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2016 – Study Question (Patents)

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Added matter: the standard for determining adequate support for amendments

Responsible Reporter: Ari LAAKKONEN

National/Regional Group

Argentina

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I. Current law and practice

You are reminded that a reference to patent in the following questions refers to both a granted patent and an application for a patent.

If your answer differs depending on the distinction between a granted patent and an application for a patent, please answer the questions for each, as applicable.

1) Under your Group's current law, are amendments to the description and/or figures of a patent possible?

Yes.

2) Under your Group's current law, are amendments to the claims of a patent possible?

Yes.

3) Further to your answers to questions 1) and 2), please indicate:

a) the standard for determining whether such amendments are permissible and indicate whether this standard exists in statutes, regulations, patent office guidelines, and/or in case law.

Section 19 of the Regulating Decree No. 260/96 (to the Argentine Patent Law No. 24,481) states:

“As from the date of filing of the patent application and for NINETY (90) days afterwards, applicant may add supplements, corrections, and amendments, provided that they do not imply an extension of the object thereof. After said term, only the elimination of deficiencies found by the examiner shall be

authorized. The new embodiments that might be added shall be complementary for a better understanding of the invention. No right can derive from supplements, corrections or amendments which imply an extension of the original application.”

In practice, the Argentine PTO accepts amendments to the claims at any time during prosecution.

It should also be borne in mind that a decision in re Pfizer (2012) allowed amendments, during prosecution, to the claims and specification as long as they are obvious to the subject matter originally disclosed.

b) whether there are the differences between the substantive standards for amendments under 1) and 2) above. If so, what?

Yes. The provisions for amending the description and drawings are more restrictive than those related to claims.

4) To the extent your answer to question 3) depends on timing (e.g. after filing but before examination, after allowance but before grant, and after grant), please explain how the standard changes and during which time periods.

N/A

5) Further to your answer to question 3), if impermissible added matter is a ground for refusing an amendment, please explain how impermissible added matter is defined.

According to section 19 of Regulatory Decree No. 260/96, impermissible added matter is that which extends the scope of the subject matter.

6) In any assessment of impermissible added matter under your Group's current law, please explain:

a) how the patent application as filed is interpreted;

By persons of ordinary skill in the art and available common knowledge.

b) if interpreted as the notional skilled person would understand the patent application as filed, what is the relevant date of knowledge of the notional skilled person?

Date of filing the application or, if pertinent, the priority date.

7) If an amendment that was made to a patent application prior to grant is later reviewed by your patent office or a court in a post-grant proceeding and determined to contain impermissible added matter, is there a mechanism for the patentee to remedy the defect, for example by removing portions of the amendment found to be impermissible?

no

Please explain:

There are no provisions on this respect. It should also be borne in mind that there is no post-grant

procedure in Argentina. Thus, should an amendment were found to be illegal, then the claim or the patent would be revoked.

II. Policy considerations and possible improvements to your current law

- 8) How does your Group's current law strike a balance between allowing a patent applicant to make appropriate amendments during the examination process and preventing the applicant from adding impermissible matter?

An amendment is deemed appropriate if the overall disclosure as changed is derivable from the application as filed (including matter in priority documents) by persons of ordinary skill in the art.

- 9) Are there aspects of these laws that could be improved?

yes

Please explain:

Yes, we consider that it would be advisable to expressly state that amendments to both the specification and claims are permissible as long as they do not include new non-obvious matter.

- 10) Does your Group's current law allow amendments post grant? If so, how does your Group's current law strike a balance between allowing a patentee to make appropriate amendments to a granted patent (such as amendments necessary to sustain its validity) and preventing the patentee adding impermissible matter?

No.

- 11) Are there aspects of these laws that could be improved?

yes

Please explain:

Yes, we consider that it would be advisable to expressly state that amendments to the specification and claims are permissible as long as they do not include new non-obvious matter.

- 12) If your Group's current law uses, at least in part, the notional person skilled in the art to determine the permissibility of amendments, is this approach effective? Are there aspects of this that could be improved?

We know of no substantial problems heretofore with this approach.

III. Proposals for harmonisation

- 13) Is harmonisation of the definition of impermissible added matter desirable?

If yes, please respond to the following questions without regard to your Group's current law. Even if no, please address the following questions to the extent your Group considers your Group's laws could be improved.

yes

Please explain:

14) If yes, please propose a definition of impermissible added matter that you believe is appropriate.

Subject-matter non-obvious from the original specification or claims.

15) Should this definition depend on when an amendment is made (for example, after filing but before examination, after allowance but before grant, and after grant)?

no

Please explain:

16) Should rules against impermissible added matter prohibit the addition of claims per se, as opposed to adding limitations to claims?

No.

17) Should rules against impermissible added matter prohibit the removal of claims per se, as opposed to removing limitations from claims?

no

Please explain:

18) Should the definition of impermissible added matter be the same when applied by a patent office as when applied by a court?

yes

Please explain:

19) If your proposed definition refers to the notional skilled person, what should be the relevant date of knowledge for the notional skilled person in evaluating the permissibility of an amendment?

Date of filing the application or, if pertinent, the priority date.

20) If the deletion of impermissible added matter by amendment would result in an impermissible extension of scope, how should the impermissible added matter defect be remedied in these circumstances?

The examiner should reject the amendment via an official action. Applicant may comply deleting or else amending the added matter to comply with the examiner's grounds, or may traverse the latter, for the examiner to reconsider.

21) Please comment on any additional issues concerning any aspect of impermissible added matter you consider relevant to this Study Question.

Please indicate which industry sector views are included in part **“III. Proposals for harmonization”** of this form:

No discrimination of any industry sector.

Summary