

PCT – Part H

Amendments and Corrections

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Chapter I – The right to amend

Chapter H-I deals with the right to amend, while Chapters H-II and H-III deal with the allowability of amendments. Chapter H-IV is dedicated to the rectification of obvious mistakes.

1. Introduction

Notwithstanding the possibility to amend the claims before the IB under Art. 19, an international application may be amended during the PCT Chapter II procedure. There are a number of important aspects to consider.

Firstly, the amendments filed must be such that they can be taken into consideration by the EPO in its capacity as IPEA. The conditions governing timing and formal aspects are explained in GL/PCT-EPO H-I, 2 to GL/PCT-EPO H-I, 6.

Any change in the claims, the description or the drawings, other than a rectification of obvious mistakes under Rule 91, a correction under Rule 26 or the furnishing of missing parts under Rule 20.5 or correct elements or parts under Rule 20.5*bis*, is considered an amendment. Unless withdrawn or superseded by later amendments, any change considered an amendment must be taken into consideration for the purpose of the international preliminary examination.

Art. 19
Art. 34(2)(b)
Rule 66.5
GL/ISPE 20.04

Secondly, amendments must be allowable, which means that they must not:

- (i) add to the application subject-matter which was not disclosed in the application as originally filed
- (ii) introduce other deficiencies (such as lack of clarity in the claims).

Art. 19(2)
Art. 34(2)(b)

GL/ISPE 20.09

2. Amendments before receipt of the search report

There is no right to amend the application until after the international search report has been established. Obvious mistakes, on the other hand, may be corrected (see GL/PCT-EPO H-IV).

3. Amendments prior to the start of international preliminary examination

When filing the demand, the applicant should indicate on Form PCT/IPEA/401 which documents should form the basis for international preliminary examination. These may be:

- the international application as originally filed, or
- amendments to the claims under Art. 19 and/or
- amendments to the claims, the description and/or sequence listings filed as a part thereof and/or the drawings under Art. 34(2)(b).

Art. 19
Art. 34(2)(b)
Rule 53.9
Rule 66.1
GL/ISPE 20.01-20.02

- Rule 53.9(a)* The applicant may have filed amended claims under Art. 19 with the International Bureau after receipt of the search report and before the demand was filed. When filing the demand, the applicant may revert to the originally filed claims, reversing the amendments made according to Art. 19. If this is the case, preliminary examination proceeds on the basis of the originally filed set of claims.
- Rule 54bis,*
Rule 53.9(c),
Rule 60.1(g),
Rule 69.1(a)
PCT AG I 10.010
- Amendments and/or arguments filed under Art. 34 should preferably be filed together with the demand. Where the applicant indicates in the statement concerning amendments filed with the demand that it is doing so, but fails to actually submit the amendments with the demand, the EPO as IPEA will invite the applicant to submit them within a set time limit (Form PCT/IPEA/431). Where the applicant has expressly requested postponement of the start of international preliminary examination until expiry of the time limit under Rule 54bis.1(a), the EPO as IPEA will take into account any amendments and/or arguments under Art. 34 which are filed before then (see also GL/PCT-EPO C-VI, 1).
- The examiner should carefully check that the examination is based on the correct set of documents.
- 4. Further opportunity to submit amendments**
- Art. 34(2)(b)*
Rule 66.4
- Together with the reply to the WO-ISA, the WO-IPEA or the minutes of a telephone consultation, the applicant has, subject to certain exceptions (see GL/PCT-EPO, C-VII, 1(d)), the opportunity to submit (further) amendments under Art. 34 to the claims, description and/or drawings.
- Rule 66.4bis*
GL/ISPE 20.05
- Subsequently filed amendments and/or arguments will be taken into account by the EPO as IPEA only if they are received before the point at which preparation of a written opinion or the IPER has actually started.
- For further details, see GL/PCT-EPO C-IV, 1 and GL/PCT-EPO C-IV, 2 and subsections, and GL/PCT-EPO C-VII, 1.
- 5. Amended sheets**
- Rule 66.8*
GL/ISPE 20.06
- Amendments to the claims, the description and the drawings must be made by filing replacement sheets when, on account of the amendments, the replacement sheet differs from the sheets previously filed.
- Rule 46.5*
- If amendments are made to the claims, a complete set of new claims should be filed.
- Rule 92.4*
GL/ISPE 20.08
- The applicant may submit amendments by fax and there is no need for a confirmation letter, unless the faxed document is illegible. Printed or typed amendments are preferred; handwritten amendments are, in general, not acceptable. Nevertheless, if the handwritten amendments are legible they may – at the discretion of the EPO – be admitted.
- PCT AI Annex C, 3ter*
- If amendments are made to a sequence listing contained in an application filed in electronic form, a sequence listing in electronic form comprising the entire listing with the relevant amendment must be filed.

