



Submission date: 25th April 2016

## 2016 – Study Question (Patents)

Sarah MATHESON, Reporter General

John OSHA and Anne Marie VERSCHUUR, Deputy Reporters General

Yusuke INUI, Ari LAAKKONEN and Ralph NACK, Assistants to the Reporter General

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

Responsible Reporter: Ari LAAKKONEN

National/Regional Group

France

Contributors name(s)

Alain GALLOCHAT (CHAIRMAN), Cyra NARGOLWALLA (REPORTER), Michel ABELLO, Sabine AGÉ, Gwendal BARBAUT, Hélène CORRET, Pauline DEBRÉ, Gérard DOSSMANN, Frédérique FAIVRE PETIT, Blandine FINAS-TRONEL, Esther HAGEGE, Francis HAGEL, Jonathan HINKSON, James LAWRENCE, Amandine METIER, Thierry MOLLET-VIEVILLE, Marc NEVANT, Christian NGUYEN-VAN-YEN, Stéphane PALIX, David POR and Corinne VEDEL

e-Mail contact

alain.gallochat@wanadoo.fr

Date

22-04-2016

### 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?

A) It is possible to amend the description and figures of a French patent application in the following cases:

1) In response to a notification of irregularities from the “National Institute of Industrial Property” (“INPI” – referred to here-under as “French Patent Office”).

2) In response to the preliminary search report and, when applicable, to the supplementary preliminary search report, deletions are possible in order to ensure the consistency with the amended claims.

3) In case of a divisional application, the description and the figures may be limited to the sole subject matter of said divisional application.

4) Amending the description and the figures in response to third party observations is not provided for by the law.

B) French law allows amendment of the description and the figures of a French patent in the context of a limitation procedure.

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

A) It is possible to amend the claims of a French patent application in the following cases.

1) From the filing date of the patent application up to the day the prior-art-search officially starts.

2) In response to a notification of irregularities issued by the French Patent Office.

3) In response to the preliminary search report and, when applicable, to the supplementary preliminary search report.

4) In response to third party observations.

B) It is possible to amend the claims of a French patent in the context of a limitation procedure. The effects of limitation are retroactive back to the date of filing of the patent application.

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.

#### **1. Admissibility of amendments outside of the patent limitation procedure**

##### **1.1. During the patent grant procedure**

Throughout the procedure of the patent grant, the patent application is subject to amendments. However, application may be rejected by the French Patent Office if the amended claims are not supported by the description.

##### **1.1.1 Applicable texts / rules**

Article L.612-6 of the "Code de la Propriété Intellectuelle", "CPI": "The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description. "

Article L.612-12 CPI " A patent application will be refused, in whole or in part, if:

[...] 3°.it concerns a divisional application whose subject matter extends beyond the contents of the description in the original application;

[...] 8°.the claims are not based on the description;"

Article R.612-49 CPI " If the patent application is likely to be refused for one of the reasons referred to in Article L. 612-12 (item 8), a reasoned notification thereof shall be made to the applicant. The notification shall set out the time limit afforded him in order to submit his observations or new claims.

The patent application shall be refused:

- if the applicant has not submitted observations or new claims within the time limit afforded him;
- if the observations submitted are not accepted or if the new claims do not enable the irregularity to be remedied."

### **1.1.2 Amendments to the application as filed**

#### **(I) Amendments may be made at different stages of the grant procedure:**

- At the first technical examination stage made by the French Patent Office: after filing of the patent application, the Office may notify the applicant of irregularities notably if the claims of the initial application are not supported by the description (Art R.612-49 CPI.). An amendment of the claims, description and figures is possible in response to these notifications, but only "to the extent necessary to rectify the irregularity" (art. R. 612-37 CPI; Guidelines C-II-5.1, and C. -III-5.1).
- Between the filing and the start of the prior art search: the applicant may amend his set of claims or spontaneously file a new set of claims (article L.612-13 CPI and Guidelines C-IV-5.1.). In this case, the applicant cannot make any changes to the description (Guidelines C-II-5.1) or figures (Guidelines C-II-5).

NB: in the case of a French patent application claiming the priority of at least one foreign application, the start of the prior art search is the day when the applicant has provided the "research report" for the priority application(s), or has justified being unable to produce such a document (s) (Guidelines C-VIII-4.2).

