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RECTIFICATION OF OBVIOUS MISTAKES

Document prepared by the International Bureau

INTRODUCTION

1. At its first session, held on November 12 to 16, 2001, the Working Group discussed a proposal by the United States of America that Rule 91¹ be amended to limit the rectification of obvious errors to errors occurring in the request and to eliminate the rectification of obvious errors in the description, claims, drawings, and abstract of international applications (see document PCT/R/WG/1/4, paragraphs 8 to 12). Those discussions are summarized in document PCT/R/WG/1/9, as follows:

¹ 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. References to “national laws,” “national applications,” “the national phase,” etc., include reference to regional laws, regional applications, the regional phase, etc. References to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT.

“Proposal to amend Rule 91 (see document PCT/R/WG/1/4)

“34. The comments and concerns expressed by various delegations included the following:

(i) while some delegations expressed support for the approach taken in the proposal, others felt that the correction of obvious errors should not be limited to errors occurring in the request but should continue to be possible also with regard to such errors in the description, claims and drawings; any such requests for correction should be dealt with as early as possible during the international phase rather than by individual [designated Offices] in the national phase;

(ii) noting the workload of Offices in dealing with requests under present Rule 91, it was recognized that a balanced solution would have to be found which would continue to give applicants the flexibility needed to correct obvious errors without putting too heavy a burden on Offices dealing with requests for rectifications;

(iii) noting ongoing discussions in the context of the draft [Substantive Patent Law Treaty], some delegations expressed their desire for a review of the present definition of “obvious error” under Rule 91.1(b).

“35. It was agreed that the proposal to amend Rule 91 should not be included in revised drafts to be prepared by the International Bureau, although delegations may wish to further consider the matter in the light of the discussion.”

2. For the second session of the Working Group, the International Bureau prepared a paper (document PCT/WG/2/6) outlining possible further PLT-related changes to the PCT. In relation to the correction of mistakes under PLT Rule 18, paragraph 14 of that document explained:

“Correction of mistakes

“14. The PLT sets out the requirements that a Contracting Party is permitted to apply as regards requests for correction by the Office of mistakes in respect of an application (see PLT Rule 18). In particular, it sets out the contents of the request that an Office may require; it also obliges the Office to notify the applicant of any non-compliance with one or more applicable requirements and to provide the applicant with an opportunity to subsequently comply with those requirements. However, it does not regulate what mistakes may be corrected. PCT Rule 91.1 provides for rectification of obvious errors in the international application or other papers. However, it does not set out any requirements as to the contents of the request for rectification. It also does not require the receiving Office, International Searching Authority or International Preliminary Examining Authority or International Bureau, as the case may be, to notify the applicant of any non-compliance with one or more applicable requirements and to provide the applicant with an opportunity to subsequently comply with those requirements.”

3. However, it was suggested “that any proposals to align the PCT with PLT Rule 18 in the above respects not be presented to the Working Group until a future session, as this does not appear to be a matter of high priority” (see document PCT/WG/2/6, paragraph 15; the Working Group at its second session was unable in the time available to consider document PCT/WG/2/6 (see document PCT/WG/2/12, paragraph 59)).
4. During its third session, the Working Group reviewed a proposal by the Representative of the European Patent Office (EPO) that Rule 91.1(b) be amended so as to refer to a “person skilled in the art” rather than “anyone” when determining whether a rectification offered by the applicant was “obvious” under Rule 91.1(b). Several delegations supported the proposal and also expressed the view that, in general, Rule 91 was unnecessarily strict. It was agreed that the EPO and the International Bureau should work together to review Rule 91 and to submit a written proposal for consideration by the Working Group (see the summary of the Chair of the third session of the Working Group, document PCT/R/WG/3/5, paragraph 64).
5. A written proposal was submitted to the fourth session of the Working Group (see document PCT/R/WG/4/4 Add.2). However, having regard to the time available, discussions on that document were deferred until the next session (see the summary of by the Chair, document PCT/R/WG/4/14, paragraph 104).
6. The written proposal was accordingly re-submitted to the last (fifth) session of the Working Group (see document PCT/R/WG/5/2). The Working Group’s discussions (see document PCT/R/WG/5/13, paragraphs 106 to 111) are outlined in the following paragraphs:
 - “106. Discussions were based on document PCT/R/WG/5/2.
 - “107. Several delegations and representatives of users expressed support in principle for the amendments proposed in the document. The Secretariat noted that, in general, the criteria for rectification of obvious errors under existing Rule 91 were very strict and not always easy to interpret. There was often great difficulty in deciding how to apply the requirement that a rectification be obvious in the sense that “anyone” would “immediately” realize nothing else could have been intended than what was offered as rectification. Read literally, this would suggest that a rectification might not be authorized if there was one person who would not immediately recognize that the rectification was obvious. The result was a range of different practices applied by the various Offices and Authorities.
 - “108. One delegation expressed its concern that the proposals did not streamline or simplify the procedures for rectification but rather introduced new standards and added complexity to the system; in their current form, the proposals would not be acceptable to the delegation. The delegation suggested that rectification of mistakes should be restricted to mistakes of a minor nature, such as clerical and typographical errors, so as to keep the system simple and transparent.
 - “109. After some discussion in which differing views were expressed, the Chair concluded that there was at present a wide variation in the interpretation of, and practice under, Rule 91, highlighting the need for an overhaul of the system so as to achieve more harmonized practices. The Working Group invited the International Bureau to further study the different practices and approaches, focusing, in particular, on the issues raised in the discussion. These included:

