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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	Philippines
Contributors name(s)	Bienvenido I. SOMERA, Ma. Sophia Editha CRUZ-ABRENICA, Darwin P. ANGELES and Mark Leo P. BEJEMINO
e-Mail contact	bi.somera@thefirmva.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?

During examination, amendments to the description and/or figures of a patent application is possible provided that such amendments do not include new matter outside of the scope of the disclosure contained in the application, as filed, in accordance with Section 49 of the Intellectual Property Code of the Philippines ("IP Code")^[1] and Rules 916^[2], 919^[3] and 923^[4] of the Revised Implementing Rules And Regulations For Patents, Utility Models And Industrial Designs ("IRR for Patents").

Once the patent has been granted, amendments to the description and/or figures of a granted patent is still possible in order to: (1) limit the extent of the protection conferred by the patent; (2) to correct obvious mistakes, clerical errors, or (3) mistakes and errors made in good faith; provided that if the amendments would result in broadening of the extent of the protection conferred by the patent, (i) the request for amendment must be made within two (2) years from the grant of the patent and (ii) the change shall not affect the rights of any third party who has relied on the patent, as published, in accordance with Section 59 of the IP Code^[5] and Rule 1209 of the IRR for Patents.^[6]

Footnotes

1. [^] Section 49 of the IP Code states: "Sec. 49. Amendment of Application. – An applicant may amend

the patent application during examination: Provided, That such amendment shall not include new matter outside the scope of the disclosure contained in the application as filed.”

2. [^](#) *Rule 916 of the IRR for Patents provides: “Rule 916. Amendments by the Applicant. – An applicant may amend the patent application during examination; Provided, That such amendment shall not include new matter outside the scope of the disclosure contained in the application as filed (Sec. 49, IP Code).”*
3. [^](#) *Rule 919 of the IRR for Patents provides: “Rule 919. Amendment of the Disclosure. – No deletion or addition shall broaden the disclosure of an application to include new matter after the filing date of the application. All amendments to the description, claims, or drawings and all addition thereto made after the filing date of the application must conform to at least one of them as it was as of the filing date. Matter not found in either, involving a departure from or an addition to the original disclosure cannot be added to an application even though supported by a supplemental oath and can be shown or claimed only in a separate application.” [Emphasis supplied]*
4. [^](#) *Rule 923 of the IRR for Patents provides: “Rule 923. Amendments to the Drawing. – No change in the drawing may be made except by permission of the Bureau. Request for changes in the manner of presentation shown in any drawing may be made only upon payment of the required fee. A sketch in permanent ink showing the proposed changes to become part of the record must be filed together with the request for amendment. The paper requesting amendments to the drawing should be separate from other papers. The drawing may not be pulled out from the Bureau except for signature. Substitute drawings will ordinarily not be admitted in any case unless required by the Bureau.”*
5. [^](#) *Rule 59 of the IP Code provides: “Rule 59. Changes in Patents. – 59.1. The owner of a patent shall have the right to request the Bureau to make the changes in the patent in order to:*
6. [^](#) *Rule 1209 of the IRR for Patents provide: “Rule 1209. Changes in Patent. – The owner of the patent shall have the right to request the Bureau to make changes in the patent in order to:*

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

The claims of a patent application may be amended during examination provided that such amendments do not include new matter outside of the scope of the disclosure contained in the application, as filed, in accordance with Section 49 of IP Code and Rules 916 and 920 of the IRR for Patents. The claims may be amended by canceling particular claims, by presenting new claims, or by amending the language of particular new claims.

Similar to amendments to the description and/or figures of a granted patent, amendments to the claims of a granted patent is still possible in order to: (1) limit the extent of the protection conferred by the patent; (2) to correct obvious mistakes, clerical errors, or (3) mistakes and errors made in good faith; provided that if the amendments would result in broadening of the extent of the protection conferred by the patent, (i) the request for amendment must be made within two (2) years from the grant of the patent and (ii) the change shall not affect the rights of any third party who has relied on the patent, as published, in accordance with Section 59 of the IP Code and Rule 1209 of the IRR for Patents.

