

Claim amendments during the international patent application procedure

International patent applications under the Patent Cooperation Treaty (PCT) provide a single international procedure for searching and examining an invention in a single language.

Since inception of the PCT in 1978, the number of international patent applications filed has risen year-on-year and new states join the PCT system typically at the rate of one or two per year. As of November 2017, there were 152 individual PCT contracting states which includes all of the major industrialised nations of the world.

PCT search and examination system

Much like any other national patent system, the international patent system involves a search of the invention to find prior art documents published before the invention, and an examination procedure to examine the claimed invention against the internationally recognised common criteria of novelty, inventive step and industrial applicability.

Unlike national patent offices, the World Intellectual Property Organisation (WIPO) which administers international patent applications under the PCT, does not actually grant patents at the end of the international search and examination procedure. Instead, WIPO produces an international preliminary report on patentability (IPRP) which the national patent offices then use as the basis of their national examination procedure, after the international phase. It is the national patent offices which grant the patents.

Two different options for the international examination procedure

There are two options for the international procedure:

- **Chapter I** which involves a search and a written opinion being issued by the International search authority (ISA). At the end of the Chapter I procedure the ISA issues an International Preliminary Report on Patentability Chapter I (IPRP Chapter I) which sets out the ISA's assessment of the novelty, inventive step and industrial applicability of the invention as claimed;
- **Chapter II** which involves an additional round of examination by the International Preliminary Examining Authority (IPEA) at the end of which the IPEA issues an International Preliminary Report on Patentability Chapter II (IPRP Chapter II) which sets out the IPEA's assessment of the novelty, inventive step and industrial applicability of the invention as claimed.

The duration of the international phase is the same, whether the applicant opts for Chapter I or Chapter II procedure.

The International Search Report

The basic criteria for obtaining valid granted patent protection in most countries is that the invention as claimed has novelty over prior art material, and involves an inventive step. Industrial applicability is almost always present.

The purpose of the International Search Report is to find the closest prior art documents which are relevant to the invention as claimed, so that the International Preliminary Report on Patentability, and any written opinions which precede the final IPRP, can be drawn up having regard to the closest prior art documents available.

Written opinion of the International Search Authority (ISA)

Under Chapter I procedure, the International Searching Authority give their written opinion on the novelty, inventive step and industrial applicability of the invention as claimed. This report is drawn up by an international search examiner. These are the three criteria which national or regional patent offices use in determining whether to grant national/regional patents after the international procedure.

If the applicant subsequently demands Chapter II procedure after the search, the written opinion of the International Searching Authority is automatically regarded as being the written opinion of the International Preliminary Examining Authority IPEA.

Chapter I examination

There is a single opportunity to make amendments to the claims within the deadline given in the first written opinion. The deadline for making amendments to the claims under Chapter I procedure is the later of 2 months from the date of transmittal of the International Search Report to the applicant, or 16 months from the earliest priority date. Extensions of time are not available.

After the issue of the first written opinion, the International Search Authority will issue an International Preliminary Report on Patentability (IPRP) Chapter I, which will include their opinion on the novelty, inventive step and industrial applicability of the invention as claimed in the international application.

Individual national/regional patent offices are not bound to accept the report of the International Searching Authority and are at liberty to perform further searching and examination, and in most cases do so. However, a favourable final IPRP based on the international search is persuasive in many cases in subsequent examination procedure before the national/regional patent offices, and in any case provides a level of pre-examination before the national phase examination.

Chapter II examination

There is the option but not the obligation to demand Chapter II procedure. Chapter II procedure allows one further additional opportunity to amend claims in the international phase, and allows the opportunity to submit written arguments concerning novelty and inventive step and to amend the description and drawings.

Where Chapter II examination is requested, at the end of the international procedure the international preliminary examining authority (IPEA) will issue an international preliminary report on patentability Chapter II (IPRP Chapter II), which comments on the novelty and inventive step of the claims as amended during the Chapter II procedure.

As with the Chapter I procedure, national or regional patent offices are not bound to accept the result of the IPRP Chapter II and in many cases will continue with their own examination procedure in any case. However a favourable IPRP Chapter II is good preparation for the subsequent national or regional phase examination after the international stage.

Procedural opportunities for claim amendments

Using the international procedure, the full opportunities to amend the claims after filing are:

- In the international phase Chapter I procedure there is a single opportunity to amend claims without making observations on novelty or inventive step; and
- In the international phase, if the optional Chapter II procedure is demanded, there is a further opportunity to amend claims. There is also an opportunity to amend the description and drawings and to submit observations on novelty and inventive step; and
- At the end of the international phase there is an opportunity to submit amendments to the claims before entering the national regional phases, but in most cases without submitting further observations on novelty and inventive step; and
- In each national or regional prosecution phase there are usually at least 2 further opportunities to submit amendments to the claims and to submit observations concerning novelty and inventive step, and in some cases to make amendments to the description and drawings provided these do not result in added matter.

Following either the Chapter I procedure or the Chapter II procedure, the duration of the international phase remains the same.

National/Regional Phase Entry

At the end of the international phase, the rights are continued as one or more national or regional patent applications. The international patent application is equivalent to a national or regional patent for each of the designated contracting parties. All deadlines set by the national or regional patent offices are suspended during the international phase, which means that on entering the national or regional phase procedure after the international procedure, all national/regional patent office search and examination fees are due at once, and the national search and examination can start straight away, subject to workload backlogs and delays in the individual national or regional patent offices.

On entry into the national or regional phases, in general further amendment to the claims can be made before the national or regional examination commences.

Summary

The international patent application procedure allows for a centralised search, examination and amendment of a single patent application in a single language covering many states.

Amendment of the claims in the international phase may subsequently result in fewer objections to the patentability of the invention being raised during examination in the subsequent national and regional patent applications procedures at the end of the international phase.

However, if amendments to the claims are not made during the international phase there is still ample opportunity to amend the claims at the transition between the international phase and the national and regional phases, and subsequently during the national and regional patent application procedures themselves.

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