

# WIPO



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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**  
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**INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)**

**MEETING OF INTERNATIONAL AUTHORITIES  
UNDER THE PATENT COOPERATION TREATY (PCT)**

**Sixteenth Session  
Seoul, March 16 to 18, 2009**

PROPOSAL FOR PARAGRAPH AMENDMENT OF PCT APPLICATIONS

*Proposal by the Japan Patent Office*

## SUMMARY

1. In this document, the JPO proposes details of paragraph amendment for implementation based on its experience of domestic applications.

## NECESSITY AND BENEFIT OF REVISION PER PARAGRAPH

2. Presently, when applicants make a revision in a PCT application, the revision is submitted in the form of substituting (replacing) page<sup>1</sup> (hereinafter referred to as “page amendment”). On the other hand, electronic filings based on the XML format have been already started, following the PCT regulations and administrative instructions amended in January, 2002. Since descriptions based on the XML format do not have any page break, it has been difficult for applicants to replace a page in order to amend a description. Thus, applicants who utilize the electronic filings have been requesting the option to amend a description on a paragraph to paragraph basis (hereinafter referred to as “paragraph amendment<sup>2</sup>”).

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<sup>1</sup> Regulations under the PCT 26.4, 66.8, 91.2

<sup>2</sup> Application documents in XML format do not have a concept of page break, thus those documents are converted into PDF with page breaks in order to calculate fees. But there is possibility that using different software results in different results of page breaks

[Footnote continued on next page]

3. By introducing paragraph amendment which does not relate to the concept of a page, the work burden which relates to revision for the applicant who files an XML electronic application is especially reduced.

4. Moreover, when a description and its amendment are in XML format, IP offices also benefit; for instance, compilation of a gazette can be performed automatically.

## THE CONTENTS OF THE PROPOSAL

### *Target of paragraph amendment and page amendment*

	Paragraph amendment	Page amendment
XML electronic application	Applicable	Not Applicable
Application by paper or image data	Applicable <input type="checkbox"/> only applies to applications with paragraph numbers in description at the time of filing. <input type="checkbox"/>	Applicable <input type="checkbox"/> Page amendment is not permitted after paragraph amendment, because page break becomes unclear. <input type="checkbox"/>

5. Paragraph amendment applies to all revisions of description (including the following: furnishing of the missing part under rule 20.5 or incorporation by reference under 20.6(a), correction under article 14, rectification of obvious mistake and amendment under article 34).

### *Paragraph amendment*

6. Paragraph amendment, which does not make any change of the paragraph number, includes replacement or deletion of the paragraph.

### *Amendment of whole description (replacement of the whole text)*

7. In the case of adding a new paragraph, a description is amended by replacing the whole text. In the case of changing, deleting or adding headings such as “Example n” or “citation list”, a description is amended by replacing the whole text. In the case where paragraphs are renumbered, a description is amended by replacing the whole text.

### *Method of indicating the basis of the report/opinion in the international preliminary examination report and written opinion*

8. In the case of paragraph amendment, the report (written opinion) should identify the paragraph on which the report (written opinion) is based, pursuant to the page amendment.

### *Amendment of drawings*

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[Footnote continued from previous page]

In that case, it may happen that applicants cannot reproduce the original page break at the time of filing, or that recognition of page breaks at applicant's side differs the one at the IP office's side.

9. Amendment of drawings is permitted on a drawing number to drawing number basis.<sup>3</sup>

*Amendment of claims<sup>4</sup>*

10. Amendment of changing or deleting claims is permitted on a claim to claim basis. In the case where claims are added or deleted and consequently claims are renumbered, the amendment is done by replacing the whole text of the claims.

*Transmission between Offices, Authorities or IB etc.*

11. Regarding paragraph amendment, Offices, Authorities or the IB receiving the amendment transmits to other Offices, Authorities or IB only what is submitted by an applicant without converting it into a replacement page.

## DISCUSSIONS

*Providing applicants with easy access for amendment*

12. When paragraph numbers are given to the original description at the time of filing, amended parts become clear by the way of paragraph amendment. When paragraphs are renumbered as part of amendments, it is expected to avoid complication by replacing (amending) the whole text.