“(a) the definition of “mistakes” which should be rectifiable;

“(b) the question whether, in the light of such definition of “mistakes”, it was necessary to provide expressly that the omission of “an entire element or sheet of the international application” shall not be rectifiable; if so, what was meant by an “entire element” having regard to the term “elements” in Article 11(1)(iii), and whether it was necessary to explain that no change of meaning was intended by the proposed deletion of the words “even if clearly resulting from inattention, at the stage, for example, of copying or assembling sheets;”

“(c) the authorities (receiving Office, International Searching Authority, International Preliminary Examining Authority, International Bureau) which should be responsible for the rectification of mistakes appearing in different elements of the international application (request; description, claims and drawings; corrections and amendments; other documents) and the responsibility of different authorities in different stages of the international phase (Chapter I and Chapter II);

“(d) the basis on which the relevant authority should make the finding whether an alleged mistake is a rectifiable mistake, that is:

“(i) the notional person who should understand what was intended (for example, a person skilled in the art, or a person in the relevant authority);

“(ii) the question of what should be the “applicable date” to be used in determining the allowability of a rectification of a mistake, depending on the element of the international application (request; description, claims and drawings; corrections and amendments) or other document in question;

“(iii) the circumstances (if any) in which account should be taken of the contents of extrinsic documents, including the question as to which documents should be considered to be extrinsic (for example, a cover-letter or other document of record contained in the files of the receiving Office on the international filing date; an earlier application the priority of which was claimed; instructions from the applicant to the attorney);

“(e) the question whether, in accordance with the principle of *lex specialis*, rectification of a mistake should be permitted under Rule 91 if a specific remedy existed elsewhere in the Treaty or Regulations, for example, in respect of correction of priority claims under Rules 26*bis*;

“(f) the time limit for submitting a request for rectification, including:

“(i) the question whether a request for rectification of a mistake in the international application should be submitted before international publication; and

“(ii) the question whether rectification of mistakes in the description, claims or drawings of an international application should be permitted after the start of the international preliminary examination procedure or whether any mistake should be “correctable” at that stage only by way of an amendment;

“(g) the need to provide that a rectification under Rule 91 should have no effect in any designated or elected Office where the processing or examination of the international application has already started (in the case of early entry into the national phase);

“(i) the question whether the request for rectification should, in all cases, contain a brief explanation of the mistake and the proposed rectification;

“(j) what, if any, further action is necessary where a mistake in the description, claims or drawings, or a mistake in the correction of a priority claim, is rectified after the international search report and the written opinion of the International Searching Authority have been established.

“110. The Working Group also invited the International Bureau to study suggestions that Rule 82^{ter} be amended:

“(a) to require designated and elected Offices to rectify certain decisions taken by the receiving Office or the International Bureau during the international phase if that Office or the International Bureau accepted that the decision taken was erroneous;

“(b) to avoid designated and elected Offices having to decide disputes between the applicant and the receiving Office or the International Bureau as to whether certain decisions taken by the receiving Office or the International Bureau during the international phase were erroneous.

“111. One representative of users stressed the importance of present Rule 82^{ter} as the only provision in the PCT which would guarantee applicants a review by designated and elected Offices of certain decisions taken during the international phase by the receiving Office and the International Bureau, noting that, in particular, certain receiving Offices did not, under their national laws and practices, offer any review procedure with regard to decisions taken by them during the international phase.”

7. The Annex to this document contains proposals to amend Rule 91 accordingly, and proposals for consequential amendments of Rules 11, 12, 26^{bis}, 48, 66, 70 and 82^{ter}. For information and clarity, the proposals for amendment of Rule 91 are presented both in the form of a “clean” text of the Rule 91 as it would stand after amendment and in the form of a marked-up text of Rule 91 as proposed to be amended. The main features of the proposals are outlined in the following paragraphs.

RECTIFICATION OF OBVIOUS MISTAKES

Rectification of “Obvious Mistakes”

8. *Obviousness.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(a). Upon further consideration, it is proposed to continue to use, as at present, the term “obvious” mistake rather than (as was proposed in document PCT/R/WG/5/2) “clear” mistake, noting that the term “obvious” appears to better define and more clearly describe the kind of mistake that should be rectifiable under Rule 91.

9. *Definition.* It is proposed to consider a mistake as being “obvious” and thus rectifiable if the competent authority finds:

- (a) that something else was intended than what appears in the document concerned;
and
- (b) that nothing else could have been intended than the proposed rectification.

10. As is presently the case (see the final draft of the PCT International Search and Preliminary Examination Guidelines as applied to international applications filed on or after January 1, 2004, document PCT/GL/ISPE/1 Prov.2, Chapter 8, paragraph 8.02), the PCT International Search and Preliminary Examination Guidelines should continue to provide that, where the alleged mistake is in any part of the international application other than the request, or in any correction or amendment thereof, the proposed rectification could only be considered obvious where what is proposed as rectification would not go beyond the disclosure in the international application as filed.

