



Submission date: 22nd April 2016

## 2016 – Study Question (Patents)

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

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Date	08-04-2016

### 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.

In the Netherlands there are basically two routes via which a patent can be obtained. A national Dutch patent can be obtained via the filing of a patent application with the Dutch Patent Office ("DPO"). Patent protection in The Netherlands can also be obtained by designating the Netherlands as a country in a European patent application.

Up until the grant of the patent, the rules that govern the European route differ from the Dutch route. The Dutch Patent Act 1995 ("DPA") provides the rules for obtaining a Dutch patent, while European patent applications are governed by the European Patent Convention ("EPC"). Once the grant of a European patent with a Dutch designation has been published by the European Patent Office ("EPO"), the patents have the same legal effect and the same rules apply to both patent types of patent (Art. 49 (1) DPA). See also Art. 2(2) EPC which provides that, unless the EPC provides otherwise, European patents are governed by the same legal provisions and have the same legal consequences as patents granted under national law.

#### *Amendments to Dutch patent applications*

The Dutch patent system is a registration-only system, meaning that patent applications are not examined by the DPO (although a novelty search is performed and a first opinion with respect to patentability is provided). A patent applied for via the Dutch route is granted as soon as the patent application is entered in the patent register, normally eighteen months after the date of filing or after the first date of priority, whichever date comes first (Art. 31 in conjunction with Art. 36 DPA).

Art. 28 DPA stipulates that the applicant may amend the description, claims and drawings of the patent application until the grant thereof (under Art. 31 DPA).

#### *Amendments to European patent applications*

During prosecution, European patent applications may be amended pursuant to Art. 94 (3) and 123 (1) EPC.

#### *Amendments to granted Dutch/European patents*

Art. 63 DPA provides that a patent holder may (voluntarily) limit his patent in whole or in part by registering an official document to that effect in the patent register. This provision may be used to amend the description, claims and drawings after grant of the patent. In daily practice, a new description and a new set of claims is filed with the DPO. The document will only be registered by the DPO if all third parties which according to registered documents have rights with regard to the patent (e.g. registered licensees or claimants in a nullity suit which has been registered) have agreed with the limitation. Adding new dependent claims, via the registration of an official document ex Art. 63 DPA is not allowed (*Toll Collect vs Papst*, District Court of The Hague, 6 July 2011, IEPT20110706).

Article 138 (3) EPC provides that during national revocation procedures against a granted European patent, the patent may be limited by a corresponding amendment of the claims if a ground for revocation affects the European patent only in part. It also provides that in such proceedings, the proprietor of the patent shall have the right to limit the patent by amending the claims. This rule also applies to Dutch patents (*Bébécar-Utilades Para Crianca vs Maxi Millaan B.V.*, Court of Appeals of The Hague, 30 March 2010, IEF 8731).

For European patents, Art. 105a EPC further provides that at the request of the proprietor, the patent may be limited by amendment of the claims for all Contracting States in respect of which the patent was granted (Art. 105b(3) EPC).

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

Yes (see answer to Q.1 above).

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.

#### *Statutes*

Art. 28 DPA provides that the subject matter of a divisional or amended Dutch patent application must be covered by the contents of the original application. However, as mentioned above under Q.1, Dutch patent applications are not examined before grant.

Art. 75(1)(b) DPA provides that a court will (partially or in its entirety) revoke a patent if the subject matter is not covered by the application as filed or the original application. This provision applies to both Dutch and (Dutch parts of) European patents. The test under this Dutch provision equals that of Art. 123(2) EPC: a European patent (application) may not be amended in such a way that it contains subject matter which extends beyond the application as filed.

