



Submission date: 19th April 2016

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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Date	19-04-2016

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, but only for a patent application until the grant of the patent.

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

Yes, but only for a patent application until the grant of the patent.

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.

In legal regulations, Implementing Decree No. 550/1990 Coll., Section 14 states:

Admissible Changes in the Application for an invention

Modifications and changes made in the application for an invention during the course of patent procedure shall not exceed the framework of the original filing.

In patent office guidelines, part B, section 1.4. some examples are given.

The guidelines, however, are not binding legal regulations, but administrative guidance instrument for examiners.

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

In claims (under 2) above), omitting a feature from an independent claim and thereby broadening the claimed scope of protection is only acceptable if it is clear from the original filing as whole that the gist of the invention is that broad and not only the narrower solution described in the claims before such amendment.

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.

There is no difference until the grant of a patent.

After grant, only “obvious mistakes” will be allowed to be corrected by the patent register.

Any person can file a request for revocation of the granted patent. In such a case, however, the Office only issues the matter mentioned in Section 23 of the Patent Law No. 527/1990 Coll. and decides at its own discretion, the patentee can only make proposals for limitation of claims within the revocation proceedings.

The patent might also be revoked in part.

(Cf. also reply to the question 7)

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 defined as anything “*exceeding the framework of the original filing*”. No more specific definition is available.

The guidelines give some examples of admissible and inadmissible amendments are given.

Examples of inadmissible amendments:

- introducing essential features;
- amending essential features;

- omitting features that leads to broadening of the gist of the invention,
- amendments not implied by the original filing, including the drawings.

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;

As whole in context to the date of filing, including the drawings.

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 “average skilled person” is a common legal construct in the Czech practice, which is often used in the official guidelines, however not defined in the law.

The standard is applied above all for assessment of the inventiveness. Such person's knowledge comprises of everything relevant in the respective field to the priority date.

This is the same skilled person standard that might also be applied to interpreting the framework of the original filing.

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:

No. When a request for revocation of the granted patent has been filed, the Office only considers the issue mentioned in Section 23 of the Patent Law No. 527/1990 Coll. and decides at its own discretion, the patentee can only make proposals for claim limitation.

Section 23 Revocation of the patent (1) The Office shall revoke the patent, if it is ascertained subsequently: a) that the invention did not meet the conditions of patentability; b) that the invention is not disclosed in the patent so clearly and completely, to be carried out by a person skilled in the art; c) that the subject-matter of the patent extends beyond the content of the invention application as filed or the subject-matter of the patents granted on the divisional application extend beyond the content of the invention application as filed, or the extent of the protection arising from the patent was extended; d) revocation upon the request of the authorised person (Section 29); (2) If the grounds for revocation concern only a part of the patent, the patent shall be revoked in part. The partial revocation of the patent shall be carried out by the amendment of claims, description or drawings. (3) Revocation of a patent shall have retroactive effect to the date on which the patent became valid. (4) The request for revocation of a patent may be filed even after lapse of the patent if the person filing the request can prove a legal interest.

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?

In the Group's opinion, in addition to the examiner, it is also the applicant's responsibility not to file or approve any amendments exceeding the framework of the original filing (even if the examiner erroneously proposes such inadmissible amendment).

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?

No.

After grant, only obvious mistakes will be allowed to be corrected by the patent register.

Any person can file a request for revocation of the granted patent. In such a case, however, the Office only considers the issues mentioned in Section 23 of the Patent Law No. 527/1990 Coll. and decides at its own discretion, the patentee can only make proposals for voluntary limitation of claims within the revocation proceedings.

(Cf. also reply to the question 7)

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

yes

Please explain:

In the Group's opinion, it would be beneficial to allow that patentee to request voluntary claim limitation after grant.

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 traditional Czech person skilled in the art is derived from the German/European "durchschnittlichen

Fachmann” is deeply rooted in Czech patent practice. Its characteristics have changed only slightly over with the time. The Group is of the opinion that there are currently no difficulties in this respect.

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:

The Group considers harmonisation of the definition to be desirable.

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

The Group finds the EPC Guidelines definition to be convincing: "An amendment should be regarded as introducing subject-matter which extends beyond the content of the application as filed, and therefore unallowable, if the overall change in the content of the application (whether by way of addition, alteration or excision) results in the skilled person being presented with information which is not directly and unambiguously derivable from that previously presented by the application."

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 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?

Reverting to the application as originally filed.

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

No further comments.

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

No particular industry sector.

Summary

Under Czech patent law and practice, modifications and changes made in the application for an invention during the course of patent procedure shall not exceed the framework of the original filing. Official guidelines contain examples of impermissible added matter. There is no possibility for patentee for requesting post-grant claim amendment. The patentee can only propose limitation of claims within revocation proceedings.

The Group is of the opinion that harmonization is desirable. The Group is of the opinion that introducing post-grant claim amendment in the Czech Republic would be beneficial.