11. *Rectification.* Although the draft SPLT uses the term “correction” instead of “rectification” (see draft SPLT Article 7(3) and draft SPLT Rule 7(2)), it is proposed, as was proposed in document PCT/R/WG/5/2, to continue to use the term “rectification” so as to maintain the distinction, in the context of the PCT, between “amendments” of the description, claims or drawings (under Articles 19 and 34) and “corrections” of formal defects (under Article 14 and Rule 26).

Responsibility for Authorization of Rectification

12. *Competent authorities.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(c). It is proposed to make a clear distinction between the “competent authorities” responsible for authorizing the rectification of obvious mistakes appearing in the different elements of the international application and in related documents, and the responsibility of the different competent authorities in the different stages of the international phase. Under the proposals, the finding whether an alleged mistake is obvious and thus rectifiable would be made:

- (a) in the case of a mistake in the request part of the international application, or in any correction thereof—by the receiving Office;
- (b) unless the International Preliminary Examining Authority is competent under paragraph (c), below, in the case of a mistake in any part of the international application other than the request, or in any correction thereof, or in any amendment under Article 19—by the International Searching Authority;

(c) on or after the date on which international preliminary examination shall start in accordance with Rule 69.1, and provided that the demand for international preliminary examination has not been withdrawn, in the case of a mistake in any part of the international application other than the request, or in any correction thereof, or in any amendment under Article 19 or 34—by the International Preliminary Examining Authority;

(d) in the case of a mistake in any other document submitted to the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau—by that Office, Authority or Bureau, as the case may be.

Basis for the Finding by the Competent Authority

13. *Notional person.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(d)(i). As was the case in document PCT/R/WG/5/2, if the alleged mistake is in any part of the international application other than the request, or in any correction or amendment thereof (that is, in cases where either the International Searching Authority or the International Preliminary Examining Authority is the competent authority), it is proposed to refer to a “person skilled in the art” as the notional person who should understand what was intended by the applicant and who should make the finding whether the alleged mistake is obvious. Otherwise, that is, where the mistake is in the request or in any other document submitted to either the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau, no specific attributes need to be ascribed to the person making the finding whether an alleged mistake is “obvious” and thus rectifiable.

14. *Applicable date.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(d)(ii). As was already proposed in document PCT/R/WG/5/2, it is proposed that the applicable date to be used in determining the allowability of a rectification of a mistake should be:

(a) the international filing date where the alleged mistake is in any part of the international application;

(b) the date on which the document containing the alleged mistake was received where the alleged mistake is in any other document, including an amendment or a correction of any part of the international application (noting that, where the mistake is an amendment or a correction of any part of the international application, such mistake could only be considered to be obvious and thus rectifiable where what is proposed as rectification would not go beyond the disclosure in the international application as filed (see paragraph 10, above).

15. *Extrinsic documents.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(d)(iii). Noting that only *obvious* mistakes should be rectifiable under Rule 91, and so as to not to add further complexity to the system (for example, procedures allowing the applicant to furnish evidence, showing his real intention, such as instructions to the agent etc.), it is proposed that the competent authority, when making the finding whether an alleged mistake is “obvious” and thus rectifiable, should only

take into account the document containing the mistake, any other document filed with that document, any other document contained in the authority's file as the applicable date referred to in paragraph 14, above, and the priority document.

Mistakes not Rectifiable Under Rule 91

16. *Omission of entire sheets etc.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(b). It is proposed to maintain the existing provision that the omission of an entire element or sheet shall not be rectifiable under Rule 91. In view of the proposal to provide expressly for the furnishing of missing parts of the description, claims or drawings (see document PCT/R/WG/6/...), it would not seem appropriate to change the existing provisions of Rule 91 in this respect. Furthermore, it is proposed to clarify what is meant by an "entire element" by referring expressly to the elements of the international application listed in Article 3(2) (request, description, claims, drawings and the abstract).

17. *Mistakes in priority claims and corrections and additions thereof.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(e). Upon consideration, it is proposed that a mistake in a priority claim or in a notice correcting or adding a priority claim (submitted under Rule 26bis) should not be rectifiable under Rule 91 where the rectification of such mistake would cause a change in the priority date of the international application. So as not to add further complexity to the system with regard to the computation of time limits calculated on the basis of the priority date, such mistake should only be correctable by way of submitting a (further) notice of correction or addition under Rule 26bis of the priority claim in question, within the applicable time limit under that Rule.

Request for Rectification

18. *Time limit; effect of authorization on written opinions and reports.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(f)(i). Upon consideration, it would generally appear not to be necessary to require that any rectification of an obvious mistake in any part of the international application be submitted before the International Searching Authority has begun to draw up the international search report or the written opinion, or (under Chapter II) before the International Preliminary Examination Authority has begun to draw up the written opinion or the international preliminary examination report. Noting that a mistake could only be considered to be obvious and thus rectifiable where what is proposed as rectification would not go beyond the disclosure in the international application as filed, it would appear that the rectification of an obvious mistake in any part of the international application should not effect the substance of any written opinion or report. It is thus proposed to set a uniform time limit of 28 months from the priority date for submitting a request for rectification, irrespective of which is the competent authority for the rectification of the alleged mistake, and irrespective of whether the Authority had indeed begun to draw up a written opinion or report.

