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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. Pursuant to Art. 42 of the law on Patents and Registration of Utility Models (LPRUM) amendments are possible for a pending patent application, up-to such time as the Examiner has decreed a decision to grant or to refuse a patent, and for a granted patent, during an nullity procedure only.

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.

Any amendments of a pending patent application cannot exceed the scope of the initial disclosure in the patent application as filed. Any amendments of the claims of a granted patent in a nullity procedure cannot broaden the scope of protection as granted.

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

Yes. In the case of a pending application amendments of the description, figures and claims are possible, while in the case of a granted patent only the claims can be amended.

- 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.

Amendments of a pending patent application are possible at any time up-to the date of the decision to grant a patent or refuse a patent. Amendments of a granted patent are only possible during a nullity procedure up-to the decision in the nullity procedure.

- 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 is such matter that exceeds the initial disclosure of the invention in the description, figures (if any) and claims (if available at the filing date of the application), for pending patent applications. For granted patent impermissible added matter is such matter which broadens the scope of protection defined by the granted claims.

- 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 scope of protection is determined by the claims. The description and figures are used to interpret the claims. The claims cover the stated features as well as their equivalents. An equivalent of a feature is a feature which carries out essentially the same function in the same manner and achieves substantially the same result and it is evident to the skilled person that at the priority date the result achieved by the claimed feature can be achieved with the equivalent feature too.

- 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?

Filing date (priority date) of the patent 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?

no

Please explain:

The patent law (LPRUM) does not provide for such a mechanism. If the Examiner finds that any amendment of a pending patent application is impermissible added matter, the patent application is refused and the decision to refuse patent can be appealed before the administrative court which examines the decision of the Patent Office only regarding its lawfulness but not with regard to its advisability (regularity). Removing portions of an amendment is possible only up-to the decision of the Examiner to grant or refuse patent, and also in case the decision of the Examiner is found to be unlawful and the examination procedure is re-opened.

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 patent applicant is allowed to introduce amendments during the examination of the patent application not only in response to an objection by the Examiner but also voluntarily at the applicant's own initiative on certain stages of the examination. The applicant has also the right to appeal the decision of the Examiner to refuse patent including on grounds of introduced impermissible added matter. However the public should enjoy legal certainty and therefore any decision of the Patent Office can be appealed before the administrative court but the appealed decision is examined only with regard to its lawfulness and not with regard to its advisability (regularity). Giving the applicant several possibilities to amend the patent application and appeal the decision of the administrative authority and limiting the right to appeal only to the lawfulness of the decisions of the Patent Office provides the necessary balance between the interests of the patent applicants and those of the public.

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

yes

Please explain:

The substantive and implementing legal norms relating to added matter should be made more detailed to avoid any vagueness and voids of the law.

- 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?

A granted patent may be amended only in the course of a nullity procedure. The competitive character of this procedure involving the right of each party to be given the opportunity to examine the standpoint of the adversary and to respond to his arguments as well as the right of the losing party to appeal before the administrative court but only with regard to the lawfulness of the decision of the Patent Office provides the necessary balance.

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

yes

Please explain:

Again, the substantive and implementing provisions can be made much more detailed to avoid disparate court practice.

- 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 skilled person (expert in the technical field) is the person who knows the general state of technics in his own and neighbouring technical fields, and has a general technical knowledge characteristic of any technician as well as a skill which allows him to improve his technical field (definition provided in the Regulation on Drafting and Examination of Patent Applications). The definition of the skilled person should be provided by the patent law and not by the implementing regulation which is an inferior legal act and moreover this definition does not quite correspond to the notion of the skilled person according to the EPC.

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:

Yes. Patents are very important part of the industrial and intellectual property and essential for the technical and economic development of the world. Impermissible added matter violates the legal certainty of the public and should not be allowed.

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

Not at this time.

- 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:

The present regulation of this problem in the Bulgarian patent law is adequate in that amendments are allowed at any time during the examination procedure of a patent application but only in response to an objection by the Examiner and also voluntarily at certain stages of the examination procedure.

No amendment is allowed after grant except in the case of a nullity procedure which is also adequate because the public needs a legal certainty.

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

No, if the original disclosure provides for adding a new claim.

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, because removal of claims should be the right of the patent applicant who may decide what scope of protection is claimed.

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:

Yes, otherwise there is no legal certainty to the patent applicants and to the public.

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 day before the filing (priority) date of the patent application.

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 available, otherwise the legal certainty for the public is violated.

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