- After issuing the preliminary search report: the French Patent Office may invite the applicant to make changes to his claims including for grounds of a lack of support from the description ("up to the date of payment of the fee for granting and printing of the specification", article R.612-60 and guidelines C-I-III-C 5.4 and 5.4).
- In response to third party observations: it is possible to amend the claims but the law does not provide for amendments to the description and figures (R612-64 CPI and guidelines C-IX-1a).

#### **(II) Claim amendments: supported by the description**

- The principle is that an amendment to the claims is possible provided that it is supported by the description of the application as filed (Article L.612-6 CPI.).
- The requirements for amending claims can be fulfilled, according to the French Patent Office guidelines (Guidelines C-IV-1.4), when "the claim contains the exact wording found in the description, in the case of an equivalent formula or when the technical characteristics clearly derive from the figures(s)."

In addition, the French Patent Office guidelines state that "technical characteristics not mentioned in the description but found unequivocally in the figures, can be accepted in the claims, provided that these characteristics concern an already foreseen technical means in the description and only specify it in line with the overall content of the description" (Guidelines C-IV-1.4).

The description and the figures can be modified by:

- suppression of examples which are no longer within the scope of the claims;

- transfer of elements initially presented in the disclosure of the invention towards the part of the description relating to the prior art, possibly by citing the references of the documents of the preliminary search report, without comments; and/or

- adding a limiting feature to a paragraph of the invention's disclosure, wherein said feature is already contained in the initial description, provided that the new claims with this addition have previously been considered as being based on the initial description (Guidelines C-VIII-5.2.3).

• The sanction for not complying is the rejection of the patent application as referred to in Article L.612-12 CPI supra.

### **1.1.3 The case of the divisional application**

In case of division, although said divisional application should be entirely supported by the parent application (Art. L.612-12-3° CPI), it is possible to limit the description to a single object of the divisional application and delete the figures corresponding to the passages deleted from the description (R.612-35 CPI and guidelines C-II-5.3).

## **1. Admissibility of amendments before the court**

### **1.2.1 The test to be applied**

The basic principle: the modifications must be derivable directly and unambiguously from the application as filed; they must "result from it unequivocally".

In this regard, the whole content of the application (description, claims, figures) must be taken into account.

According to case law:

(I) it is necessary to compare the application and the claims, independently of the state of the art; then

(II) check whether these modifications can be "objectively deduced" by the skilled person in the art, that is to say, that they directly and unambiguously derive from the application as filed.

The following reserves must be taken into account:

step (ii) is not a test of obviousness, so that an addition which is obvious to the person skilled in the art would not suffice to justify it; the patent is not a reservoir and one can only combine features which were themselves disclosed in combination.

In assessing the content of the disclosure of the application as filed, it is appropriate to adopt the point of view of the person skilled in the art.

An amendment which restricts the scope of the claim may nevertheless violate Article L.613-25 CPI.

### **1.2.2 Applications**

#### **(I) Interpretation of the application by the person skilled in the art**

Case law considers that it is not necessary that the expression used in the claims be disclosed

explicitly, as long as the concept be substantially described; terms which are different but equivalent to those of the application, can be used in the claims.

Case law judges that errors in the application, which are manifest to those skilled in the art may be corrected.

### **(II) Suppression of characteristics**

According to case law, the suppression of a feature is impermissible if:

- this suppression does not derive directly and unambiguously from the application as filed, and/or if
- this feature is presented as being essential.

However, the suppression of a characteristic found in the description is acceptable if this characteristic is only described as a preferred embodiment of the invention, and the teaching of the application may be limited to a solution presented as being preferred, when no other solution is disclosed.

### **(III) Intermediate Generalization**

Case law considers that it is not allowed to isolate a characteristic from a particular example where said characteristic is disclosed in combination with others, if the person skilled in the art cannot clearly deduce from the application that said characteristic is directly and unambiguously applied to the more general context.

However case law considers that a general characteristic can be deduced from several particular disclosed examples, even if they do not meet the full scope of the general characteristic.

### **(IV) Consideration during examination**

If an amendment is made to distinguish from prior art, but said amendment is not directly and unambiguously supported by the application as filed, then it should not be allowed.

### **(V) Considering the figures only**

Case law considers that amendments to the claims by including characteristics found in the figures only, are permissible so long these characteristics can be directly and unambiguously derived therefrom.

