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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

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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. However, limitations apply after grant of the patent.

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.

The standard that exists in the statutes provides that any amendment is permissible that does not extend the subject-matter of the patent beyond the content of the application as filed.

The case law (OLG 34R86/14p "Lochski") specifies that the content of the application as filed comprises the literal disclosure of the patent application, supplemented with all matter that can be directly and unambiguously derived from the patent application as filed.

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

No.

- 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.

An additional requirement is imposed on amendments performed after grant: the patent may not be amended in such a way as to extend the protection it confers.

- 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.

The case law (OLG 34R86/14p “Lochski”) specifies that any amendment is considered impermissible that extends the subject-matter of the patent beyond what can be directly and unambiguously derived from the patent application as filed.

- 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;

The patent application is interpreted as the notional skilled person would understand the patent application as filed.

- 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?

The relevant date of knowledge of the notional skilled person is the priority date of the application.

- 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?

yes

Please explain:

Yes, the defect may be remedied, if such remedy is feasible without extending the scope of protection that the granted patent confers.

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?

The balance between patentee's interest in making amendments and the public's interest in legal certainty is safeguarded by requiring that an amendment is only permissible, if it does not extend the subject-matter of the patent beyond the content of the application as filed.

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

no

Please explain:

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?

Yes, post grant amendments are allowed.

The standard for the amendments to be permissible post grant is the same as for amendments before grant: any amendment is permissible that does not extend the subject-matter of the patent beyond the content of the application as filed. The balance between patentee's interest in sustaining validity and the public's interest in legal certainty is safeguarded by additionally requiring that the patent may not be amended after grant in such a way as to extend the protection it confers.

A post-grant amendment may be obtained by filing a request for partial renunciation with the Patent Office according to para 46(2) of the Patent Act. The partial renunciation is effective ex nunc. There is no ex-parte procedure in place for obtaining an amendment that is effective ex tunc.

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

yes

Please explain:

It would be desirable for the patentee to have ex-parte proceedings in place for requesting a limitation of the patent with effect ex tunc.

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?

Yes, it appears effective.

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.

Any amendment should be considered impermissible that extends the subject-matter of the patent beyond what can be directly and unambiguously derived from the patent application as filed. The patent application should be interpreted as the notional skilled person would understand the patent application as filed.

- 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?

The relevant date should be the priority date of the patent.

- 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?

No remedy should be possible in such a case.

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:

Summary

Amendments to patent applications and granted patents should generally be allowed.

The standard for the amendments to be permissible post grant should be the same as for amendments before grant: any amendment should be permissible that does not extend the subject-matter of the patent beyond the content of the application as filed. The content of the application as filed should comprise all matter that can be directly and unambiguously derived from the patent application as filed (cf. the current EPO standard)

The balance between patentee’s interest in sustaining validity and the public’s interest in legal certainty is safeguarded by additionally requiring that the patent may not be amended after grant in such a way as to extend the protection it confers.