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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?

An application: Amendments to the description and/or the figures of the application are possible. Please see paragraph 3) a) and b) for further details and the standard. Procedure takes place at the patent office application procedure.

A patent: Amendments to the description and/or the figures of the patent are possible. Please see paragraphs 3) a) & b) for further details and the standard. Procedure may take place at the patent office opposition procedure, patent office limitation procedure, or market court procedure.

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

An application: Amendments to the claims of the application are possible. Please see paragraph 3) a) and b) for further details and the standard. Procedure takes place at the patent office application procedure.

A patent: Amendments to the claims of the patent are possible. Please see paragraph 3) a) & b) for further details and the standard. Procedure may take place at the patent office opposition procedure, patent office limitation procedure, or market court procedure

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 for determining whether such amendments are permissible:

The standard is based on determining whether the amendment is impermissible or not, i.e. whether the proposed amendment introduces impermissible subject matter. Please see question 5) for the details.

Exists in:

The standard is defined in Patent Act Section 13 (application), Patent Act Section 25 3) & 4) (patent), Patent Act Section 52 3) (patent), Patent Act Section 53a, Patent Decree Section 19 (application), Patent Regulations Section 39 (application) and Patent Office Guidelines Section H.3.

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

There are differences between amending claims and description. Generally, a proprietor or applicant may amend claims throughout the application procedure, and after the grant by the procedures of limitation and partial invalidation (before the patent office or the court).

However, amendments to the description and drawings are only allowed when considered necessary. The applicant or proprietor may make only such amendments and additions as are necessary clarifications or corrections, or amendments that are needed when adjusting the description to comply with new or amended claims. The amendments and additions within the description may not be of the kind that gives a broader or different content to the claims than is justified by the basic document. Patent Regulations Section 39 and Patent Office Guidelines section H.3.3.

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.

Amendment of application before the patent office:

After filing but before receiving a first combined search and examination report: The applicant is allowed to amend the application, without being restricted to the fact that the amendments are given prior to the conducted search.

Once the Patent Office has issued the combined search and examination report, no claim disclosing an invention that is independent of the invention disclosed in the previous claims may be included in the same application. Patent Decree Section 19.

After allowance but before grant: Once the notice of allowance has been given to the applicant, the patent claims may not be altered in such a way as to extend the scope of protection. Patent Act Section 19

After grant: Generally no difference to the situation of after the allowance notification.

Amendment of patent after the grant may take place at patent office opposition procedure, patent

office limitation procedure, or at a market court 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.

An application for a patent, or a patent, may not be amended in such a way that protection is claimed for subject matter, which is not disclosed in the application at the time it was filed. Patent Act § 13, Patent Decree Section 19 and Patent Office Guidelines Section H.3.1.

Consequently, the amendment shall not contain subject matter that has not been disclosed in the application as filed. Where a claim is amended to add new features, the applicant shall at the same time state where those new features are to be found in the basic documents.

Patent office guidelines or patent law does not specify that amendments must be directly and unambiguously derivable from the application as filed. However, practically the standard conforms to this kind of a level of the requirement.

- 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;

By the notional skilled person. Patent office guidelines section H.3.

- 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 is the relevant date, as the application shall not contain subject matter that has not been disclosed in the application as filed. Patent office guidelines section H.3.

- 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:

Administrative procedures:

Review in patent office opposition procedure:

The proprietor may amend the patent at the opposition proceedings, in which case the patent may be maintained in amended form. Patent Act Section 25. This may be conducted, when communications from the patent office has been received, or later on at the time of filing an appeal against such a decision of the patent office. However, the patent claims may not be altered in such a way as to extend the scope of protection.

Civil court procedure:

Review in Market court proceedings:

In connection with the invalidation process of a patent, the patent proprietor may request the Court to limit the patent in accordance with the amended patent claims. If the Court approves the request for limitation, the patent limited in this manner shall make the basis for continuation of the process, also in which case the patent may be maintained in amended form. Patent Act Section 52.

However, the request for limitation shall be presented before the case is transferred to the main hearing. The court may furthermore declare a preclusion setting a procedural deadline for submitting any amendment.

The patent claims may not be altered in such a way as to extend the scope of protection.

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?

Finnish patent legislation contains certain measures aiming to ensure a balance between, on one hand, a patent applicant's right to make certain amendments during the examination process and, on the other hand, preventing the applicant from adding impermissible matter.

The first category of these measures relate to the interpretation of the legislation concerning amendments and responsibilities of the applicant when amending the patent.

Claims may not be amended to include subject matter not disclosed in a basic document (description with drawings and the claims as contained in the application as filed or as deemed to have been filed).

In other words, the basis for the amendments is the basic document. Where a claim is amended to add new features, the applicant is obliged to state at the same time where those new features are to be found in the basic documents. (Patents Decree, Section 19)

When the applicant submits a new description, he/she must also give an assurance indicating to what extent the description is not literally consistent with the previously submitted description, and in what respect the amendment made means that something new that has an effect on the matter has been included in the new description. (Patents Regulations, Section 40)

The second category of the measures to be used in striking a balance relate to proceedings after the grant of the patent.

