

Section 19: General power to amend application before grant

19.01 Provisions relevant to this subject are laid down in rr.35 and 36.

Section 19(1)

At any time before a patent is granted in pursuance of an application the applicant may, in accordance with the prescribed conditions and subject to section 76 below, amend the application of his own volition.

r.100
s.25(1) 19.02 To be effective a request to amend must be received before the issue of the letter informing the applicant that a patent has been granted (see 18.86). If it is received before that date but too late to prevent issue of the letter the grant may be rescinded; the request should then be considered as described in paragraphs 19.20-19.22. If the request is received on or after that date it is too late to amend the application; amendment of the specification of the patent may be sought after the date of publication of the notice of grant in the Journal (see 27.04). It is additionally necessary for the request to be received while the application is still in being; an application apparently cannot be amended after it has been treated as withdrawn through failure to meet a formal requirement (eg to file Form 9/77) or otherwise terminated, even if allowance of the amendment would allegedly have the effect of avoiding termination (eg by relinquishing a claim to priority, see 19.11, and thus apparently giving more time for Form 9/77 to be filed). This is because amendment takes effect *ex nunc* as explained in 19.04 and, in addition, it appears that the general power to amend under s.19 cannot be used to circumvent the specific requirements of other sections of the Act (cf *Payne's Application* [1985] RPC 193, see 117.10).

Amendments and corrections

B 19.03 Although the ordinary dictionary definitions of these words overlap, and the terms may often be employed interchangeably in normal parlance, they are used in the Act and Rules in quite distinct and specific senses, and it is convenient at this point to discuss in general terms the difference between them. Correction is the alteration of a document so that it may better express the intention the drafter had at the time of drafting, including the case where an agent drafting a document has misconstrued his instructions. If the alteration is sought because the drafter has become aware of new facts, or because circumstances have since changed, or because he has changed his mind, then this is not correction but amendment.

r.91(2)
ss.27(3),
75(3) 19.04 Correction of an application or the specification of a patent or of any document filed in connection therewith is governed by s.117, and takes effect *ex tunc*, that is, the document is deemed always to have been in the state in which it is after the correction. If the correction sought is in a specification then it is necessary to show that it may properly be dealt with as a correction, but once this is established there is no impediment to the making of the correction; in particular the question of whether subject-matter is added by the alteration does not arise. In contrast, amendment of an application or of the specification of a patent must comply with the requirements of s.76(2) or (3), (see 76.04-22). Amendment of an application is governed by s.19 and takes effect *ex nunc*, that is, from the time the amendment is made; amendment of the specification of a patent is carried out under s.27 (or under s.75 if done while there are pending proceedings in which the validity of the patent may be put in issue) and is deemed to have had effect from the date of grant.

AMENDMENT OF THE REQUEST FOR GRANT

r.35 19.05 An application to amend the request for grant (Patents Form 1/77) must (except as stated below) be made on Form 11/77. This may be filed at any time before the applicant is sent the letter informing him that a patent has been granted (see 18.86), but must be received before preparations for publishing the application under s.16 have been completed if the change is to be included in the printed application. In such a case the printed application will carry a notice to the effect that the print reflects an amendment to the request for grant effected under r.35. It is not necessary to use a form in order to advise the Office of a change of a person's address or address for service: any written request by that person is acted on, see 32.06.

r.45(3)

B 19.06 A request to amend the name of an applicant on Form 11/77 or, if only a name requires alteration, on Form 20/77 (see 32.06) must be supported by evidence. In the case of a corporate body

r.113(1)

this should be in the form of a document from the appropriate companies registration authority as (for the UK) a certificate from Companies House, or (for the USA) a State Certificate, or (for West Germany) an extract from the Handelsregister. For France or Belgium a copy of the gazette or commercial paper in which the change of name was advertised should be supplied. Whenever the evidence is in a foreign language it should be accompanied by a verified translation. In the case of a natural person whose name has been changed, eg by Deed Poll, it is sufficient to give particulars of the issue of the gazette or newspaper in which the change has been advertised.

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19.07 If a request to amend the applicants' name is allowed, the change will be effected on all Forms 1/77, 7/77, 9/77 or 10/77 present, and also in the Register. Any change in the applicant's address or the address for service will be effected on Form 1/77 and also in the Register. If the request to amend is received in time the amendments will be included in the printed application (see 19.05).

19.08 If the change in name or address had taken place at the time the application for a patent was filed (so that Form 1/77 was incorrect at the time it was filed), then alteration of it is not amendment but correction and must be effected under s.117 (see 117.17).

19.09 Provided that Form 7/77 has not yet been filed, the addition or deletion of an applicant or the substitution of one applicant for another, for example because of assignment of the application or the death of an applicant, may be effected by a request on Form 11/77. (This may also necessitate an amendment of Part 7 of Form 1/77 (see 14.20-14.21)). Reasons for making the amendment should be given on the form. Supporting evidence (or sworn statement(s) indicating the consent of the party or parties affected by the change) is required and the statements made on a subsequent Form 7/77 must be consistent with the amendments made and the reasons given. If however Form 7/77 has already been filed, any assignment of the application must be effected under s.30.