#### Case Law and guidelines

With regard to European patent applications, the EPO applies the standards as determined by the (Enlarged) Technical Boards of Appeal in: G 1/93 (<https://www.epo.org/law-practice/case-law-appeals/recent/g930001ex1.html> [<https://www.epo.org/law-practice/case-law-appeals/recent/g930001ex1.html>] ); G 2/10: (<http://www.epo.org/law-practice/case-law-appeals/recent/g100002ex1.html#q=%22G%2000%202F10%22> [ ] ); and G 11/91 (<http://www.epo.org/law-practice/case-law-appeals/recent/g910011ex1.html> [<http://www.epo.org/law-practice/case-law-appeals/recent/g910011ex1.html>] ). See further Case Law of the Boards of Appeal of the EPO, Part II, E.1 ([http://documents.epo.org/projects/babylon/eponet.nsf/0/4CCF968D57494023C1257C1C004F992C/\\$File/case\\_law\\_of\\_the\\_boards\\_of\\_appeal\\_2013\\_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/4CCF968D57494023C1257C1C004F992C/$File/case_law_of_the_boards_of_appeal_2013_en.pdf) [[http://documents.epo.org/projects/babylon/eponet.nsf/0/4CCF968D57494023C1257C1C004F992C/\\$File/case\\_law\\_of\\_the\\_boards\\_of\\_appeal\\_2013\\_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/4CCF968D57494023C1257C1C004F992C/$File/case_law_of_the_boards_of_appeal_2013_en.pdf)] ).

These standards are summarized in the Guidelines for Examination of the EPO, Part H, Chapter IV.2 (<http://www.epo.org/law-practice/legal-texts/html/guidelines/e/index.htm> [<http://www.epo.org/law-practice/legal-texts/html/guidelines/e/index.htm>] ).

The EPO standards are also applied by the Dutch patent courts to assess whether or not granted European or Dutch patents include inadmissible added matter. Examples of Dutch case law in which these standards are applied include *Shionogi/Resolution* (Court of Appeals of The Hague, 16 February 2016, ECLI:NL:GHDHA:2016:339), *Novartis/Alvogon* (Court of Appeals of The Hague, 18 November 2014, ECLI:NL:GHDHA:2014:3611), *Rovi/Ziggo* (Court of Appeals of The Hague, 25 June 2013, ECLI:NL:GHDHA:2013:CA3887) and *ECB/DSS* (Court of Appeals of The Hague, 21 December 2010, IER 2011/29).

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.

The standards are not affected by timing (although procedural issues may arise from 'late' filing).

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.

Whether added matter is impermissible, is assessed according to abovementioned standards. As Dutch patent applications are not examined (see above under Q.1), amendments to such applications are not refused by the DPO.

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 guiding principle is the perspective of the skilled person and his general knowledge of the prior art on the priority date when assessing what the skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the application as filed.

This principle is based on the general principle that a balance must be struck between a fair protection for the patentee and the legal certainty for third parties.

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 assessment must be carried out '*ex tunc*' (i.e. at the priority date or date of the application, as confirmed in e.g. the *Shionogi/Resolution* decision as mentioned above under Q.3 A).

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:

See the answer to Q.1 above.

The Group notes that post-grant amendments made to the patent in order to repair impermissible added matter may affect other statutory patentability requirements. An example is Art. 123(3) EPC, according to which article the granted patent may not be amended in such a way as to extend the protection it confers. If, for example, the impermissible added subject matter relates to a limiting feature, removing the feature would cause impermissible extension of the protection conferred by such claim (see e.g. District Court of The Hague, 20 October 2010, ECLI:NL:RBSGR:2010:BQ2203 (*Ceva/Beaphar*)).

## 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?

### *European patent applications*

From a substantive point of view, the balance between allowing a patent applicant to make appropriate (admissible) amendments during the examination process on the one hand and preventing the applicant from adding impermissible matter in the other hand is guarded by taking into account these two interests when applying the standards described above under Q. 3A.

From the fact that the way the standards have been applied over the years has been subject to change, it follows that the (commonly held) opinion of how this balance should be reached has changed

over time and is currently still changing. With regard to European patent applications, it is our impression that before G1/93, the interests of the patent applicant were given priority at the EPO and that after that decision and still today, more attention is given to third party interests due to a more literal approach at the EPO.

The more literal approach means that, the common general knowledge of the skilled person and the actual invention play too little a role when the application is examined by the EPO. As to the procedural aspects under the EPC, when applying Rule 137(4) EPC examiners currently request clarification for basis for amendments if any text of the amendments cannot be literally traced back to the application as filed.