## **2 Admissible amendments via patent limitation**

### **2.1 Post-grant Limitation procedure**

#### **2.1.1 Law: L.613-24 and R.613-45 CPI**

Article L.613-24 CPI provides the conditions of limitation of scope of the patent by modifying one or more claims before the French Patent Office; Article R.613-45 CPI provides if need-be the modification, if any, of the description and figures to comply with the provisions of Article L.612-6 CPI, concerning clarity, conciseness and the support of the claims by the description.

To date, the French Patent Office has not yet published any guidelines regarding the limitation procedure.

### **2.1.2 The concerned titles**

French patents and the French part of European patents may be limited via the limitation procedure before the French Patent Office.

The French part of European patents may also, as part of an invalidity action, be subject to limitation under Article 105a of the European Patent Convention, i.e. before the European Patent Office.

### **2.1.3 French Patent Office's practice**

The French Patent Office checks that the amended claims:

- constitute a limitation compared to the previous claims,
- comply with the provisions of Article L.612-6 CPI (clear and concise claims, based on the description).

It is possible for the patentee to file an appeal before the Paris Court of Appeal against the decision of the Director of the French Patent Office further to the limitation request.

### **2.1.4 Control by the Paris Court of Appeal**

In the case of limitations, the Court of Appeal considers that the claims should be based on the description as filed. This requirement is satisfied when the limited claim is supported directly and unambiguously by the initial description. It is not necessary that the support be found in a claim of the application as filed.

The Court of Appeal can refer to the person skilled in the art to appreciate the support in the description.

In some case law, the Court of Appeal considered that the claims limiting the scope of the patent cannot concern a different object than that of the previous claims.

## **2.2 The Court's assessment of the validity of the limitation**

Article L.613-25 d) CPI sets, before the courts, the criteria of validity of the post-grant limitation of the patent, supplemented by case law (partial judicial invalidation of the patent referred to Article L.613-27 CPI, which is however not covered in this section 2.2).

Moreover, Article L.613-25 CPI lists the causes of nullity which generally apply to claims after limitation.

### **2.2.1 Law: L.613-25 d), for the specific criterion and L.613-25 c) CPI, for the basic criteria concerning support in the initial application**

Pursuant to Articles L.613-25 c) and d) CPI, the courts should verify that the limited claims do not contain new matter in view of the content of the application as filed.

This requirement is not specific to claims obtained after limitation.

The Courts should also verify that the restriction has the effect of reducing the scope of protection conferred by the limited claims in view of the previous claims, as granted or as limited.

Limitation proceedings should not, in fact, be prejudicial to the legal security of third parties.

### **2.2.2 Case law**

The specific requirement for the limitation pursuant to article L.613-25 d) CPI is the effective limitation of the scope of the patent.

However, the validity of this limitation is also dependent on its support, or not, in the application as filed (Article L.613-25 c) CPI).

#### **(I) Specific criteria - the limited claims have to limit the scope of the patent**

- Limiting the scope of the patent necessarily comes from the inclusion of features in a claim or clarification or information in a claim.
- The amended claims do not relate to a different object than that of the previous claims.
- When two claims are combined, all the essential features must be included, otherwise the protection conferred by the limited patent is considered by case law to be increased.

#### **(II) Basic criteria: lack of new matter - the limited claims must be supported by the content of the application as filed**

- Amendments must be supported by the application as filed. The important aspect for the Courts is indeed to determine whether the amendment in the patent as limited was already contained in the patent as filed. The initial application is taken as a whole and the meaning given to the terms is that read and assessed in light of all the evidence provided in the description and claims. Case law also considers that the limitation may concern a variant described in the description, found in the initial application.
- The case of intermediate generalization: case law considers that it is not possible to isolate a specific feature from a combination of features originally disclosed and to use it to delimit the claimed subject matter, while there are structural and functional links between the relevant characteristics.
- Although support of the limitation may in principle be based on only the figures, it must still be confirmed by case law which refers generally to the description or to the figures.
- Concerning disclaimers, case law holds that subtracting the subject-matter presented in the description as an embodiment from the scope of protection, is acceptable, in particular as part of a limitation before the EPO, in accordance with Article 105a EPC.

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

There are no differences: their support must be explicitly or implicitly disclosed in the application as filed (under penalty of the patent being revoked; L613-25 c) CPI).