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19.10 No action should be taken before substantive examination in respect of a request to amend the title of the invention on Form 1/77.

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r.6(1)

19.11 If the application includes a declaration of priority (see 14.19) or claims an earlier date of filing (see 14.18) either of these may be relinquished by a request to amend Part 6 or Part 5 of Form 1/77. (It should be remembered that abandonment of the claim to an earlier filing date may necessitate relinquishment of a claim to priority). Form 11/77 is not required if the proposed amendment arises as a consequence of an objection made under s.18(3), whether to meet that objection or in anticipation of a further objection which would arise as a result of the action taken, for example where a declaration of priority is deleted consequent on division following an objection of plurality of invention. In all other cases, including when a request is made to relinquish divisional status following a preliminary objection (see 15.34-15.35), the request to amend Form 1/77 should be made on Form 11/77. It is not possible to amend Form 1/77 to add a declaration of priority or to convert an independent application into a divisional application (*P's Application*, [1983] RPC 269).

19.12 The applicant must always be informed whether or not an application to amend the request for grant has been allowed.

AMENDMENT OF THE SPECIFICATION OF AN APPLICATION

s.18(3)

r.36(2)

s.76(2)

19.13 In addition to having the right to amend the specification in order to overcome an Official objection, the applicant may make amendments for reasons of his own. Such voluntary amendments may however only be made as provided for by r.36(3)-(5), (see 19.14-19.16; 19.20). No amendment is allowable which results in the application disclosing any matter which extends beyond that disclosed in the application as filed (see 76.03-76.17). (For the procedure for effecting amendments, see 18.61-18.62).

Before issue of the search report

r.36(1)

19.14 The applicant may not (unless required to do so by the comptroller) amend the specification before being informed of the examiner's report under s.17(5). If therefore amendments are received in the Office after the filing date (for amendments received on the filing date, see 16.10-16.13), but before the search report (including a report that search would serve no useful purpose) has issued, they are retained on the file and are deemed to have been effected on the date of issue of the search report (see

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117.11 A request to correct an error in the specification of a European patent (UK) should be dealt with in the same way as in the case of a patent granted under the Act, provided that the period of nine months allowed for opposing the patent has expired and that there is no opposition outstanding. If it is not possible to determine the allowability of the correction solely by reference to the published specification, the applicant should be required to furnish the necessary documentary evidence, for example copies of any relevant documents indicating the "as filed" state of the application. A request to correct a translation of the specification of a European patent (UK) filed under s.77(6)(a) should be dealt with similarly. However, an additional consideration is whether the correction requested properly comes under s.117 or s.80(3). If the correction would seem to broaden the protection conferred by the translation, it should be made under s.80(3) in accordance with the procedure in 80.03-06, for which purpose a fresh application on Form 57/77 is necessary. Correction of the translation will not be appropriate where the error lies in the specification of the European patent (UK) but the translation is nevertheless a correct representation of the incorrect text. In such cases a request should be made to correct the specification. If this necessitates a fresh translation then the fresh translation should be filed pursuant to r.113(1).

r.106

Procedure before publication (See also 117.06)

117.12 If no Form 47/77 has accompanied a request to correct, the examiner should ask that the form be filed. A reasonable period for doing this should be specified, although an application should not be retained on this account for long after it is due to be sent for publication (see 16.23 and 16.31).

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117.13 If an examiner notices a clerical error which would be likely to impede the understanding of a specification when published he should inform the applicant or agent. However, the initiation of a correction is a matter for the applicant, and if he does not respond the matter should be deferred until substantive examination. Publication should not be unduly delayed. Purely formal editorial matters, such as the re-arrangement and re-numbering of accidentally transposed pages, may be effected by the examiner with the applicant's or agent's agreement (and without the need for Form 47/77), provided that the nature of the error and its correction are beyond reasonable doubt.

Procedure after grant

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117.14 The examiner to whom the request is referred must consider it according to the tests set out in paragraphs 117.07 to 117.09. He must also consider whether it is necessary to advertise the correction (see 117.23-117.24).

117.15 If a request to correct is received after the issue of the letter informing the applicant that a patent has been granted but before the date of publication of the patent, the applicant should be informed that consideration of the request is deferred until after publication.

117.16 If proceedings to correct a patent are initiated or are outstanding whilst an action for revocation of the patent is pending the comptroller may decide whether the s.117 proceedings are to be stayed or resolved.

CORRECTION OF THE REQUEST FOR GRANT

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r.45(3)

117.17 If the applicant's name was given incorrectly on Form 1/77 then it may be corrected by a request on Form 47/77; a correction (or any other change) in respect of the applicant's address or the address for service may be made by means of any suitable written notification. If, however, the name was correct at the time of filing and has changed subsequently then alteration of the form to reflect this is not correction but amendment and must be effected under s.19 (see 19.05-19.07). A request to correct the name of an applicant must be supported by evidence of the same kind needed in support of amendment of the name (see 19.06). If a request to correct a name is allowed the change is effected in the same way as in the case of an amendment (see 19.07).

117.18 A request to correct the title of the invention should be considered in the same way as a proposed correction of the specification (see 117.07-117.09).