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PROPOSALS WITH RESPECT TO AMENDMENT OF CLAIMS

Document prepared by the United States of America

SUMMARY

1. This document contains proposals for amendment of the Regulations under the PCT relating to the amendment of claims under Articles 19 and 34¹. Specifically, it is proposed that PCT Rules 46.5 and 66.8 be amended to require that, when amending the claims under Articles 19 and 34, applicants submit a complete set of claims.

BACKGROUND

2. Currently, when amending the claims in an international application under Articles 19 or 34, the applicant is required to submit a replacement sheet only for those sheets of claims which, on account of an amendment, differ from the sheet previously filed. This can result in confusion and increased workload for examiners, both in Chapter II and in the national/regional phase, as they must then sort through multiple sets of claims to determine which sheets contain the actual set of claims to be examined.

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.

3. This problem can be largely eliminated by requiring applicants to submit a complete set of claims whenever any of the claims are amended. As a result, the examiner can be sure that the set of claims to be examined is up-to-date and complete, eliminating the need to search the application file for original or previously amended claims.

PROPOSALS TO AMEND RULES 46.5 AND 66.8

4. Therefore, it is proposed that Rules 46.5 and 66.8 be amended to require that, when amending any of the claims, the applicant must submit a complete set of claims as they stand on the date of amendment.

5. The Working Group is invited to consider the proposals contained in the Annex to this document

[Annex follows]

ANNEX

PROPOSALS WITH RESPECT TO AMENDMENT OF CLAIMS²

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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.

Rule 46

Amendment of Claims before the International Bureau

46.1 to 46.4 [No change]

46.5 *Form of Amendments*

(a) The applicant shall be required to submit a complete set of all the claims in the application ~~replacement sheet for every sheet of the claims which, on account of when~~ submitting an amendment or amendments under Article 19, ~~differs from the sheet originally filed.~~ The set of claims will serve to replace all prior versions of the claims in the application.

(b) The set of claims shall be accompanied by a letter ~~accompanying the replacement sheets~~ which shall indicate the claims which are being amended and shall draw attention to the differences between the prior version of the claims ~~replaced sheets~~ and the amended claims ~~replacement sheets.~~ ~~To the extent that any amendment results in the cancellation of an entire sheet, that amendment shall be communicated in a letter.~~

Rule 66

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 any part of the international application other than the claims, 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 letter accompanying the replacement sheets shall draw attention to the differences between the replaced sheets and the replacement sheets and shall preferably also explain the reasons for the amendment.

(b) [No change]

(c) When amending the claims, Rule 46.5 shall apply *mutatis mutandis*.

66.9 [No change]

[End of Annex and of document]