



Submission date: 22nd 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 | Italy |
| Contributors name(s) | Lamberto LIUZZO, Stefania BERGIA, Bianca Manuela GUTIERREZ, Renato SGARBI, Carlo FAGGIONI and Alessandro SPINA |
| e-Mail contact | alessandro.spina@sib.it |
| 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?

Yes, according to Articles 172(2), 79 and 76(1)(c) of the Italian Intellectual Property Code an application for a patent/utility model or a granted patent/utility model may be amended on request of the owner. The request must be accompanied by the modified description and drawings.

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

Yes, according to Articles 172(2), 79 and 76(1)(c) of the Italian Intellectual Property Code the applicant is also allowed to amend the claims of a patent/utility model application or of a granted patent/utility model.

According to Article 79 of the Italian Intellectual Property Code the applicant may limit the scope of protection by filing a set of amended claims with the Italian Patent and Trademark Office. The amended claims must remain within the limits of the content of the patent application as originally filed.

In proceedings concerning nullity, according to Article 79 of the Italian Intellectual Property Code the owner of a patent has the right to submit to the Court, at any stage or instance of judgment, modified claims that remain within the limits of the content of the patent application as originally filed and that do not extend the protection conferred by the granted patent.

When there are both a limitation of the European patent following a limitation procedure as per the European Patent Convention, and a limitation of the same European patent with effect in Italy following a national procedure, the scope of protection conferred by the patent is determined by taking into account each of the limitations.

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.

Permissibility of amendments is ruled by the above-mentioned articles of the Italian Intellectual Property Code in the case of patent applications, as well as in the case of a granted patent. The Italian case law and IP doctrine have a well consolidated approach and best practices that are consistent with the Italian Intellectual Property Code.

As far as patent applications are concerned, Article 172(2) e.g. provides the possibility to amend non-substantial aspects of a patent application and to add examples to the description. The case law has established that it cannot be allowed to add examples based on experimental tests carried out after the filing of a patent application. According to Article 76(1)(c) amendments that extend the subject matter beyond the content of the application as filed lead to the nullity of a (eventually) granted patent.

As far as a granted patent is concerned, Article 79 specifies that scope of protection can only be limited. According to Article 76(1)(c) amendments that extend the scope of a granted patent beyond the content of the corresponding original application lead to the nullity of the patent.

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

According to the Italian Industrial Property Code, case law and IP doctrine, the requirements for amending description, figures and claims are the same.

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.

According to the Italian Industrial Property Code the requirements for assessing amendments made to description, figures and/or claims depend on timing. The assessment of amendments made before grant in fact is ruled by the above discussed Articles 172(2) and 76(1)(c) and in principle any kind of amendment is allowed, whereas amendments made to a granted patent, i.e. post grant amendments, are assessed based on the above discussed Article 79 and can only concern limitation of the scope of protection.

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.

Added subject matter is a ground for refusing an amendment. The Italian Intellectual Property Code does not provide a definition of impermissible added matter. However, the Italian case law and IP doctrine essentially base assessment of impermissible added matter on the well-known novelty test

developed by the EPO. Differently from the approach of the European Patent Office, the interpretation of a text of a patent/patent application by the Italian judges and is neither strictly literal nor excessively broad.

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;

In line with the European Patent Convention, a patent application is construed from the point of view of a person skilled in the art based on the wording of the claims read in the light of description and drawings, if any.

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 of knowledge of the notional skilled person is the filing or priority date.

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:

As mentioned in our answer to question 1, according to Article 79 of the Italian Intellectual Property Code in nullity proceedings the owner of the patent has the right to submit to a Court, at any stage or instance of judgment, modified claims that remain within the limits of the content of the patent/utility model application as originally filed and that do not extend the scope of protection conferred by the granted patent/utility model. The owner of a patent has also the right to limit the patent by filing modified description, claims and drawings with the Italian Patent Office.

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?

Possible amendments of a patent application are assessed based on Articles 172(2) and 76(1)(c). As stated in our answer to question 3, amendments that extend the subject matter beyond the content of the application as filed lead to the nullity of a (eventually) granted patent.

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

no

Please explain:

In our view, the present system and laws are satisfactory and consistently supported by Case Law and IP doctrine.

- 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, according to Article 79 of the Italian Intellectual Property Code post grant amendments are allowed before the Italian Patent and Trademark Office and before a Court at any stage of nullity proceedings. Reference is made to the application as originally filed, the criteria being on the one hand not to extend the object of the patent beyond the contents of the originally filed application, and on the other hand not to extend the scope of protection.

Still according to Article 79 of the Italian Intellectual Property Code, post grant amendments are also allowed on a voluntary basis either before Court during a lawsuit for nullity or before the Italian Patent Office.

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

no

Please explain:

In our view the present system and laws are effective and there are no aspects that could be improved.

- 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 same criteria are used by Italian Patent and Trademark Office examiners and Court experts. This approach is generally effective and in our view there are no aspects that could be improved.

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, harmonisation of the definition of impermissible added matter is desirable.

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

In line with the EPO's Case Law, decision G1/93 in particular, and the EPO's Guidelines, impermissible subject matter should be defined as information that a skilled person would not directly and unambiguously derive from an application as filed by using common general knowledge, even taking into account implicit matter.

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:

In our view, the definition of impermissible subject matter should not depend on when an amendment is made.

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

In our view, not only claim limitations should be allowed, but also addition of claims per se, provided that they are fully supported by the originally filed application and that the scope of protection of the granted patent/utility model is not either widened or changed.

17) Should rules against impermissible added matter prohibit the removal of claims per se, as opposed to removing limitations from claims?

no

Please explain:

In our view, either removal of claims per se or removal of claim limitations should not be prohibited, provided that - as stated above - they are fully supported by the originally filed application and that the scope of protection of the granted patent/utility model is not either widened or changed.

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:

In our view the definition of impermissible added matter should be the same when applied by a patent office as well as when applied by a Court.

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 relevant date of knowledge of the notional skilled person should be the filing or 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?

In line with the EPO's approach under Article 123(2)&(3) of the European Patent Convention, a defect related to impermissible added matter should be remedied by allowing amendments referring 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 other comments.

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

Our proposals for harmonization encompass all industry sectors.

Summary

According to the Italian patent law an patent/utility model application or a granted patent/utility model may be amended on request of the owner. The Italian patent law has a standard for assessing permissibility of amendments either in the case of an application or in the case of a granted patent.

Even though no definition of impermissible added matter exists in the Italian patent law, the Italian case law and IP doctrine essentially follow the EPO novelty test and amendments are assessed based on the point of view of a notional skilled person at the filing or priority date.

Harmonisation of the definition of impermissible added matter is desirable. The Italian Group shares the definition given by EPO’s decision G1/93 and believes that such definition should be adopted by Patent Offices and Courts. In the frame of this definition claim limitations, addition or removal of claims should all be allowed.