19. On the other hand, it is proposed to expressly provide that any rectification authorized after the International Searching Authority or the International Preliminary Examining Authority has begun to draw up a written opinion or a report would not need to be taken into account by that Authority for the purposes of establishing the opinion or the report in question, and to require the International Searching Authority or the International Preliminary Examining Authority, as the case may be, to include in any authorization of the rectification of an obvious mistake information as to whether or not the rectification has been taken into

account for the purposes of preparing the written opinion or report. Such information would then be published together with the rectification (either as part of the pamphlet or together with the statement reflecting all rectifications).

20. *“Correction” of mistakes by way of amendments under Article 34.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(f)(ii). Upon consideration, it is not proposed to allow for the “correction” of mistakes, after the start of the international preliminary examination procedure, only by way of an amendment of the international application under Article 34, as was suggested at the fifth session of the Working Group. Rather, it is proposed to maintain, as under many national and regional laws, a clear legal distinction between, on the one hand, amendments of the description, claims or drawings, and rectifications (or corrections) of mistakes (or errors) in the description, claims or drawings, on the other hand, noting that the rectification of an obvious mistake in the international application would be effective from the international filing date.

21. *Explanation.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(h). Upon consideration, it would appear not to be appropriate to include a mandatory requirement for the applicant to furnish a brief explanation of the mistake and the proposed rectification, as was suggested at the fifth session of the Working Group, noting that such explanation cannot be required under PLT Rule 18(1).

Authorization of Rectification

22. *Effect on written opinions and reports.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(i). With regard to the question of what, if any, further action would be necessary where a mistake in the international application, other than the request, is rectified after the International Searching Authority or the International Preliminary Examining Authority has begun to draw up the written opinion or any report, see paragraph 18, above.

23. *Effect on designated/elected Offices where national processing has started.* See the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraph 109(g). It is proposed to expressly provide that the rectification of an obvious mistake shall have no effect in any designated or elected Office in which processing or examination of the international application has already started prior to the date on which the competent authority authorized the rectification.

RECTIFICATION BY DESIGNATED OR ELECTED OFFICES OF ERRORS MADE BY THE RECEIVING OFFICE OR BY THE INTERNATIONAL BUREAU

24. At its fifth session, the Working Group invited the International Bureau to study suggestions that Rule 82*ter* be amended to require designated and elected Offices to rectify certain decisions taken by the receiving Office or the International Bureau during the international phase if that Office or the International Bureau accepted that the decision taken was in error (see the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraphs 110(a)). A proposal to amend Rule 82*ter* accordingly is contained in the Annex to this document. Note that, while the requirement under proposed new Rule 82*ter.2*, namely, that the receiving Office or the International Bureau accepts that the decision which it took was in error, is stricter than the requirement under present Rule 82*ter.1* (which does not necessitate such acceptance), it would not be required that the error must be such that, had it been made by the designated or elected Office itself, that Office would rectify it under its

national law or practice, as is required under present Rule 82*ter*.1. Note further that proposed new Rule 82*ter*.2 is not limited to the rectification of errors by the receiving Office or the International Bureau concerning the international filing date or a priority claim, as is the case under present Rule 82*ter*.1.

25. At its fifth session, the Working Group also invited the International Bureau to study suggestions that Rule 82*ter* be amended to avoid designated and elected Offices having to decide disputes between the applicant and the receiving Office or the International Bureau as to whether certain decisions taken by the receiving Office or the International Bureau during the international phase were erroneous (see the summary of the fifth session by the Chair, document PCT/R/WG/5/13, paragraphs 110(b)). However, since the Rule 82*ter* at present expressly provides only for rectification if the error was rectifiable under the national law or practice of the designated or elected Office concerned, it does not appear possible to avoid referring to an error by the receiving Office or International Bureau within the context of existing Rule 82*ter*.1. As explained in paragraph 24, above, as an alternative approach, it is proposed to amend Rule 82*ter* so as to provide, in addition to the rectifications under present Rule 82*ter*.1, for the rectification of errors if the receiving Office or the International Bureau accepts that the decision which it took was in error (in which case the designated or elected Office would not have to intervene in or decide disputes between the applicant and the receiving Office or the International Bureau).

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

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:²
RECTIFICATION OF OBVIOUS MISTAKES (OBVIOUS ERRORS)

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² 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.

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Rule 11

Physical Requirements of the International Application

11.1 to 11.13 [No change]

11.14 *Later Documents*

Rules 10, and 11.1 to 11.13, also apply to any document—for example, [replacement sheets](#) ~~corrected pages~~, amended claims, translations—submitted after the filing of the international application.

[COMMENT: It is proposed to amend Rule 11.14 so as to align the terminology (“replacement sheets” instead of “corrected pages”) with that used in Rule 26.4, which applies *mutatis mutandis* under Rule 91.2(b) as proposed to be amended (see below).]

Rule 12

**Language of the International Application and Translation
for the Purposes of International Search and International Publication**

12.1 [No change]

12.2 *Language of Changes in the International Application*

(a) [No change]

(b) Any rectification under Rule 91.1 of an obvious mistake ~~error~~ in the international application shall be in the language in which the application is filed, provided that:

[COMMENT: Consequential on the proposed amendment of Rule 91 (see below).]