On the other hand, there are differences from a prosecution point of view to proceed to the modifications of different elements of a patent application (description, claims and figures):

- It is possible to spontaneously amend the claims of a French patent application from filing up to the date that the prior art search begins, but not the description and / or figures (see answer to Question 3.a) 1.1.2. (I));

- The possibility to change the description and figures in response to third party observations is not provided for by law, while the possibility of amending the claims is explicitly provided for in this case (see answer to question 3.a) 1.1.2. (I)).

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.

As explained in the answer to question 3, two periods can be distinguished:

- the procedure of grant before the French Patent Office, and
  - the post-grant period which can take place before the French Patent Office in case of a limitation procedure or before the courts in case of litigation.
- During the procedure of grant before the French Patent Office (at whatever stage), an amendment is possible (limitation or not), so long as the amendment does not extend the scope beyond the content of the application as filed (Article L.612-12 3 ° and 8 ° CPI). The requirement is that the amendment must be supported by the description of the application as filed (the latter includes the description, figures and claims). Non-compliance with these rules leads to the rejection of the patent application.
  - During the post-grant period, the requirements are the same on the basis of Article L.613-25 c) CPI. In this regard, the whole application (description, claims and figures), has to be taken into account, and the modification has to be directly and unambiguously derived from / supported by the application as filed.

When the patent is limited under Article L.613-24 CPI, the Courts verify that the modification is supported by the application as filed, as a whole, but will also verify that the scope of protection has not been increased. Whether the limitation does not extend the scope of protection conferred, the Courts should further:

- (I) check that the limited claim does not concern a different object than the previous claims,
- (II) check that the limited claim does not enable a broader scope of protection, in accordance with Article L.613-25 d) CPI.

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 via case law as matter which is neither explicitly nor implicitly disclosed in the patent application as filed. When the technicality of this disclosure requires it, case law then introduces the notion of the “person skilled in the art” that it then more or less precisely defines in view of the context of the invention, to determine whether or not the amendments are disclosed.



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 question of the interpretation of the content of the application as filed does not find a uniform answer in case law. In particular, the French courts do not always refer to the person skilled in the art to assess the legitimacy of added matter.

In practice and in a general manner, the courts consider that modifications are supported if they:

1. find a literal support in the application as filed; and/or
2. derive directly and unambiguously from the application as filed for the person skilled in the art at the date of filing.

The case law may be summarized as follows:

- **The literal disclosure of the patent application as filed** comprises the description, figures and claims as filed. However, the importance of figures may vary from one decision to another. Some view them as constituting a separate disclosure, while others consider that they are a secondary source of teaching.

Furthermore, the French courts have held that the use of a term in a claim does not constitute impermissible added matter when its synonym was found in the application as filed.

- French Case law admits obvious interpretation of the terms of the description, and thus **the literal disclosure of the patent application as filed, complemented by elements which can be directly and unambiguously derived from the application as filed can be used for amendments.**

- **The patent application as filed, without modification, should be interpreted in the light of the general knowledge of the person skilled in the art**, and thus some case law refers to the general knowledge of the person skilled in the art that can be used to support an added characteristic.

- Case law has clearly rejected **the possibility of amendments being based on the application as filed and everything that seemed obvious to the person skilled in the art in view of said application as filed.**

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 relevant date for the knowledge of the person skilled in the art is the date of filing of the application and not its priority date.

In case of divisional patent, the date to be taken into account is that of the filing date of the initial parent 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?

yes

Please explain:

French law does not provide for post-grant opposition proceedings.

To overcome any impermissible added matter defect after the grant of the patent, the patentee has two ways possible remedies.

First, he may limit the claims of his patent before the French Patent Office, to the extent that the scope of the claims is not expanded.

Second, he may, in court proceedings, request a partial invalidity of his claim pursuant to Article L. 613-25, al. 2 CPI. Indeed, if the reasons (impermissible subject matter) affect the patent in part, revocation may be pronounced in the form of the corresponding limitation of the claims. In this case, the court sends the owner of the patent back before the French Patent Office so that he presents a draft of the amended claim according to the provisions of the decision pursuant to Article L.613-27 para. 3 CPI.

In case law, and in application of this article a patentee was thus able to present a subsidiary limitation request of his patent in court, which was accepted.

Furthermore, it should be noted that the court may apply this text to remedy a forbidden extension.

