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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?

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.

Estonian Patents Act of 1994 (PA)

§ 25. Correction and supplementation of patent application

(1) An applicant may correct and supplement a patent application during processing such that no alterations are made to the subject matter of the invention which was disclosed in the patent

application on the filing date of the patent application.

(2) Corrections and supplements are deemed to alter the subject matter of an invention if they contain essential features of the invention which were not included in the patent claims, description of the invention, drawings or other illustrative material on the filing date of the patent application.

(3) In the case of corrections and supplements which alter the subject matter of an invention, the Patent Office shall make a decision to reject such supplements and shall notify the applicant thereof in writing.

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.

#### PA § 25. Correction and supplementation of patent application

(4) After the publication of a patent application pursuant to § 24 of this Act, the applicant shall not make such corrections or supplements which extend the scope of patent protection.

#### PA § 39. Amendments to patents

(1) The proprietor of a patent may restrict the scope of patent protection by amending patent claims and correct any bibliographical data and obvious spelling or calculation errors in the patent specification during the entire term of validity of the patent. ....

(2) The proprietor of a patent may request the making of such amendments to the patent which do not alter the subject matter of the invention which was disclosed in the patent application on the filing date of the patent application.

(5) During proceedings relating to the contestation of a patent in the Board of Appeal or a court, the proprietor of the patent cannot file a request for making amendments to the patent with the Patent Office.

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.

#### PA § 50. Contestation of patent in Board of Appeal

(1) Any person may file a revocation application with the Board of Appeal and request the revocation of a patent within nine months from the publication date of the notice of grant of the patent.

(2) A patent can be contested on the basis of the following allegations:

3) the invention protected by the patent, including an invention separated from an initial patent application pursuant to subsection 9 (2) or (3) of this Act, does not correspond to the subject matter of the invention as disclosed in the initial patent application.

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;

A patent application shall include the following documents:

a description of the invention in which the subject matter of the invention shall be disclosed in a sufficiently clear and concise manner which enables a person skilled in the art to make the invention.

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 date of 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?

yes

Please explain:

PA § 50. Contestation of patent in Board of Appeal

(1) Any person may file a revocation application with the Board of Appeal and request the revocation of a patent within nine months from the publication date of the notice of grant of the patent.

(3) The Board of Appeal has the right:

1) if the revocation application is granted, to require the Patent Office to revoke the patent provided that the facts set out in the revocation application preclude the maintenance of the patent.

## 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 applicant may file new patent application on the basis of corrections and supplements to an earlier patent application which alter the subject matter of the invention. The filing date of such patent application is the date of filing of corrections and supplements to an earlier patent application which was rejected by the Patent Office.

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?

PA § 39. Amendments to patents

(1) The proprietor of a patent may restrict the scope of patent protection by amending patent claims and correct any bibliographical data and obvious spelling or calculation errors in the patent specification during the entire term of validity of the patent.

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

no

Please explain:

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?

Current Estonian law does not use the notional person skilled in the art to determine the permissibility of amendments.

### 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 Estonian Group supports in principle paragraph 5 of the Resolution on Q193. It assumes that the test for impermissible added matter is whether that matter is not disclosed in the relevant application as filed, and also explains that an appropriate corrective action is to delete that impermissible added matter prior to grant.

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?

yes

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 date of filing.

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?

After filing but before grant, impermissible added matter should be deleted and previous (or initial) version of the patent application may be examined.

After grant, patent containing impermissible added matter should be revoked.

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

The Estonian Patent Act only enables to make amendments in patent applications and granted patents in a limited extent. Pursuant to law, during the examination only such corrections and supplements can be made into the patent application that do not alter the subject matter of the invention which was disclosed in the patent application on the filing date of the patent application. Corrections and supplements are deemed to alter the subject matter of an invention if they contain essential features of the invention which were not included in the patent claims, description of the invention, drawings or other illustrative material on the filing date of the patent application. Strict rules about corrections and supplements in patent applications and granted patents are – among other things – based on first-to-file legal concept.

After the publication of a patent application the applicant shall not make such corrections or supplements which extend the scope of patent protection.

The proprietor of a patent may restrict the scope of patent protection by amending patent claims and correct any bibliographical data and obvious spelling or calculation errors in the patent specification during the entire term of validity of the patent.

During proceedings relating to the contestation of a patent in the Board of Appeal or a court, the proprietor of the patent may only make such amendments that restrict the scope of patent protection. In case of impermissible added matter the patent will be fully revoked.