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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

#### **Patent applications**

Under Article 55 Bis of the Mexican Industrial Property Law (MIPL):

*“Article 55 Bis.- Any documents filed upon compliance of those requirements referred to in Articles 50 and 55 of this Law, or in the case of voluntary amendments, shall not contain additional matters or claims giving broader scope than that contained in the original application considered as a whole.*

*Voluntary amendments shall only be accepted until the expedition of the resolution on the allowance or rejection of the patent referred to in Articles 56 and 57 of this law.”*

In the context of MIPL this means that voluntary amendments are allowed only prior to the end of the substantive examination of the application.

### **Granted patents**

Article 55 Bis clearly states that voluntary amendments are not allowed once the patent is granted. However, Article 61 of MIPL states that:

*“Article 61.- Changes in the text or drawings of the letters patent shall be allowed only in the following cases:*

*I.- In order to correct evident or clerical mistakes.*

*II.- In order to limit the extension of the claims.*

*The authorized changes shall be published in the Gazette”*

Accordingly, the description and drawings of a granted patent may not be changed at will, but the article requires that there is a mistake to be corrected.

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

Yes

### **Patent Applications**

The claims of a patent application may be changed at will under Articles 55 and 55Bis of MIPL, provided that the amendment does not contain matters in addition to those contained in the application as originally filed.

### **Granted Patents**

Amendments in the claims, under Article 61 of MIPL require changes in the claims to be restrictive, that is, to limit the scope (extension) of the claims, or to correct an evident mistake.

In the practice this provision is interpreted very narrowly and only changes that do not require further novelty or inventive step (non-obviousness) examination for determining if the amendment is allowable are readily accepted.

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.

### **Patent applications**

The standard is that the amendments to the description, drawings or claims should not go beyond the scope of the application as originally filed.

The standard exists in the statutory provisions of Article 55 Bis of the MIPL. *(Cited above.)*

### **Granted Patents**

The standard is that the amendments should be only for correcting mistakes or limiting the scope of the claims

The standard exists in the statutory provisions of Article 61 of the MIPL. *(Cited above.)*

Under Article 48 of the MIPL, the “original application” for divisional applications is considered to be the first parent application.

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

No, there are no differences between the standards.

- 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.

#### **After filing but before allowance or final rejection**

According to Article 55 Bis of the IPL, amendments to patent applications are permissible before the issuance of the decision by the Mexican Institute of Industrial Property (MIIP) to grant or reject a patent.

#### **After allowance but before grant or after final rejection**

Once the examiner issued a definitive opinion on patentability, either allowing the patent or rejecting it definitively, no changes are allowed. In the case of a definitive rejection no changes will be possible at all.

#### **After grant**

After payment of the issuance government fee, the description and drawings can be changed in order to correct mistakes and the claims for limiting its scope and correct mistakes.

It is interpreted that this kind of amendments can be filed any time after grant while the patent is in force.

- 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.

In general there is no definition of “impermissible matter” in the statutory provisions of the MIPL.

However, as the law clearly states what is permissible, anything that is not allowed or permissible would be considered impermissible.

- 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;

Article 42 of the Regulations of the MIPL states that when carrying out the substantive examination, the patent office will consider only the contents of the description, the claims and the figures. Accordingly, under a strict interpretation, the application as filed is limited to the mentioned description, claims and figures.

It is the Group's opinion that in practice the patent office interprets the term "application as filed" more broadly.

Further, the interpretation will depend on the origin of the application.

If the application **is filed under the Paris Convention or without priority claim**, for the purposes of amendments, the application as originally filed will include the description, drawings, claims, abstract, sequence listing and biological material deposit certificates.

If the application is a **national stage of the Patent Cooperation Treaty**, the application will be considered to include the description, drawings, claims, abstract, sequence listing and biological material deposit certificates as filed in the international patent application.

In some instances, particularly when the MIIP finds the patent application definitely lacking of clarity, by using two terms for defining the same element or non-complying with other requirements for the description, drawings and or claims, drastic changes to any of such elements may be allowed if and only if there is evidence that the matter was disclosed originally in the patent application considered as a whole. For instance, by demonstrating that the description is changed but the drawings are not modified at all. By including new reference numbers to the drawings and describing the numbered elements with reference to the same name given in the description, or the like.