## 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 possibilities of amendment of the description, claims and figures under examination are strictly regulated. Any amended claim must be supported by the description or it will be rejected (Article L.612-12 al 8 CPI). According to recent case law, the courts also recognize that the amendments can be supported only by figures if the added features can be directly and unambiguously derived from these figures.

In case of amendment of the claims in response to the preliminary search report, any corresponding modification in the description should consist in removing subject matter from the description (Guidelines C VIII 5.2.3).

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

yes

Please explain:

The following provisions should be introduced into the CPI.

1) Explicitly provide that the patent application may not be amended in such a way that it contains subject-matter which extends beyond the application as filed.

2) Explicitly provide that the description and the figures may be amended (on request) if the claims are amended in response to third parties observations.

In all cases, it should be provided that:

- A claim may only be amended insofar as the combination of the amended claim characteristics can be directly and unambiguously derived from the content of the application as filed, said content comprising the claims, the description and the figures. This deduction should not be interpreted as corresponding to a literal copy, but first should take into account the vocabulary defined in the application as a whole and, second, take into account the general knowledge of the person skilled in the art normally competent for the purposes of the application on the filing date thereof (see Q12);

- The description and the figures should be amended only by deleting an item or by correction of an error, this correction must be obvious, in that it should be immediately apparent that nothing else than the correction as made could have been intended by the applicant.

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 patent limitation procedure (post-grant) can be made before the French Patent Office pursuant to Articles L.613-24 and R.613-45 CPI (see the answer to question 3, 2.1 .1 for details).

- The concerned Titles are French patents and the French part of European patents (see the answer to question 3, 2.1.2 for more details).

- It is the French Patent Office (INPI) which verifies that the amended claims, with however a possible appeal before the Court of Appeal of Paris (see for more details the answer to question 3, 2.1.3 and 2.1.4).

- However, it is article L.613-25 d) CPI that sets, before the Courts, the criteria of validity of the post-grant limitation of the patent, supplemented by case law (see the answer to question 3. 2.2 and specifically 2.2.1 and 2.2.2 for more details).

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

yes

Please explain:

A provision could be useful, where it is explicitly said that a post-grant limitation procedure primarily consists to add features disclosed in the application as filed as a whole (i.e. claims, description and figures) to the previously granted claims. It could also be useful to explicitly provide that the same examination procedure rules as defined above, apply to the post-grant added features.

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?

French law does not impose reference to the notional person skilled in the art, and as indicated in point 6 (a), it is common to find court decisions that do not refer to such notion.

When case law refers to the person skilled in the art, it sometimes precisely defines him. When this is the case, however, it must be noted that the reference to the person skilled in the art generally remains theoretical. It is rare to find decisions which explicitly make reference to the general

knowledge of the person skilled in the art to determine whether an amendment would, or not, constitute an extension beyond the content of the application as filed. It would be desirable to be able to more broadly use the notional person skilled in the art and his common general knowledge.

### 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 it is desirable, see Q14)

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

It is subject-matter not described in the application as filed (description, figures and claims) as understood by the person skilled in the art at the date of filing.

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, no prohibition.

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?

Filing 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?

Only way: to make a limitation that will overcome the defect of impermissible added matter, otherwise it is unsolvable.

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

A final document showing all the differences between the granted patent and the application as filed could be useful.

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

#### Summary

GB:

To be permissible, the subject matter of amendments must derive directly and unambiguously from the patent application as filed. According to French practice, these amendments may be made during the examination of the patent application at various but very specific moments. The patentee also has the possibility to modify the patent after grant via the limitation procedure.

FR:

Pour être admissible, l'objet de modifications doit découler directement et sans ambiguïté de la demande de brevet telle que déposée. Selon la pratique française, ces modifications peuvent être apportées lors de l'examen de la demande de brevet à différents moments très précis. Le titulaire du brevet peut aussi modifier le brevet après délivrance via la procédure de limitation.

DE :

Um zulässig zu sein muss der Gegenstand von Änderungen unmittelbar und eindeutig aus der ursprünglichen Anmeldung hervorgehen. Laut der französischen Praxis dürfen diese Änderungen während der Prüfung der Patentanmeldung in verschiedenen aber sehr bestimmten Augenblicken eingereicht werden. Nach der Erteilung darf der Patentinhaber das Patent durch das Beschränkungsverfahren noch ändern.