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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

New Zealand

Contributors name(s)

Michael BROWN, Kate BLINCOE and Jon TORRANCE

e-Mail contact

michael.brown@ajpark.com

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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?

Note, in September 2014, the Patents Act 2013 ('the 2013 Act') came into effect. Under the 2013 Act, added matter is treated differently to the previous legislation, the Patents Act 1953 ('the 1953 Act'). We are currently in a transition period where many cases are still being prosecuted under the 1953 Act, therefore both acts are relevant. Where applicable, the differences between the 2013 Act and the 1953 Act will be highlighted when answering the following questions.

Yes. Under the 2013 Act, amendments to any part of the specification can be made both before and after acceptance. This was also the case under the 1953 Act.

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

Yes. Under the 2013 Act, amendments to any part of the specification can be made both before and after acceptance. This was also the case under the 1953 Act.

3) Further to your answers to questions 1) and 2), please indicate:

- a) the standard for determining whether such amendments are permissible and indicate whether this standard exists in statutes, regulations, patent office guidelines, and/or in case law.

The rules are different before and after acceptance.

Before acceptance

Amendments prior to acceptance can be made in the following instances:

- a. voluntary amendments can be made before examination
- b. amendments can be made during examination to meet official objections
- c. voluntary amendments can be made during examination.

Under the 2013 Act, the general rule is that any amendment which does not add new matter is allowable. There must be **support** for the amendment. A request for amendment must include a statement setting out parts of the specification supporting the amendment. This standard exists in statutes and regulations.

The 1953 Act also allows any amendment which does not add new matter. In contrast to the 2013 Act, there must be **fair basis** for the amendment in the specification and it is not necessary to include a statement setting out the applicable parts of the specification. This standard exists in statutes, regulations and case law.

IPONZ has taken a strict interpretation of the term 'support' and some types of voluntary amendments that were allowable under the 1953 Act are no longer allowable under the 2013 Act. For example, IPONZ will currently not allow amendments under the 2013 Act to add statements clarifying interpretation (for example, a definition of the term 'comprising' or a statement clarifying that objects or advantages are non-limiting). IPONZ does not consider there to be support for these types of amendments. IPONZ did allow such amendments under the 1953 Act.

After acceptance

Amendments after acceptance can be made in the following instances:

- a. voluntary amendments on the part of the applicant / patentee
- b. amendments to meet post-acceptance objections
- c. amendments made during the course of opposition or revocation proceedings.

Under the 2013 Act, the Commissioner **may allow** a complete specification to be amended after acceptance, so these amendments are discretionary. An amendment will not be allowed if the effect of the amendment is that the specification as amended would claim or describe matter **that was not in substance disclosed** in the specification before the amendment (i.e. the amendment introduces added matter), or a claim of the amended specification would not fall wholly within the scope of a claim of the specification before the amendment. These limitations do not apply to correcting an obvious mistake. There must be **support** for the amendments in the original complete specification. This standard exists in statutes and regulations.

The 1953 Act only allows post-acceptance amendments which are disclaimers, corrections or explanations. As with the 2013 Act, amendments are not allowed if the effect the amendment is that the specification as amended would claim or describe matter **not in substance disclosed** in the specification before the amendment, or that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment. These limitations do not apply to correcting an obvious mistake. There must be **fair basis** for the amendments in the original complete specification. This standard exists in statutes, regulations and case law.

In theory, a broader range of amendments may be allowed under the 2013 Act as post-acceptance

amendments no longer have to be by disclaimer, correction or explanation. It may be possible to add new claims after acceptance provided they fall wholly within the scope of an existing claim.

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

Under both acts you cannot make post-acceptance amendments if the effect of the amendment is that the specification as amended would **claim or describe** matter **that was not in substance disclosed** in the specification before the amendment (i.e. the amendment introduces added matter), or a claim of the amended specification **would not fall wholly within the scope of a claim** of the specification before the amendment, unless the amendment is a correction of an obvious mistake.

Under both acts, IPONZ may require that the patent application is post-dated to the date of making a pre-acceptance amendment, if the pre-acceptance amendment is considered to introduce new matter (whether that is in the description, claims, or drawings).

It is permissible to broaden claims before acceptance under the 1953 Act and the 2013 Act, as long as the amendment is fairly based (the 1953 Act) or has support (under the 2013 Act).

Other than that the standards 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.

As outlined above, the standard is stricter after acceptance than before acceptance.

The standard after acceptance but before grant is the same as the standard after grant. However, a patent application that was filed and examined under the 1953 Act will continue to be governed by the 1953 Act after acceptance, until the patent is granted. Once granted, the patent will be governed under the 2013 Act. Therefore, the limitation that the amendment must be made by way of disclaimer, correction, or explanation will apply post-acceptance, but not post-grant.

- 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 not explicitly defined in the legislation in relation to pre-acceptance amendments but could be interpreted as any amendment not meeting the requirements as outlined in the answer to question 3 (i.e. the amendment does not have support in the specification).

Both acts state that post-acceptance amendments must not result in the amended specification claiming or describing matter that was **not in substance disclosed** in the specification before the amendment, subject to the exception for corrections of an obvious mistake. Under the 2013 Act, the applicant or patentee must file a statement with their post-acceptance amendment that outlines where there is support in the specification for the amendment.

- 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;

A patent application is interpreted through the eyes of a person skilled in the relevant art to which the patent relates.

- 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?

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:

Amendments to restore validity post-grant may be allowed provided the claims that need to be amended were drafted with due care. However, such an amendment will be subject to the post-acceptance limitations outlined above.

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?

Under the 2013 Act, each amendment before acceptance is assessed by an examiner and is to be accompanied by:

- The applicant's reasons for making the amendment
- Clearly marked up and clean copies of the amended specification
- A statement setting out the specific part or parts of the original complete specification that supports each of the proposed amendments.

Under the 1953 Act, each amendment before acceptance is assessed by an examiner and is to be accompanied by:

- The applicant's reasons for making the amendment
- Clearly marked up and clean copies of the amended specification.

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

- 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 request for amendment must be accompanied by a statement of support that outlines where there is support for an amendment in the accepted specification. There are limitations on broadening of claims or adding matter post-acceptance, as discussed above in relation to post-acceptance

amendments. Post-grant amendments are advertised in the IPONZ journal for opposition purposes.

11) Are there aspects of these laws 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?

Amendments need to have support, and post-acceptance amendments cannot extend the scope of the claims or result in the specification describing or claiming something that was not in substance disclosed in the accepted specification (unless when correcting an obvious mistake); both require a consideration of the patent from the perspective of a person skilled in the art. However, this will generally be done by a patent examiner during examination of the amendments, rather than being done by a person skilled in the art. It may be possible to submit evidence from a person skilled in the art to assist with addressing examiner objections to amendments.

A patent (claims and description) needs to be interpreted from a reasonably known/fixed perspective or else it could be open to multiple interpretations. Basing this on the knowledge of the person skilled in the art, while subjective and at times not well defined, is at least an attempt to provide this.

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.

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

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)?

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

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

18) Should the definition of impermissible added matter be the same when applied by a patent office 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?

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?

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

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

Summary

Amendments to description, figures, and claims of patent specifications are allowable both before and after acceptance. Amendments under the 1953 Act required fair basis, whereas amendments under the 2013 Act require support, which is construed as a higher threshold by IPONZ. Post-acceptance amendments under the 2013 Act are less restrictive than under the 1953 Act, but support is required for such amendments. Post-acceptance amendments under both acts have more restrictions than pre-acceptance amendments.