The 2014 revision of the EPO Guidelines for Examination resulted in additional explanation on how to apply the standards on (im)permissible added matter as opposed to the previous edition(s). In particular, the Guidelines now instruct that the focus should be placed on what is really disclosed to the skilled person in the documents as filed as directed to a technical audience. In particular, the guidelines relate to the situation in which the claims are amended by the introduction of subject matter that was only disclosed in the description of the application as filed. Examiners are instructed to consider the disclosure of the application as a whole, as read by a person skilled in the art, rather than focusing too strongly on the structure of the claims as filed. This additional paragraph in the Guidelines for Examination, Part H, Chapter IV-2.2 ([http://www.epo.org/law-practice/legal-texts/html/guidelines/e/h\\_iv\\_2\\_2.htm](http://www.epo.org/law-practice/legal-texts/html/guidelines/e/h_iv_2_2.htm) [[http://www.epo.org/law-practice/legal-texts/html/guidelines/e/h\\_iv\\_2\\_2.htm](http://www.epo.org/law-practice/legal-texts/html/guidelines/e/h_iv_2_2.htm)] ), is considered to be a response to the common view among patent practitioners that the EPO's position on added subject matter is too strict, with the result that applicants are too restricted in the amendments that they are allowed to make.

It remains to be seen whether this change in the Guidelines will lead to a change in how amendments in European patent applications are assessed by the EPO, or whether it is only a clarification of the current approach. It also remains to be seen whether this shift affects the way in which the standards will be applied by the Dutch patent courts.

In this regard, the Group notes that even though the Dutch patent courts apply the EPO standards, it is the Group's impression that the Dutch patent courts apply these standards less strict than the EPO and already take more notice of the knowledge of the skilled person compared to the more literal approach that is often taken by the EPO.

#### *Dutch patent applications*

In particular with regard to Dutch patent applications we note that, as the Netherlands have a system of a registration patent, amendments after filing of the application for a Dutch patent are not examined. This means that the applicant is not prevented from adding impermissible subject-matter to the application. However, if the applicant has introduced impermissible subject-matter before grant, this provides a ground for post-grant revocation of the Dutch patent in invalidity court proceedings.

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

no

Please explain:

The legal provisions have not changed (substantially) over the years and in the Group's opinion provide sufficient guidance in order to establish the permissibility of an amendment when national and EPO case law and the EPO Guidelines are taken into account.

Improvements can be found in the way the legal provisions are interpreted. The 2014 revised Guidelines - which may result in a less strict approach by the EPO - suggest a shift in a direction that the Group considers an improvement. That is away from a literal approach and towards an approach

wherein the actual invention that the skilled person using his common general knowledge, would derive from the application plays a decisive role. This is in line with other aspects of the European patent prosecution which are (and in our view should remain) primarily focussed on (the protection) of the invention. This makes the standards better balanced.

This discussion is similar to the debate regarding the assessment of scope of protection. The objective should be to strike a balance between the interests of the patent applicant / patentee and that of third parties, always with the legal certainty of all parties involved in mind. In our view an approach wherein the actual invention that has been made is decisive (and not the mere literal wording) strikes a better balance.

In this regard the Group notes that one of the dangers of overstressing the importance of 'literal' basis for amendments (i.e. an amendment is only allowable if the applicant can refer to a verbatim basis in the application) is that applicants will draft applications accordingly, trying to cover as many variants as possible in order to be able to point to a specific embodiment if the need arises during prosecution. This will result in applications that are far more extensive and elaborate than is merited by the invention for which protection is sought for in the first place. These applications will furthermore be far more difficult to read and comprehend for a third party.

As to procedural aspects under the EPC, the procedure could in our opinion be improved by making sure that Rule 137(4), second sentence of the EPC, is used less rigorously by EPO examiners.

With regard to (unexamined) amendments made to Dutch patent applications, the Group is of the opinion that the lack of examination is properly compensated by an examination of the permissibility of amendments in court proceedings and during advisory proceedings before the Dutch Patent Office (Art. 84 DPA), the result of which advisory proceedings may be used in court proceedings.

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.

From a substantive point of view, the balance between allowing a patent applicant to make appropriate (admissible) amendments during the examination process on the one hand and preventing the applicant from adding impermissible matter in the other hand is, under Dutch law, guarded by taking into account these two interests when applying the standards described above under Q. 3A.

Amendments to a patent may be introduced by the patentee post grant by means of a deed ex Art. 63 DPA (see Q.1 above). Such amendments are not examined by the Dutch patent office. However, if the patentee introduced impermissible added matter by means of such deed, this provides a ground for revocation of the patent during court proceedings.