The patent authority is obliged to revoke a patent, due to an opposition, if patent contains subject matter not included in the application as filed or if the scope of patent protection was extended after the patent authority notified the applicant that the application could be accepted. Any person may file an opposition within nine months from the date of grant of the patent. (Patents Act, Sections 24 and 25)

The court is obliged to declare a patent invalid, due to a legal action, if the patent contains subject matter not included in the application as filed or if the scope of protection was extended after the patent authority notified the applicant that the application could be accepted. Any person who suffers prejudice due to the patent may initiate invalidity proceeding. (Patents Act, Section 52)

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

yes

Please explain:

In the Finnish practice the principles set forth in the EPO's test for assessing permissible amendment concentrating on whether the amendment can be directly and unambiguously deduced from the application documents as filed are followed to some degree in parallel with the national provisions set forth above. However, the implementation of the test results at times in interpretations that may be considered unreasonably strict. The Finnish group considers that the applicants should have certain level of flexibility to ensure reasonable view on the interests of the applicant while at the same time ensuring legal certainty.

Furthermore, the legislation concerning permissible/impermissible amendments could be made more specific to reduce the room left for interpreting the rules and thereby to enhance legal certainty for both the applicants and for third parties. For example, the use of the notion of the person skilled in the art in evaluating whether patent includes added matter could be further specified in the current legislation.

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, the Finnish Patents Acts allows limitations of the patent post grant. The patentee may put application for limitation forward, for example, as a response to an invalidity claim. The patentee may apply for limitation of the patent by making a written request to the patent authority or, if court proceedings concerning the validity of the patent are pending, to the court in question. Please see also answer to question 1 regarding limitation of the patent post grant. (Patents Act, Sections 52 and 53 a)

The current law in Finland tries to strike a balance between allowing the patentee to make amendments to granted patent and preventing patentee from adding impermissible matter by setting a certain criteria against which the permissibility of patentee's request is assessed. The court or the patent authority will accept the request if the patent limited according to the request meets the following conditions:

- Patent relates to an invention, the description of which is so clear that the person skilled in the art may carry out the invention on the basis of it;
- Patent does not contain subject matter not included in the application as filed; and
- Patent's scope of protection has not been extended from the scope of protection of the granted patent, patent granted in the opposition proceeding or from the scope of protection defined in previous decision concerning limitation of the patent. (Patents Act, Section 53 b)

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

yes

Please explain:

The Finnish group finds that it is important that the interests of the applicants are reasonably protected while maintaining legal certainty. Therefore, the Finnish group finds that it is important that post grant amendments continue to be allowed to enable the applicant, for example, to reasonably react to validity challenges and to ensure proper scoping of the claims vis-à-vis prior art that may also surface at a later stage (such circumstances may arise, e.g., due to a specific prior art document not being readily available to the applicant at the time of filing of the application for example because the prior art document was a secret patent application or in a foreign language not within the scope of the applicant's prior art search). However, the Finnish group finds that special attention should be paid to ensuring legal certainty for third parties relying on the disclosure of the original application and preventing applicants from gaining unjustified advantage through post grant amendments. Therefore,

the patent applicants should continue paying attention to good quality and careful drafting of the patent applications as their first measure against possible invalidity claims.

- 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?

In the Finnish system the notion of a person skilled in the art is used. The Finnish group considers it important that the same notion of the person skilled in the art is used in both in assessing the initial patent application as well as in the later assessments concerning the patent in question. As stated above, the Finnish group considers that it would be beneficial to further specify the use of the notion of the person skilled in the art when assessing questions related to added matter

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.

Our Group generally accepts to the principles set out at the point 5) of the questions

- 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 group had different opinions, so a clear yes/no answer could not be given.

A part of the Group came to the conclusion: **No**. The timing of the amendment should not have an effect on the definition of the amendment. The definition of amendment should remain the same at least for the application procedure, and after the grant be very similar to the existing procedure, thus overall resulting in the current practise.

Another part of the Group though differently: **Yes**. Before publication of the application, the amendments should not be as strictly forbidden. According to the underlying idea of Article 123(2) EPC is that an applicant should not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application. If the amendment is done while the application is not published, the third parties cannot be damaged.

If amendment (during the first 18 months) adds subject matter to the application, then the added matter could get a new filing date, but it would not be forbidden to do so. At the moment this is only allowed during the first 12 months and it requires the filing of a new application, which is totally unnecessary in many cases, if the amendment could be allowed in the first application.

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:

Removal on claims per se, should always be allowed.

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?

Please see question 15).

A part of the group thought that it should be the time of filing the application (or a 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?

Please see question 15)

A part of the group thought that Patent Examiners should not allow added matter during prosecution of the application. They should pay more attention to this. If, however, the granted patent would contain added subject matter, then the proprietor should always be allowed to remove such subject matter from the application, even if the scope of protection would be broader after the allowed new amendment of the claims.

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

In Finland application or patent may be amended for description, figures and claims. Any amendment shall not extend beyond the content of the application as filed. After the grant, the scope of protection may not be broadened by the amendment. Amendment may be carried out before the patent office at

an application procedure, an opposition procedure, a limitation procedure, or before a Market court at a civil procedure. For improvement of the legislation, the Finnish group considers that the applicants should have certain level of flexibility to ensure reasonable view on the interests of the applicant, while at the same time ensuring legal certainty, and the implementation of the criteria to determine whether the amendment is acceptable should not be unreasonably strict. This was emphasized for the procedure after the grant of the patent, in which case the criteria might be slightly more liberal to remove such subject matter from the patent.