an amendment proposed under Article 19 or Article 34.
6. For the rectification to be authorised it must be obvious to the competent authority that something else was intended other than what appears in the document concerned and that the proposed rectification is clearly what was intended.
7. In deciding whether a mistake is obvious account must only be taken of the description, claims and drawings and of the correction or amendment concerned.
8. Certain mistakes to the description, claims and drawings are not rectifiable under Rule 91, in particular the omission of one or more of the description, claims or drawings, or one or more entire sheets of the international application.
9. Rule 91.3(f) permits a designated office to disregard a rectification authorized under Rule 91.1 if that office would not itself have authorized the rectification. The examiner should

investigate the rectification to ensure that it does correct an obvious mistake under Rule 91.1 and does not introduce new matter. If the examiner recommends that the rectification should be disregarded, the applicant will be given an opportunity to amend the specification or dispute the examiner's recommendation.

Amendments made under Articles 19 and 34 of the PCT

10. Amendments made to the complete specification of a Treaty application prior to the commencement of the national phase should be performed as prescribed in the rules of the PCT.
11. Under Article 19, only amendments to claims may be proposed, and Rules 46.1 to 46.5 apply.
12. Under Article 34, amendments to the description, claims and drawings may be proposed in the form as set out in Rule 66.8.
13. The differences between the requirements of these rules and Regulation 58 are:
 - fresh amended specification sheets as opposed to a whole complete specification must be filed
 - reasons for the amendments are not required under Rule 46 and optional under Rule 66.8; and
 - the basis of support for amendments to the description and drawings (statement of specific support) need not be provided.
14. ~~Similar to the requirement under regulation 58(d), all claim amendments must be accompanied by an indication of the basis for the amendments.~~ [Paragraph removed.]

Filing requirements at entry into national phase

15. To meet the requirements of regulation 63(2), the amendments made during the international phase must be filed at entry into national phase irrespective of whether these amendments are to be carried through during the national phase. Verified English translations of any amendments must be filed within the time allowed for filing verified translations of any Treaty application documents, generally within 3 months, or the extended period of 5 months from entry into national phase.
16. Any amendment that was not made during the international phase and which is proposed at the time of submitting a request to enter the national phase in New Zealand, or subsequently, including an amendment that effectively retracts Article 19 and/or Article 34 amendments, is subject to regulation 58.
17. At entry into national phase, the complete specification will be taken to be the description, claims and drawings including any corrections under Rule 26, and rectifications under Rule 91, and any final amendments proposed under Article 19 or Article 34 during the

international phase. (By final, is meant the latest set of amendments that have not been superseded by a later amendment during the international phase).

18. If final amendments are not incorporated into the complete specification document and have not been superseded by further amendments during the national phase before the application is examined, the first examination will be performed as though the final amendments were incorporated.
19. In summary, an IPONZ examiner may object to Rule 91 rectifications but only on the ground that the rectification was not the correction of an obvious mistake. If Article 19 or Article 34 amendments appear to contain new matter not found in the original complete specification then the applicant will be required either to substantiate that the amendments do not constitute new matter or to agree to post-date the application to the date of the amendment.

Examination of the amended specification

20. Section 69(1) requires an amended specification to be examined in the same manner as the original specification.
21. The examiner will check that amendments have been correctly performed and that the amended specification meets the requirements of the Act and Regulations in all respects, and raise any subsequent objections in an examination report that is sent to the applicant.