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## 2016 – Study Question (Patents)

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**Added matter: the standard for determining adequate support for amendments**

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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?

For patent application: voluntary amendments can be submitted into the description/figure until the request for examination since they are limited to the subject-matter initially revealed in the application. After the request for examination, the amendments should be restricted to formal issues, such as a correction of minor typing and/or translation mistakes, and/or formal amendments to adapt the application to the Brazilian practice.

For granted patent: There is no formal procedure to amend the description and/or figures of a granted patent.

In principle, amendments to the description and/or figures of a granted patent would be possible (such as for correcting a formal issue) through an annotation in an additional sheet enclosed in the end of the Patent-Letter.

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

For patent application:

a. Amendments before the request for examination can be performed into the claims, provided that

the amendments are in accordance with the matter initially revealed and should be fully supported in the specification, abstract and/or figures;

- b. amendments after the request for examination are restricted to the initially revealed matter and should be fully supported in the specification, being limited to (i) a restriction of the scope of protection, (ii) a correction of minor typing and/or translation mistakes, and/or (iii) formal amendments to adapt the application to the Brazilian practice. The inclusion of new embodiment or category of claim (use claim, composition claim, process claim, compound claim) is not accepted.

It is important to notice that for divisional patent applications, the amendments in the claims must be restricted to the scope of protection of the set of claims of the parent application for which the request for examination was filed.

For granted patent:

There is no formal procedure to amend claims of a granted patent.

In principle, the request for amending the claims after granting should not go beyond the matter of the application as initially revealed and should be fully supported in the specification.

Amendments to the claims aiming at correcting formalities such as typographical and/or translation errors are permissible.

Amendments to the claims based on post-grant opposition decisions may be accepted with the same limitations for a patent application.

Such amendments are made through an annotation in an additional sheet enclosed in the end of the Patent-Letter.

- 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 is based on the Article 32 of the Brazilian IP Law and item 2.1 of the Brazilian Resolution 93/2013.

The article 32 defines that: *"In order better to clarify or define a patent application, the applicant may effect alterations up to the request for examination, provided that they be limited to the subject matter initially disclosed in the application."*

The Resolution 93 is related to guidelines regarding the applicability of said Article 32.

The Resolution 93, item 2.6, still foresees that for divisional patent applications, the amendments in the claims must be restricted to the scope of protection of the set of claims of the parent application for which the request for examination was filed.

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

There are no significant differences between the standards for the amendments to the description/figures and the set of claims. In both cases, amendments are restricted to the initially revealed matter and the claims must be fully supported in the specification, figures and/or abstract. Amendments filed after the request for examination are limited to (i) a restriction of the scope of

protection, (ii) a correction of minor typing and/or translation mistakes, and/or (iii) formal amendments to adapt the application to the Brazilian practice.

- 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.

According to the Article 32 of Brazilian IP Law and Brazilian Resolution 93/2013, the time-limit for filing amendments is until the request for examination since it is restricted to the matter initially disclosed and the claims must be fully supported in the specification, figures and/or abstract.

After the request for examination, amendments are accepted in order to (i) restrict the scope of protection, (ii) correct minor typing and/or translation mistakes, and/or (iii) perform formal amendments to adapt the application to the Brazilian practice.

It is important to notice that for divisional patent applications, the amendments in the claims must be restricted to the scope of protection of the set of claims of the parent application for which the request for examination was filed.

- 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.

Impermissible added matter refers to any matter that is not disclosed in the patent application as initially filed, according to Article 32 of the IP Law.

Article 32: *"In order better to clarify or define a patent application, the applicant may effect alterations up to the request for examination, provided that they be limited to the subject matter initially disclosed in the application."*

Furthermore, the claims must be fully supported in the specification according to Article 25 of the IP law.

The inclusion of new embodiment or category of claim is not accepted after the request for examination.

- 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 application as filed is interpreted as initially revealed matter which is basis for amendments. There is no jurisprudence in Brazil regarding this issue.

- 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?

In case it is applicable/considered, it would be the filing 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:

As already explained before, there is no formal procedure for amending a granted patent.

Anyway, at administrative instance, the patentee may request an amendment aiming at excluding the impermissible added matter through an annotation in an additional sheet enclosed in the end of the Patent-Letter.

On a court in post-grant proceedings, the acceptance of amendment for removing some portions found to be impermissible will depend on the judge's decision. It is possible that the judge has an understanding different from the PTO or the court-appointed expert.

## 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?

Although the article 32 of the IP Law provides a good scope as basis for presenting amendments based on the matter initially revealed, however the restrictions imposed by the Resolution 93 would no exist.

The amendments should be restricted to the initially revealed matter in the application until the end of the examination aiming at providing legal safety.

After the granting, amendments would be acceptable provided that they would not result in the extension of the scope of protection as granted.

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

yes

Please explain:

Yes. Amendments should be accepted even after the request for examination provided that it is restricted to the initially revealed matter in the application.

Provisions of the Resolution 93 for divisional patent applications regarding amendment into the set of claims must be disregarded.

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?

There is no formal procedure for post-grant amendments.

There would be a formal procedure for filing amendments and which should be restricted to the initially revealed matter in the application and they do not extend the scope of protection as granted.

For divisional patent, amendments should be accepted even after the examination request of the

parent application, provided that is its restricted to the initially revealed matter.

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

yes

Please explain:

Yes, the amendments should be restricted to the initially revealed matter in the application and they do not extend the scope of protection as granted, either parent or divisional patent case.

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?

The notional person skilled in the art is not formally defined on the current law and guidelines to determine the permissibility of amendments.

Anyway, the guidelines states that the skilled person in the art is as follows: *"The definition of a person skilled in the art is broad. The person skilled in the art can be one with average skill in the art in question at the time of filing of the application, with technical-scientific level, and/or one with operating working knowledge of object. It is considered that it had at disposal the means and the ability to work and routine experimentation usual the technical field in question. There may be cases where it is most appropriate to think in terms of a group of people, as in the case of a production team or research. This may apply particularly in certain Advanced technologies such as computers and nanotechnology."*

### 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.

The definition of the EPO's Guidelines seems to be aligned with the Brazilian IP law and practice, so that a suggestion would be:

*"Impermissible added matter is when a skilled person cannot derive directly and unambiguously, using common general knowledge, from the disclosure of the invention as filed, also taking into account any features implicit to a person skilled in the art in what is expressly mentioned in the document."*

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)?

yes

Please explain:

Yes. Amendments should be restricted to the initially revealed matter in the application and they do not extend the scope of protection as granted, either parent or divisional patent case.

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

No. Neither the addition of claims nor addition of limitation to claims should be considered impermissible added matter.

Amendments should be restricted to the initially revealed matter in the application and they do not extend the scope of protection as granted.

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

no

Please explain:

No. The removal of claims should not be considered impermissible added matter.

The removal of limitation from claims should be evaluated in case-by-case basis

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 date of the filing 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?

In case such impermissible added matter had been unduly proposed by applicant and unduly accepted by the examiner, an amendment could be proposed aiming at overcoming the objection regarding the impermissibility provided that it does not represent a broadening of the scope of protection.

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

No additional comments.

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

Summary