6. Indication of amendments and their basis

The applicant is obliged to indicate the basis in the application as originally filed for any amendments filed. If no such basis is indicated, the IPER may be established as if the amendments had not been made. This is indicated in the IPER under Section I.

Rule 46.5
Rule 66.8(a)
Rule 70.2(c-bis)

If a further WO-IPEA (Form 408) is sent (with respect for the principles set out in GL/PCT-EPO C-IV, 2.2), there should be a similar indication in the WO-IPEA as to which amendments could not be taken into account. Further, the applicant may also be reminded in this WO-IPEA to specify the basis for the amendments which may be filed in reply to the WO-IPEA. However, a WO-IPEA whose only content would be a request to indicate the basis for such amendments will not be sent; instead, the IPER is established directly.

Chapter II – Allowability of amendments

1. Introduction

Once the EPO as IPEA has concluded that the amendments can be taken into consideration (see GL/PCT-EPO H-I), all amended pages (description, claims, drawings) must be examined to see whether they introduce subject-matter not originally disclosed. The examiner should apply the criteria used under Art. 123(2) EPC for the European procedure *mutatis mutandis*, as indicated below. It is important to note that an amendment which is taken into consideration by the EPO as IPEA is not automatically allowable.

GL/ISPE 20.09

With regard to establishing the WO-IPEA or IPER if any newly filed claim, drawing or part of the description contains amendments which are considered to go beyond the disclosure as originally filed, see GL/PCT-EPO C-III, 4.

2. Allowability of amendments

2.1 Basic principle

The examiner should apply the guidelines of section H-IV, 2.1, in the Guidelines for Examination in the EPO *mutatis mutandis*.

GL/ISPE 20.12

2.2 Content of the application as "originally" filed – general rules

The examiner should apply the guidelines of section H-IV, 2.2, in the Guidelines for Examination in the EPO *mutatis mutandis*.

2.2.1 Features described in a document cross-referenced in the description

The examiner should apply the guidelines of section H-IV, 2.2.1, in the Guidelines for Examination in the EPO *mutatis mutandis*.

2.2.2 Incorporating missing or correct parts or elements completely contained in the priority document

If the applicant files (a) missing or correct part(s) (i.e. part(s) of the description, part(s) of the claims and/or part(s) or all of the drawings) and/or (a) missing or correct element(s) (i.e. all of the description and/or all of the claims), the filing date of the application as a whole will be the date on which the part(s) and/or the element(s) was (were) subsequently furnished, unless the RO accepted the incorporation by reference of the missing or correct part(s) and/or element(s).

Rule 20.3

Rule 20.5

Rule 20.5bis

Rule 20.7

OJ EPO 2020, A81

An applicant therefore has the possibility to furnish parts of the application and/or entire elements which were erroneously omitted without affecting the international filing date by requesting their incorporation by reference to the priority document (see GL/PCT-EPO A-II, 5).

Rule 4.18

Rule 20.6

Rule 19.4(a)(iii)
Rule 20.5bis(a)(ii)
Rule 20.8(a-bis)
PCT Gazette
30.01.2020, 11-12

Similarly, an applicant therefore also has the possibility to request the correction of erroneously filed parts of the application and/or entire elements without affecting the international filing date by requesting their incorporation by reference to the priority document. This latter possibility is, however, not available before all ROs. In particular, the EPO acting as RO had notified the IB of the incompatibility of Rule 20.5bis(a)(ii) and Rule 20.5bis(d) with the legal framework under the EPC; see GL/PCT-EPO A-II, 6. However, following the withdrawal of this notification of incompatibility with effect from 1 November 2022, the EPO as RO may now also process requests for incorporation by reference of the correct element or part for international applications filed on or after 1 November 2022. See GL/PCT-EPO A-II, 6.2.

The activity of the EPO as ISA and IPEA depends on the decisions taken by the RO with regard to the international application and its filing date (see GL/PCT-EPO B-III, 2.3.3 and GL/PCT-EPO B-III, 2.3.4, and GL/PCT-EPO B-XI, 2.1).