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 Law is silent about the issue, there is no concept in Mexican law or practice defining a notional skilled person for interpreting amendments, and therefore, neither is a relevant date of knowledge of such person.

Nevertheless, it is a requirement of Article 47 of the MIPL that the description should be clear and complete in order to allow a person skilled in the art to reduce to practice the invention, which leaves open the possibility of using such a notional skilled person for interpreting the permissibility of an amendment.

Unfortunately, for the sake of Article 47, the relevant date of knowledge of the skilled person to which the description is directed is not defined, but considering that the description is made as of the date of filing and that the inventive step, another concept involving a skilled person, is evaluated as of the filing date, under Mexican law the relevant date of knowledge should be considered the filing date, if priority is claimed, the 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:

According to Article 78 when the impermissible amendment was made to the claims, the MIIP may in fact declare the nullity in partial form as a limitation or precision in the corresponding claim.

However, if the amendment was made to the description or drawings, whether such partial nullity declaration is possible or not will depend on the cause of nullity that is used and the merits of the specific case.

Under Article 79 of the IPL, the Patent Office is entitled to remedy the defect *ex officio*.

The nullity of a patent application can only be declared through an administrative proceeding before the MIIP, which may be ordered by the Courts.

Accordingly, under Article 78:

*“Article 78.- The patent or register shall be null in the following cases:*

*I.- ...*

*II.- ...*

*III.- ...*

*IV.- ...*

*...*

*When a nullity only affects one or some claims, or a part of a claim, **the nullity shall be declared only with respect to the affected claim or claims**, or the part of the affected claims. The nullity may be declared in the form of a limitation or precision in the corresponding claim.”*

## 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 current MIPL allows a proper balance by allowing the patent applicant to make appropriate amendments during examination, which should be approved by the MIIP during examination, but protecting the public and giving certainty to third parties that, on one hand, there will not be additional matter that was not disclosed originally and that, after grant, the scope will not change but only to be reduced.

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

yes

Please explain:

It would be desirable to have a more precise definition of impermissible added matter as well as specific guidelines to be considered when filing amendments.

The language of the current statutory provisions of the MIPL could be improved in order to:

- Link the concept of permissible amendments with the requirement of clarity of the description in Article 47.

- Introduce in the concept of the breadth of the claims and description that such breadth should be interpreted also by the skilled person as required for inventive step (non-obviousness) and description clarity.

Moreover, it would be desirable that applicants have the chance to file amendments after allowance but before grant.

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?

Our country does allow amendments post-grant and we consider that it does strike a proper balance between allowing a patentee to make appropriate amendments and protecting the public by preventing the addition of impermissible matter.

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

yes

Please explain:

It would be desirable to have clear guidelines on the interpretation of correction of evident and formal errors permitted under an amendment post grant. For example, an amendment to improve the wording or dependence in the claims seeking clarity.

Thus, it could be clearly defined what is considered an "extension" of matter in the 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?

Despite it is not specifically mentioned in the Law, it is interpreted that the notional person skilled in the art is used to determine the permissibility of amendments.

Further, the concept is inherent to the compliance of Article 47 that states that the description should be sufficient and complete to allow a skilled person to reduce to practice the invention.

The concept of the skilled person could be improved by making it explicit in the amendments, evaluation of inventive step and evaluation of the completeness of the description.

### 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:

Harmonisation of the definition of impermissible matter is desired.

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

*Impermissible added matter* is the modification introduced to a matter of a patent application by means of an amendment having as a consequence that the amended matter lacks support in the application as filed under the eyes of the notional skilled in the art at the relevant filing date linked to the amended matter, wherein the relevant filing date is the priority date or the effective national filing date, as corresponds to such amended matter, and the application as filed comprises at least the following documents: fulfilled application format, priority application, description, claims, figures, the abstract, sequence listings, certificates of deposits of biological materials, and documentation related to a non-harmful disclosure, if applicable.

On the other hand, the Mexico group also finds interesting as an additional possibility to define the *permissible matter* to be added through an amendment and consequently anything out of the definition could be considered *impermissible 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:

The proposed definition itself does not need to depend on when the amendment is made, but the Law should clearly state when amendments are permissible.