(i) and (ii) [No change]

(c) [No change]

12.3 and 12.4 [No change]

Rule 26bis

Correction or Addition of Priority Claim

26bis.1 Correction or Addition of Priority Claim

(a) The applicant may correct or add [to the request](#) a priority claim by a notice submitted to the receiving Office or the International Bureau within a time limit of 16 months from the priority date or, where the correction or addition would cause a change in the priority date, 16 months from the priority date as so changed, whichever 16-month period expires first, provided that such a notice may be submitted until the expiration of four months from the international filing date. The correction of a priority claim may include the addition of any indication referred to in Rule 4.10.

[COMMENT: It is proposed to amend Rule 26bis.1(a) so as clarify that any correction or addition of a priority claim would be made “to the request,” as is the case also for any correction or addition of declarations under present Rule 26ter.1(a). In the context of “obvious mistakes, ” the proposed amendment would also clarify that the receiving Office would be the competent authority to authorized the rectification of an obvious mistake made in a notice correcting or adding a priority claim (provided that such correction or addition would not cause a change in the priority date, in which case a rectification under Rule 91.1 would not be possible (see Rule 91.1(d)(ii) as proposed to be amended, below).]

(b) and (c) [No change]

26bis.2 [No change]

Rule 48

International Publication

48.1 [No change]

48.2 *Contents*

(a) The pamphlet shall contain:

(i) to (vi) [No change]

(vii) any request for rectification of an obvious mistake, any reasons and any comments referred to in Rule 91.3(e) where the request for publication under Rule 91.3(e) was received by the International Bureau before the completion of the technical preparations for international publication ~~referred to in the third sentence of Rule 91.1(f),~~

(viii) to (ix) [No change]

(x) any declaration referred to in Rule 4.17(v), and any correction thereof under Rule 26*ter*.1, which was received by the International Bureau before the expiration of the time limit under Rule 26*ter*.1;

(xi) any information concerning the authorization of the rectification of an obvious mistake referred to in Rule 91.3(b), second sentence.

[Rule 48.2, continued]

(b) to (h) [No change]

(h-bis) If the authorization for rectification of an obvious mistake in the international application referred to in Rule 91.1 is received or given by the International Bureau after completion of the technical preparations for international publication, either the pamphlet (containing the international application as rectified and any information referred to in paragraph (a)(xi)) shall be republished or a statement reflecting all the rectifications (containing any information referred to in paragraph (a)(xi)), shall be published. In the latter case, at least the front page shall be republished and the sheets containing the rectifications, or the replacement sheets and the letter furnished under Rule 91.2(b), as the case may be, and any information referred to in paragraph (a)(xi), shall be published.

(i) The Administrative Instructions shall determine the cases in which the various alternatives referred to in paragraphs (g), ~~and~~ (h) and (h-bis) shall apply. Such determination shall depend on the volume and complexity of the amendments or rectifications and/or the volume of the international application and the cost factors.

(j) If the request for publication under Rule 91.3(e) was received by the International Bureau after the completion of the technical preparations for international publication, the request for rectification, any reasons and any comments referred to in Rule 91.3(e) shall be promptly published after the receipt of the request for publication, and the front page shall be republished.

[Rule 48.2(j), continued]

[COMMENT: The proposed amendments of Rule 48.2 are consequential on the proposed change of approach with regard to the time limit within which a request for rectification of a mistake may be made; see proposed new Rule 91.2(a), below.]

48.3 to 49.6 [No change]

Rule 66

Procedure Before the International Preliminary Examining Authority

66.1 to 66.5 [No change]

66.5 *Amendment*

Any change, other than the rectification of an obvious mistake errors, in the claims, the description, or the drawings, including cancellation of claims, omission of passages in the description, or omission of certain drawings, shall be considered an amendment.

[COMMENT: Consequential on the proposed amendment of Rule 91 (see below).]

66.6 to 66.9 [No change]

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), each replacement sheet containing amendments under Article 19 and, [subject to Rule 91.3\(b\)](#), each replacement sheet containing [the](#) rectifications of [an](#) obvious [mistake](#) ~~errors~~ authorized under Rule [91.1\(b\)\(iii\)](#) ~~91.1(e)(iii)~~ shall, unless superseded by later replacement sheets or amendments resulting in the cancellation of entire sheets under Rule 66.8(b), be annexed to the report. Replacement sheets containing amendments under Article 19 which have been considered as reversed by an amendment under Article 34 and letters under Rule 66.8 shall not be annexed.

(b) [No change]

70.17 [No change]

Rule 82ter

Rectification of Errors Made

by the Receiving Office or by the International Bureau

82ter.1 [No change] *Errors Concerning the International Filing Date and the Priority Claim*

If the applicant proves to the satisfaction of any designated or elected Office that the international filing date is incorrect due to an error made by the receiving Office or that the priority claim has been erroneously considered by the receiving Office or the International Bureau not to have been made, and if the error is an error such that, had it been made by the designated or elected Office itself, that Office would rectify it under the national law or national practice, the said Office shall rectify the error and shall treat the international application as if it had been accorded the rectified international filing date or as if the priority claim had not been considered not to have been made.

82ter.2 *Errors in Decisions*

If the receiving Office or International Bureau accepts that a decision taken by the receiving Office or the International Bureau, as the case may be, was in error, the designated or elected Office shall rectify the error and shall treat the international application as if that error had not been made.

[COMMENT: See paragraphs 24 and 25 of the Introduction to this document.]