Rule 4.18
Rule 20.3
Rule 20.5
Rule 20.5bis
Rule 20.7

A request for incorporation by reference can only be filed before the RO within two months of the date of receipt of the purported international application (or at the invitation of the RO) provided that the priority claim was present at that initial date of receipt and only if the applicant can show that the missing or correct part(s) and/or element(s) was (were) completely contained in the priority document. Missing or correct parts and/or elements which have been accepted under this criterion are considered to be part of the application documents "as originally filed" (see GL/PCT-EPO B-III, 2.3.4 and GL/PCT-EPO B-XI, 2.1).

Rule 20.5(e)
Rule 20.5bis(e)

If the RO finds that the "completely contained" criterion is not met, the filing date of the application will be the date on which the part(s) and/or the element(s) was (were) subsequently furnished (unless, in the case of missing parts or of correct elements and/or parts, the applicant withdraws the subsequently furnished elements and/or parts). Where the EPO is (S)ISA or IPEA, the examiner must check (as far as the documents needed are available) whether the RO's assessment of the "completely contained" criterion was correct.

See also GL/PCT-EPO A-II, 5.

2.2.2.1 Test for "completely contained"

Rule 20.5(a)(ii)
Rule 20.5(d)
Rule 20.5bis(a)(ii)
Rule 20.5bis(d)

The test for "completely contained" is stricter than the test for added subject-matter since it is a test whether the subsequently filed missing or correct part(s) and/or element(s) was (were) identical to the corresponding extract in the priority document, or a translation thereof.

OJ EPO 2020, A81
GL/RO 205D
GL/ISPE 15.11

Although the RO is responsible for the decision on whether the missing or correct part(s) and/or element(s) was (were) completely contained in the priority document, the examiner must check (as far as the documents needed are available) that the decision taken was correct.

If the EPO is the RO, the examiner is only required to check for additional technical content. This entails ensuring that the missing text has been

inserted into the application in such a position that it has exactly the same meaning as it had in the priority document.

If the EPO is not the RO, the identity of drawings and the word-for-word identity of (parts of) the description/claim(s) must also be checked by the examiner (unless the documents needed are not available at this stage).

2.2.2.2 Review by the examiner

If the missing or correct part(s) and/or element(s) was (were) indeed completely contained in the priority document, the examiner will treat the file as having the filing date accorded by the RO. The examiner will proceed in the same way where unable to check whether the missing or correct part(s) and/or element(s) was (were) indeed completely contained in the priority document because, at the time of the search or the preliminary examination, the priority document(s) or any other document needed (i.e. the subsequently filed sheet(s) embodying the missing or correct part(s)/element(s) or the translation of the priority document) is (are) not available to the ISA or IPEA. If the documents needed for the check are not available, this will be indicated in the WO-ISA/IPER, in Section I of the separate sheet.

Rule 20.5(a)(ii)
Rule 20.5(d)
Rule 20.5bis(a)(ii)
Rule 20.5bis(d)
OJ EPO 2020, A81
GL/ISPE 15.11

If the missing or correct part(s) and/or element(s) was (were) not completely contained in the priority document, the decision on the filing date made by the RO is still valid for the international phase. However, the examiner will indicate in the WO-ISA/IPER in Section I of the separate sheet that there are doubts as to whether the missing or correct part(s) and/or element(s) was (were) actually completely contained in the priority document. The search report and the WO-ISA or the IPER, as applicable, will also include documents which would be relevant if the application were to be redated (see GL/PCT-EPO B-III, 2.3.3).

A review of the decision by the RO can only take place in the regional phase (Rule 82ter.1(b)).

After entry into the regional phase before the EPO (Euro-PCT phase) the applicant can withdraw the subsequently filed missing or correct parts and/or correct elements in order to avoid the redating of the application. In this case, it should be noted that amendments which are acceptable under the less strict criterion of Art. 123(2) EPC can always be filed during the Euro-PCT phase.

Rule 82ter.1(d)

2.2.3 Sequence listings filed after the date of filing

Any sequence listing not contained in the international application as filed will – if not allowable as an amendment under Article 34 – not form part of the international application.

Rule 13ter.1(c)

See GL/PCT-EPO B-VIII, 3.2, for the effect on the search and GL/PCT-EPO B-XI, 7, for the effect on the WO-ISA. For the effect on examination in Chapter II, see GL/PCT-EPO C-VIII, 2.1.