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

no

Please explain:

See the answer to Q.9 above.

The Group is furthermore of the opinion that similar standards should be applied to the assessment of added matter issues and (material) priority issues, as in both situations the assessment essentially addresses the question as to whether the amended patent or patent application at issue relates to 'the

same invention'. When assessing novelty, the contents of the prior art should also be interpreted the same way. Relevant is what the skilled person would derive directly and unambiguously, using common general knowledge, from the document as a whole.

- 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 Dutch patent courts often refer to the general knowledge of the skilled person when the court assesses claim amendments for which there is no literal basis in the application as filed.

The actual knowledge of the skilled person is generally not as thoroughly established in Dutch court proceedings as it is for instance in the UK, where expert evidence plays a large(r) role. A more thorough assessment of the general knowledge of the skilled person may improve effectiveness and predictability of the assessment of impermissible added matter. Such more thorough assessment is of course only possible in Dutch court proceedings if the parties themselves provide sufficient (expert) evidence of the knowledge of the skilled person (or the lack thereof). A more thorough assessment of common general knowledge is also something that would benefit the way the EPO applies the standards.

### 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 may lead to more uniform drafting of patents across jurisdictions. Where patent applications are nowadays generally filed through one PCT application, which is by definition intended to serve as the basic application for various prosecutions and which should lead to patents in various jurisdictions, it would be highly desirable, if not necessary, that the same standards are used in different jurisdictions for the assessment of the permissibility of added matter. More importantly, these definitions should be interpreted in a similar and predictable way in different jurisdictions.

We believe it is important to consider the standards for the assessment of impermissible added matter in the context of other relevant provisions of patent law, in particular scope of protection. Harmonizing the standards for impermissible added matter without harmonizing other provision may lead to a situation where patent law (e.g. scope of protection) is ultimately less harmonized than it is today, even though the standards for amendments are harmonized.

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

The Group believes that the wording of Art. 123(2) EPC combined with the practice at the EPO (see Guidelines for Examination in the European Patent Office, Part H - Chapter IV.1) could - as such - serve as a basis for a definition regarding impermissible added matter:

*Impermissible added matter is subject matter which extends beyond the content of the application as filed, being any subject-matter which the skilled person cannot derive directly and unambiguously, using common general knowledge, from the disclosure of the invention as filed, also taking into account any features implicit to a person skilled in the art in what is expressly mentioned in the document.*

Application of this definition in practice however causes problems already mentioned above, in the sense that the definition is at least at the EPO often applied by examiners very strictly only permitting amendments that have a (nearly) literal basis in the application as filed. Therefore, guidelines in the form of a protocol for the interpretation of the definition are desirable. Such protocol (based on Guidelines for Examination in the European Patent Office, Part H - Chapter IV.1/2) could read as follows:

*The definition of impermissible added matter should not be interpreted as meaning that literal support is required. On the other hand, the overall change in the content of the application (whether by way of addition, alteration or excision) should also not result in the skilled person being presented with information that is not directly and unambiguously disclosed in the application as filed and that would improve applicant's or patentee's position and would be damaging to the legal certainty of third parties relying on the content of the original application.*

Thus, one would introduce a check based on third parties' interests which by definition also introduces the understanding by the average skilled person.

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:

No, as long as other statutory patentability requirements, in particular scope of protection, are taken into account.

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

No, as long as other statutory patentability requirements, in particular scope of protection, are taken into account.

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:

Yes, for reasons of legal certainty.

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) 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?

The Group is not unanimous in its opinion whether this should be remedied. If it is remedied, there are the following two options:

1. If a claim in a patent contains a feature not originally disclosed as part of the invention, the patent is not to be revoked if the feature leads to narrower protection and not to different subject matter. The feature not originally disclosed is to be ignored when assessing patentability, as it cannot support the invention (the German Bundesgerichtshof approach: Bundesgerichtshof 17 February 2015, Az.: X ZR 161/12 *Wundbehandlungsvorrichtung*).

1. The impermissible added matter in the claim should, to the extent possible, be replaced with subject matter which is permissible and comes closest to the scope of the patent without deletion of the impermissible added matter. In addition, any third party, whether acting in good faith or not, that made attempts starting to work or started working the subject-matter protected by the amended, but not by the granted claims, may continue working in that area.

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

No further comments

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

Summary