Rule 91 [“clean” copy]³

**Rectification of Obvious Mistakes in
the International Application and Other Documents**

91.1 Rectification of Obvious Mistakes

(a) An obvious mistake in the international application or other document submitted by the applicant shall be rectifiable, on the request of the applicant, subject to and in accordance with paragraphs (b) to (e) and Rules 91.2 and 91.3.

(b) A rectification under this Rule shall be made only if it is authorized by “the competent authority,” that is:

(i) in the case of a mistake in the request part of the international application, or in any correction thereof—by the receiving Office;

(ii) unless the International Preliminary Examining Authority is competent under item (iii), in the case of a mistake in any part of the international application other than the request, or in any correction thereof, or in any amendment under Article 19—by the International Searching Authority;

³ Comments on particular provisions appear only in the “marked-up” copy following.

[Rule .91.1(b), continued]

(iii) on or after the date on which international preliminary examination shall start in accordance with Rule 69.1, and provided that the demand for international preliminary examination has not been withdrawn, in the case of a mistake in any part of the international application other than the request, or in any correction thereof, or in any amendment under Article 19 or 34—by the International Preliminary Examining Authority;

(iv) in the case of a mistake in any other document submitted to the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau—by that Office, Authority or Bureau, as the case may be.

(c) For the purposes of this Rule:

(i) a mistake shall be considered to be obvious only if the competent authority finds that something else was intended than what appears in the document concerned and that nothing else could have been intended than the proposed rectification;

(ii) the competent authority shall take into account the document containing the mistake, any other document filed with that document, any other document contained in the authority's file at the applicable date under item (iv), and the priority document;

[Rule 91.1(c), continued]

(iii) in the case of a mistake in any part of the international application other than the request or in any amendment or correction thereof, the competent authority shall make its finding on the basis of what would have been understood by a person skilled in the [relevant] art;

(iv) a finding as to whether a mistake is obvious shall be made, in the case of a mistake in any part of the international application, as at the international filing date, and in the case of a mistake in any other document, including an amendment or a correction of the international application, as at the date on which that document was submitted.

(d) The following shall not be rectifiable under this Rule:

(i) the omission of one or more entire elements of the international application as referred to in Article 3(2) or of one or more entire sheets of the international application;

(ii) an obvious mistake in a priority claim or in a notice correcting or adding a priority claim under Rule 26bis.1(a), where the rectification of the mistake would cause a change in the priority date;

provided that nothing in this paragraph shall prevent the inclusion of a missing part containing an entire element or an entire sheet, or the correction of a mistake in a priority claim, under another provision of these Regulations.

[Rule 91.1, continued]

(e) Where the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau discovers what appears to be a rectifiable obvious mistake in the international application or other document, it may invite the applicant to request rectification under this Rule.

91.2 Requests for Rectification

(a) A request for rectification of an obvious mistake shall be submitted to the competent authority within 28 months from the priority date. It shall specify the mistake to be rectified and the proposed rectification, and may, at the option of the applicant, contain a brief explanation.

(b) Rule 26.4 shall apply *mutatis mutandis* as to the manner in which a rectification shall be requested.

91.3 Authorization and Effect of Rectifications

(a) The competent authority shall promptly decide whether to authorize or refuse to authorize the rectification of an obvious mistake under Rule 91.1 and shall promptly notify the applicant and the International Bureau of the authorization or refusal and, in the case of refusal, of the reasons therefor. The International Bureau shall proceed as provided for in the Administrative Instructions.

[Rule 91.3, continued]

(b) The rectification of an obvious mistake need not be taken into account by the International Searching Authority for the purposes of the international search report or the written opinion by that Authority, or by the International Preliminary Examining Authority for the purposes of a written opinion by that Authority or the international preliminary examination report, if that Authority gives, or is informed of, the authorization after it has begun to draw up the written opinion or report concerned. Where that Authority has authorized the rectification of an obvious mistake in the international application or in any correction or amendment thereof, the notification under paragraph (a) shall include information as to whether the rectification has been or will be taken into account in the written opinion or report concerned.

(c) Where rectification of an obvious mistake has been authorized under Rule 91.1, it shall be made in the document concerned as provided in the Administrative Instructions.

(d) Where the rectification of an obvious mistake has been authorized, it shall be effective:

(i) in the case of a mistake in the international application, from the international filing date;

(ii) in the case of a mistake in another document, including an amendment or a correction of the international application, from the date on which that document was submitted.

[Rule 91.3, continued]

(e) Where the competent authority refuses to authorize a rectification under Rule 91.1, the International Bureau shall, upon request submitted to it by the applicant within two months from the date of the refusal, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, publish the request for rectification, the reasons for refusal by the authority and any further brief comments that may be submitted by the applicant, if possible together with the international application. A copy of that request, of those reasons and of those comments (if any) shall if possible be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3).

(f) The rectification of an obvious mistake need not be taken into account by any designated or elected Office in which the processing or examination of the international application has already started prior to the date of the authorization of the rectification by the competent authority.

Rule 91 [“marked-up” copy]

**Rectification of Obvious Mistakes Errors in the
International Application and Other Documents**

91.1 *Rectification of Obvious Mistakes*

(a) An obvious mistake ~~Subject to paragraphs (b) to (g-quarter), obvious errors~~ in the international application or other document papers submitted by the applicant shall be rectifiable, on the request of the applicant, subject to and in accordance with paragraphs (b) to (e) and Rules 91.2 and 91.3 ~~may be rectified.~~

[COMMENT: See paragraphs 8 and 11 of the Introduction to this document.]