2.2.4 Priority documents

It is not permissible to add to an international application matter present only in the priority document for that application, unless this is done under the provisions of Rule 20.6 (GL/PCT-EPO H-II, 2.2.2). For correction of errors, see GL/PCT-EPO H-IV.

2.2.5 Citation of prior art in the description after the filing date*GL/ISPE 20.10*

The examiner should apply the guidelines of section H-IV, 2.2.7, in the Guidelines for Examination in the EPO *mutatis mutandis*.

2.2.6 Clarification of inconsistencies*GL/ISPE 20.10*

The examiner should apply the guidelines of section H-IV, 2.2.8, in the Guidelines for Examination in the EPO *mutatis mutandis*.

2.2.7 Trademarks

The examiner should apply the guidelines of section H-IV, 2.2.9, in the Guidelines for Examination in the EPO *mutatis mutandis*.

~~**2.3 Assessment of "added subject-matter" – examples**~~*GL/ISPE 20.13*~~The examiner should apply the guidelines of section H-IV, 2.4, in the Guidelines for Examination in the EPO *mutatis mutandis*.~~**3. Compliance of amendments with other PCT requirements***GL/ISPE 20.09*

The examiner should apply the guidelines of section H-IV, 5.2, in the Guidelines for Examination in the EPO *mutatis mutandis*.

Chapter III – Allowability of amendments – examples

1. Introduction

This Chapter provides additional guidance and examples relating to a number of typical situations where compliance with Art. 19(2) and/or Art. 34(2)(b) is an issue. However, it must be borne in mind that the allowability of a specific amendment is ultimately to be decided on a case-by-case basis.

2. Amendments in the description

2.1 Clarification of a technical effect

The examiner should apply the guidelines of section H-V, 2.1, in the Guidelines for Examination in the EPO *mutatis mutandis*. GL/ISPE 20.15

2.2 Introduction of further examples and new effects

The examiner should apply the guidelines of section H-V, 2.2, in the Guidelines for Examination in the EPO *mutatis mutandis*. GL/ISPE 20.16-
GL/ISPE 20.17

2.3 Revision of stated technical problem

The examiner should apply the guidelines of section H-V, 2.4, in the Guidelines for Examination in the EPO *mutatis mutandis*. GL/ISPE 20.18

2.4 Reference document

The examiner should apply the guidelines of section H-V, 2.5, in the Guidelines for Examination in the EPO *mutatis mutandis*.

2.5 Alteration, excision or addition of text in the description

The examiner should apply the guidelines of section H-V, 2.6, in the Guidelines for Examination in the EPO *mutatis mutandis*. GL/ISPE 20.19

3. Amendments in claims

3.1 Replacement or removal of a feature from a claim

The examiner should apply the guidelines of section H-V, 3.1, in the Guidelines for Examination in the EPO *mutatis mutandis*.

3.2 Inclusion of additional features

The examiner should apply the guidelines of section H-V, 3.2, in the Guidelines for Examination in the EPO *mutatis mutandis*.

3.2.1 Intermediate generalisations

The examiner should apply the guidelines of section H-V, 3.2.1, in the Guidelines for Examination in the EPO *mutatis mutandis*.

3.3 Deletion of part of the claimed subject-matter

The examiner should apply the guidelines of section H-V, 3.3, in the Guidelines for Examination in the EPO *mutatis mutandis*.

3.4 Further cases of broadening of claims

The examiner should apply the guidelines of section H-V, 3.4, in the Guidelines for Examination in the EPO *mutatis mutandis*.

3.5 Disclaimer disclosed in the application as originally filed

The examiner should apply the guidelines of section H-V, 4.1, in the Guidelines for Examination in the EPO *mutatis mutandis*.

GL/ISPE 20.21

4. Disclaimers not disclosed in the application as originally filed

4.1 The subject-matter to be excluded is not disclosed in the application as originally filed (so-called undisclosed disclaimers)

The examiner should apply the guidelines of section H-V, 4.2.1, in the Guidelines for Examination in the EPO *mutatis mutandis*.

The EPO applies option A20.21[2] of the Appendix to Chapter 20 of the ISPE Guidelines.

4.2 The subject-matter to be excluded is disclosed in the application as originally filed

The examiner should apply the guidelines of section H-V, 4.2.2, in the Guidelines for Examination in the EPO *mutatis mutandis*.