Patent applications should not have the same standard than granted patents. In order to protect the public, the claims of a granted patent should not include a scope beyond what was already granted.

If amendments adding matter to the claims were allowed, even if supported by the specification, the public would never know if any subject matter was given up by the applicant or not, thus making impossible to know in good faith if the third party activities will infringe a patent or not.

It is also significant that the Paris Convention provides for the possibility of filing divisional applications only for patent applications and not granted patents, Article 4 (G), which is the same reason why an amendment to a granted claim should never enlarge the scope of the patent, not even in a separate application (divisional) when the examination has ended.

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

No

For **patent applications** such a restriction would be opposite to the Paris Convention, Article 4(H). However, for **granted patents** the limitation for addition of any claims should be restricted to an actual limitation in scope of the claims as a whole.

For instance, if an independent claim recites expressly three possible embodiments of an invention, a separation of such claim into two independent claims, each reciting one of the three embodiments, thereby excluding one of the embodiments from protection, should be allowed. Accordingly, for granted

patents, a prohibition of adding claims per se would not be proper.

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

no

Please explain:

As in the case of the addition of claims, for **patent applications** such a restriction would be opposite to the Paris Convention, Article 4(H). However, for **granted patents** the limitation for addition of any claims should be restricted to an actual limitation in scope of the claims as a whole.

In fact, the most common way of limiting the scope of a claim is incorporating subject matter of a dependent claim into an independent claim and removing the former dependent claim.

If there are two independent claims covering two embodiments of the same invention or covering two categories of invention (process and product), by eliminating a claim the scope would be restricted to only one embodiment or category, and therefore, removal of claims should 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:

The definition should not change.

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 filing date, or if priority is claimed, the priority date.

Further considering if the amendment is relative to the matter contained in the priority application or the matter included for the application in Mexico.

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 essence the amendment should have been rejected by the patent office. Further, the effect of the rejection should be that the complete amendment should be considered as not filed.

For **patent applications**, the patent office would reject the amendment at the time of defining that the scope has been extended. For **granted patents**, we have defined the possibility of declaring partial nullity of the claims by the patent office *ex officio*.

Further, the applicant or patent owner may have to opportunity to request the patent office to make the subsequent revision.

In practice, under Rule 66.2(iv), if as a result of the International Preliminary Examination detects that an amendment exceeds the original description, it should notify of such circumstance the applicant, and furthermore, under Rule 66.4bis, if the PCT Preliminary Examination Authority receives the



amendment once such authority had initiated the drafting of the opinion or report the authority will not take it into account. Now then, if the patent office made a mistake by accepting the amendment, harmonization of the effect may be difficult, as general law on administrative procedures may be applicable.

Nevertheless, as a general rule the amendment should be considered as not filed and then the corresponding Patent office should re-examine the application as if the amendment was never filed.

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

The Group considers important to address the issue of amendments and impermissible added matter when a patent is within a litigation procedure such as an invalidation action or an infringement action.

It should be clear for the different kind of inventions when a matter described in an amendment can be considered as impermissible added matter or whether such amendment aims to support the embodiments already described or illustrate other alternative ways to apply the teachings of the invention that are already disclosed in the application as originally filed.

On the other hand, the Group also finds interesting as an additional possibility to define the *permissible matter* to be added through an amendment and consequently anything out of the definition could be considered *impermissible matter*.

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

#### Summary

The Mexican Group of AIPPI concludes that it is desirable to harmonize the definition of impermissible added matter. The definition should include the concept of notional skilled in the art at the time the protection for invention was pursued, that is, the priority date, if applicable, or the filing date of the application, if no priority was claimed.

On the other hand, the Mexico group also finds interesting as an additional possibility to define the *permissible matter* to be added through an amendment. Consequently anything out of such definition could be considered *impermissible matter*.

The Mexican Group also concludes that the rules against impermissible added matter must not prohibit the addition or removal of claims *per se*. Moreover, it should be allowed the possibility of adding limitations to the claims. Regarding the removal of limitations on the claims, it should not be allowed for a granted patent.

If the deletion of impermissible added matter by amendment would result in an impermissible extension of scope, the patent office would have the possibility of rejecting the amendment returning the application to the state it had before such amendment. If the patent has already been granted, it should be possible to limit the scope of protection.