(b) ~~(e)~~ A No rectification under this Rule shall be made only if it is authorized by “the competent authority,” that is ~~except with the express authorization:~~

(i) in the case of ~~the receiving Office if the~~ a mistake error is in the request part of the international application, or any correction thereof—by the receiving Office;

(ii) unless the International Preliminary Examining Authority is competent under item (iii), in the case of ~~the International Searching Authority if the~~ a mistake error is in any part of the international application other than the request, or in any correction thereof, or in any amendment under Article 19—by the International Searching Authority ; ~~or in any document paper submitted to that Authority;~~

[Rule 91.1(b), continued]

(iii) on or after the date on which international preliminary examination shall start in accordance with Rule 69.1, and provided that the demand for international preliminary examination has not been withdrawn, in the case of the International Preliminary Examining Authority if the a mistake error is in any part of the international application other than the request, or in any correction thereof, or in any amendment under Article 19 or 34—by the International Preliminary Examining Authority; ~~or in any document paper submitted to that Authority,~~

(iv) in the case of a mistake in any other document submitted to the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or of the International Bureau—by that Office, Authority or Bureau, as the case may be if the error is in any paper, other than the international application or amendments or corrections to that application, submitted to the International Bureau.

[COMMENT: See paragraph 12 of the Introduction to this document.]

(c) ~~(b)~~ For the purposes of this Rule:

(i) a mistake shall be considered to be obvious only if the competent authority finds that something else was intended than what appears in the document concerned and that nothing else could have been intended than the proposed rectification.

[COMMENT: See paragraphs 9 and 10 of the Introduction to this document.]

[Rule 91.1(c), continued]

(ii) the competent authority shall take into account the document containing the mistake, any other document filed with that document, any other document contained in the authority's file at the applicable date under item (iv), and the priority document;

[COMMENT: See paragraph 15 of the Introduction to this document.]

(iii) in the case of a mistake in any part of the international application other than the request or in any amendment or correction thereof, the competent authority shall make its finding on the basis of what would have been understood by a person skilled in the [relevant] art;

[COMMENT: See paragraph 13 of the Introduction to this document.]

(iv) a finding as to whether a mistake is obvious shall be made, in the case of a mistake in any part of the international application, as at the international filing date, and in the case of a mistake in any other document, including an amendment or a correction of the international application, as at the date on which that document was submitted.

[COMMENT: See paragraph 14 of the Introduction to this document.]

[Rule 91.1(c), continued]

~~Errors which are due to the fact that something other than what was obviously intended was written in the international application or other paper shall be regarded as obvious errors. The rectification itself shall be obvious in the sense that anyone would immediately realize that nothing else could have been intended than what is offered as rectification.~~

~~(d)~~ (e) The following shall not be rectifiable under this Rule:

- (i) the omission ~~Omissions~~ of one or more entire elements of the international application referred to in Article 3(2) or one or more entire sheets of the international application; ~~even if clearly resulting from inattention, at the stage, for example, of copying or assembling sheets, shall not be rectifiable~~
- (ii) an obvious mistake in a priority claim or in a notice correcting or adding a priority claim under Rule 26bis.1(a), where the rectification of the mistake would cause a change in the priority date;

provided that nothing in this paragraph shall prevent the inclusion of a missing part containing an entire element or an entire sheet, or the correction of a mistake in a priority claim, under another provision of these Regulations.

[COMMENT: See paragraphs 16 and 17 of the Introduction to this document.]

[Rule 91.1, continued]

(e) ~~(d)~~ Where the receiving Office, the International Searching Authority, the International Preliminary Examining Authority or the International Bureau discovers
~~Rectification may be made on the request of the applicant. The authority having discovered~~
what appears to be a rectifiable obvious mistake in the international application or other
document, it ~~an obvious error~~ may invite the applicant to ~~present a~~ request ~~for~~ rectification ~~as~~
~~provided in paragraphs (e) to (g-*quater*) in accordance with this Rule. Rule 26.4 shall apply~~
~~mutatis mutandis to the manner in which rectifications shall be requested.~~

[COMMENT: Clarification only. It is proposed to move the last sentence of present paragraph (d) to proposed new Rule 91.2(b) (see below).]

91.2 Requests for Rectification

(a) A request for rectification of an obvious mistake shall be submitted to the
competent authority within 28 months from the priority date. It shall specify the mistake to
be rectified and the proposed rectification, and may at the option of the applicant, contain a
brief explanation.

[COMMENT: See paragraphs 18 and 19, and paragraph 21 of the Introduction to this document. See also PLT Rule 18(1)(a)(i), (iii) and (iv). The indication under PLT Rule 18.1(a)(ii) (the number of the application or patent concerned) is not included here since the request for rectification must be in the form of, or accompanied by, a letter identifying the international application to which it relates (see PCT Rule 92.1(a)). The indication under PLT Rule 18.1(a)(v) (the name and address of the requesting party) is not included since rectification may be made only on the request of the applicant (see paragraph (d), above).]