5. Amendments to drawings

It is normally not possible under Art. 34(2)(b) to add completely new drawings to an application, since in most cases a new drawing cannot be unambiguously derivable from the mere text of the description. For the same reasons amendments to drawings should be carefully checked for compliance with Art. 34(2)(b).

For drawings based on the priority document, see GL/PCT-EPO H-II, 2.2.2 and subsections.

6. Amendments derived from drawings

The examiner should apply the guidelines of section H-V, 6, in the Guidelines for Examination in the EPO *mutatis mutandis*.

7. Amendments to the title

The sole purpose of the title is to inform the public about the technical information disclosed in the application. The examiner does not need the applicant's approval to compose or amend the title.

Rule 5.1, 37

GL/ISPE 16.35-16.38

Under Rule 5.1, the title is considered to be a part of the description. Under Rule 37.2, in the absence of a title, or when the title does not comply with Rule 4.3 (i.e. it is too long or not precise enough), the search examiner can compose a title or amend the existing one. On the basis of these two rules taken in conjunction, the EPO as ISA may accept amendments of the title proposed by the applicant, provided that any such amendments do not go beyond the disclosure in the international application as filed.

Moreover, the title can be amended before the EPO as IPEA under Art. 34, *Art. 34*
like any other part of the description.

Chapter IV – Correction of defects and errors

1. Substitute sheets (Rule 26)

If the RO finds defects under Art. 14(1)(a), it invites the applicant to correct them by submitting replacement sheets which will be stamped "SUBSTITUTE SHEET (RULE 26)", and these will retain the original filing date if submitted within the set time limit.

Art. 14
Rule 26
PCT AI Section 325

2. Request for rectification of obvious mistakes in the application documents (Rule 91)

2.1 Introduction

An applicant can request authorisation to rectify obvious mistakes in the international application. Rectification is authorised on condition that:

Rule 91.1(a),
Rule 91.1(c)
GL/ISPE 8.01

- (i) the mistake is obvious to the skilled person, i.e. that something else was intended than what appears in the document concerned, and
- (ii) the rectification is obvious to the skilled person, i.e. that nothing else could have been intended than the proposed correction.

The applicant may submit a request for rectification of an obvious mistake in the description, claims and drawings (not the abstract) of the international application (including amended documents) to the ISA or the IPEA, which is the competent body to authorise or refuse such rectification. If the obvious mistake is related to the request form (PCT/RO/101), it is the RO which authorises or refuses the rectification.

Rule 91.1(b)(ii)
Rule 91.1(b)(iii)

2.2 Authorisation or refusal of the request for rectification of obvious mistakes in the application documents

In order to determine whether the request for rectification of obvious mistakes can be authorised, the examiner should check that the time limit for requesting rectification has not expired. The request for rectification can only be considered if it is filed with the competent authority within 26 months from the priority date.

Rule 91.2

If the request is too late, it is refused on that ground.

If the request is in time, the examiner must check whether the requested rectifications satisfy the above criteria (i) and (ii) (see GL/PCT-EPO H-IV, 2.1).

- If one or both of the criteria (i) and (ii) are not satisfied, the examiner will not authorise the request and will indicate the reasons.
- If the request is authorised, no reasons need to be given. The fact that a rectification of an obvious mistake has been taken into account will be indicated in the WO-ISA, WO-IPEA (Form 408) or IPER (Form 409) under Section I.

- If the request is authorised only in part, the examiner indicates which rectifications are not allowable, together with the reasons, and which rectifications are allowable. The fact that a rectification of an obvious mistake has been taken into account (in part) will also be indicated in the WO-ISA, WO-IPEA (Form 408) or IPER (Form 409) under Section I.

Rule 91.1
GL/ISPE 17.16
PCT AI Section 607

Authorised replacement pages or sheets for rectification of obvious mistakes under Rule 91 are deemed to be part of the international application "as originally filed". These sheets are identified with "**RECTIFIED SHEET (RULE 91.1)**".

Rule 91.3(d)

If authorisation of a request for rectification is refused, the applicant may request the IB in writing, within two months of the refusal, to publish the refused request together with the reasons for refusal, subject to payment of a special fee.

2.3 Allowability of rectifications

The examiner will apply the same criteria in assessing the substantive allowability of proposed rectifications according to Rule 91.1 as for European applications according to Rule 139 EPC (see GL/EPO H-VI, 2.2.1).

2.4 Examples

The examiner should apply the guidelines of section H-VI, 2.2.1, in the Guidelines for Examination in the EPO *mutatis mutandis*.