*Making it easy for applicants, IP offices or third parties to confirm amended description*

13. It is rather easy to confirm which part is amended when the number of paragraphs does not change or when paragraphs are deleted or adding a new paragraph.
14. Moreover, in the case of replacing the whole text, it is also easy to identify the amended part, because an applicant gives an explanation.
15. In addition, when an amendment is made electronically, the amended part can also be easily identified by using general-purpose software that processes XML data, etc.

*Applying paragraph amendment to applications by paper or image data*

16. Basically, paragraph amendment is applied to XML applications. As for the amendment of XML applications, since there are few merits to make an amendment by submitting a replaced page (as currently done with rendering difficulty during reproduction by applicants in case of an XML application), limiting an option for amendment only to paragraph amendment is desirable.
17. Therefore, in case of amending a paper application or application containing image data, paragraph amendment should be accepted only when certain conditions are met, such as paragraph numbers have already been provided at the time of filing.

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<sup>3</sup> In the case of drawing amendment, there is no need to amend the full text even when a new paragraph is added, because there are no headings unlike description and also XML layer of drawings is simple.

<sup>4</sup> With the revision of PCT regulation, the whole scope of claims have to be replaced in the case of amending the claims, as from July 2009.

*Permitting branch number for paragraph number*

18. A branch number method could cause format discordance between a PCT application and a domestic application in view of thoughts behind the CAF.

19. Moreover, a branch number is not indispensable when renumbering for paragraph numbers is permitted. Therefore, it is better not to permit a branch number.

*Considering the amendment of a numbered table/ formula/ drawing etc.*

20. Regarding tables or formulas in a description, it is desirable to permit amendment by replacing the whole paragraph which includes them. This way makes it possible to avoid the complexity of the amendment and to keep procedures and systems simple. Moreover, there seems almost no disadvantage for an applicant.

21. As for drawings and scope of claims, it should be taken into consideration to permit the replacement of each drawing or each claim unit, just like the paragraph amendment for a description.

SEVERAL TYPES OF AMENDMENTS TO BE POSSIBLY OCCURRED IN JPO PROPOSAL

*Replacement of a paragraph*

22. Simple replacement of a paragraph (without change of the heading or number of a paragraph) aiming only at change of the contents of the paragraph does not result in the renumbering of a paragraph.

23. Also, when the contents of a paragraph increases by replacement, because it is not obligatory to add paragraph numbers due to such changes, a method of revision which does not basically add paragraph numbers in such a case is desirable.

*Deletion of a paragraph*

24. The deletion of a paragraph can result in renumbering. However, renumbering is not necessarily required. In the case of JPO domestic applications, it is permitted for applicants to delete of all the contents of a paragraph and leave the paragraph number of the paragraph as it originally was, which means there exists a paragraph (number) without any contents (sentences.) When a renumbering is performed due to deletion of a paragraph, replacement of the whole description is necessary.

*Addition of a paragraph*

25. When a paragraph is added, the renumbering of a paragraph number or a branch number is necessary. Since the branch number is not accepted in the JPO, when a paragraph is added, renumbering and replacement of the whole description becomes indispensable.

*Movement of a paragraph*

26. Movement of a paragraph can be regarded as being equal to several “replacements of a paragraph.” However, in the case that the movement of a heading of a paragraph accompanies the movement of the paragraph itself, the simple replacement of a paragraph does not work. It is because a heading does not belong to a paragraph, so the revision of a heading cannot be performed by the replacement of a paragraph. When such a heading needs to be revised, the replacement of the whole description is needed for a JPO domestic application.

*Replacement of the whole description*

27. In replacement of the whole description, when required, the applicant basically performs the renumbering. In the JPO, the renumbering is not performed by a government official.

*Amendment of a paper/image application*

28. In the case when paragraphs numbers are given in the original description: Paragraph amendment is permitted for a paper/image application with paragraph numbers, just as it is permitted for XML an electronic application.

29. In the case when paragraphs numbers are not given in an original description: If paragraph numbers are not given in an original description of domestic application, presently paragraph numbers are not given by the JPO when the description is digitized (into XML format.) In this case, amendments are performed as replacement of the whole description.

30. But it can be considered that if the IP office gives paragraph numbers when the description is digitized, and share the information of paragraph numbers with applicants, and then paragraph amendment can be performed for that application.

*31. The Meeting is invited to comment on the proposals of the JPO put forward in this document.*

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