[Rule 91.2(a), continued]

~~[91.1(g)] The authorization for rectification referred to in paragraph (e) shall, subject to paragraphs (g-bis), (g-ter) and (g-quater), be effective:~~

~~(i) where it is given by the receiving Office or by the International Searching Authority, if its notification to the International Bureau reaches that Bureau before the expiration of 17 months from the priority date;~~

~~(ii) where it is given by the International Preliminary Examining Authority, if it is given before the establishment of the international preliminary examination report;~~

~~(iii) where it is given by the International Bureau, if it is given before the expiration of 17 months from the priority date.~~

(b) Rule 26.4 shall apply *mutatis mutandis* as to the manner in which a rectification shall be requested.

91.3 Authorization and Effect of Rectifications

(a) ~~[91.1](f)~~ The competent authority shall promptly decide whether to authorize or refuse to authorize the rectification of an obvious mistake under Rule 91.1 and Any authority which authorizes or refuses any rectification shall promptly notify the applicant and the International Bureau of the authorization or refusal and, in the case of refusal, of the reasons

[Rule 91.3(a), continued]

therefor. The International Bureau shall proceed as provided for in the Administrative Instructions. ~~The authority which authorizes a rectification shall promptly notify the International Bureau accordingly.~~

[COMMENT: The proposed amendments would align the wording with that used elsewhere in the amended Rule. The Administrative Instructions would have to be modified so as to require the International Bureau to promptly notify the receiving Office, the International Searching Authority and/or the International Preliminary Examining Authority accordingly, if needed.]

(b) The rectification of an obvious mistake need not be taken into account by the International Searching Authority for the purposes of the international search report or the written opinion by that Authority, or by the International Preliminary Examining Authority for the purposes of a written opinion by that Authority or the international preliminary examination report, if that Authority gives, or is informed of, the authorization after it has begun to draw up the written opinion or report concerned. Where that Authority has authorized the rectification of an obvious mistake in the international application or in any correction or amendment thereof, the notification under paragraph (a) shall include information as to whether the rectification has been or will be taken into account in the written opinion or report concerned.

[COMMENT: See paragraph 19 of the Introduction to this document.]

[Rule 91.3, continued]

(c) Where the rectification of an obvious mistake has been authorized under Rule 91.1, it shall be made in the document concerned as provided in the Administrative Instructions.

[COMMENT: Sections 325, 413, 511 and 607 of the Administrative Instructions would have to be modified.]

(d) Where a rectification of an obvious mistake has been authorized, it shall be effective:

(i) in the case of a mistake in the international application, from the international filing date:

(ii) in the case of a mistake in another document, including an amendment or a correction of the international application, from the date on which that document was submitted.

[COMMENT: Proposed new paragraph (d) would clearly spell out the effective date of a rectification once authorized.]

(e) ~~[91.1](f)~~ Where the competent authority refuses to authorize a rectification under Rule 91.1 ~~authorization of the rectification was refused~~, the International Bureau shall, upon request ~~submitted to it made~~ by the applicant ~~within two months from the date of the refusal, prior to the time relevant under paragraph (g-bis), (g-ter) or (g-quater)~~ and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions,

[Rule 91.3(e), continued]

publish the request for rectification, the reasons for refusal by the authority and any further brief comments that may be submitted by the applicant, if possible together with the international application. A copy of ~~that~~ ~~the~~ request, of those reasons and of those comments (if any) for rectification shall if possible be included in the communication under Article 20 where a copy of the pamphlet is not used for that communication or where the international application is not published by virtue of Article 64(3).

[COMMENT: Under paragraph (e) as proposed to be amended, upon request of the applicant, the International Bureau would also publish information with regard to a request for rectification which was refused by the International Preliminary Examining Authority, even if the request for publication is received after international publication. This would fill a gap which exists under the present Regulations: under present Rule 91.1(f), any request for publication of information with regard to a refused request for rectification has to be received by the International Bureau prior to completion of technical preparations for international publication. In practice, this means that information concerning a request for rectification which has been refused by the International Preliminary Examining Authority after international publication is neither published nor mentioned in the international preliminary examination report: only authorized rectifications are annexed to that report (see present Rule 70.16; see also Rule 70.16 as proposed to be amended, above).]

(f) The rectification of an obvious mistake need not be taken into account by any designated or elected Office in which the processing or examination of the international application has already started prior to the date of the authorization of the rectification by the competent authority.

[COMMENT: See paragraph 23 in the Introduction to this document.]

[Rule 91.3(f), continued]

~~{91.1}(g-bis) If the notification made under paragraph (g)(i) reaches the International Bureau, or if the rectification made under paragraph (g)(iii) is authorized by the International Bureau, after the expiration of 17 months from the priority date but before the technical preparations for international publication have been completed, the authorization shall be effective and the rectification shall be incorporated in the said publication.~~

~~{91.1}(g-ter) Where the applicant has asked the International Bureau to publish his international application before the expiration of 18 months from the priority date, any notification made under paragraph (g)(i) must reach, and any rectification made under paragraph (g)(iii) must be authorized by, the International Bureau, in order for the authorization to be effective, not later than at the time of the completion of the technical preparations for international publication.~~

~~{91.1}(g-quater) Where the international application is not published by virtue of Article 64(3), any notification made under paragraph (g)(i) must reach, and any rectification made under paragraph (g)(iii) must be authorized by, the International Bureau, in order for the authorization to be effective, not later than at the time of the communication of the international application under Article 20.~~

[End of Annex and of document]