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.

For patent applications, the standard is that the amendments should not include new matter outside of the scope of the disclosure contained in the application, as filed. This standard is provided in the statute (Section 49 of the IP Code), as well as in the regulations (Rules 916, 919 and 923 of the IRR for Patents) and in the patent office guidelines, specifically, Chapter VI, 3.2^[1] and 5.1^[2] of the Manual for

Substantive Examination Procedure (“MSEP”).

Chapter VI, 5.4 of the MSEP provides that “[a]n amendment should be **regarded as introducing subject matter which extends beyond the content of the application as filed and therefore unallowable, if the overall change in the content of the application** (whether by way of addition, alteration or exclusion) results **in the skilled person being presented with information which is not directly and unambiguously derivable from that previously presented by the application**, even when account is taken of matter which is implicit to a person skilled in the art...”
[Emphasis supplied]

For granted patents, the standard is that the amendments should be limited to obvious mistakes, clerical errors, or mistakes and errors made in good faith and that if the amendments would result in broadening of the extent of the protection conferred by the patent, (i) the request for amendment must be made within two (2) years from the grant of the patent and (ii) the change shall not affect the rights of any third party who has relied on the patent, as published^[3]. This standard is provided in the statute (Section 59 of the IP Code^[4]), as well as in the regulations (Rules 1209 of the IRR for Patents^[5]).

Footnotes

1. [^] Chapter VI, 3.2 of the MSEP provides: “3.2 Such amendments being voluntarily made by the applicant, the applicant is not restricted to amendment necessary to remedy a defect in his application. It does not, however mean that the applicant is free to amend in any way he chooses. Any amendment must satisfy the following conditions:
2. [^] Chapter VI, 5.1 of the MSEP provides : “5.1. An applicant may amend the patent application during examination, provided that such an amendment does not include new matter outside the scope of the disclosure contained in the application as filed... x x x If amended claims are directed to subject matter which has not been searched (e.g. because it only appeared in the description and the examiner did not find it appropriate to extend the main search to this subject matter), ... such amendments are not admissible. This applies particularly when this unsearched subject-matter alone is now claimed. x x x It is important also to ensure that no amendment adds to the content of the application as filed and thus offends against the proviso in Sec. 49 ...”
3. [^] Rule 1209 of the IRR for Patents provide: “Rule 1209. Changes in Patent. – The owner of the patent shall have the right to request the Bureau to make changes in the patent in order to:
4. [^] See Footnote 10.
5. [^] See Footnote 14

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

There is no difference in the standards used between amendments to the description and/or figures and amendments to the claims.

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 standard used during the application process, whether after filing but before examination, during examination, or after allowance but before grant, is generally the same: no new matter outside the

scope of the original disclosure must be introduced by the amendment.

However, the rules on amendment become stricter as the application progresses into allowance and grant of the patent. Under Chapter VI, 4.9 of the MSEP, after the Notice of Allowability has been issued, only minor amendments which do not appreciably delay the preparations for the grant of patent will be allowed. Chapter VI, 4.10 of the MSEP provides that “[o]nce the decision to grant has been taken, further amendments or corrections to the granted patent can only be requested on the basis of Sec. 57, 58 or 59.” Section 57 of the IP Code provides for correction of mistakes incurred through the fault of the IPO, Section 58 provides for correction of a mistake in a patent of a formal or clerical nature which is not incurred through the fault of the IPO.

After the patent has been granted, the standard is different and more stringent as provided for under Sec. 59 of the IP Code.

- 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.

An impermissible added matter is not directly defined in the IP Code, in the IRR for Patents and MSEP. What is provided is the requirement that for amendments to be allowed, they must not extend to the subject-matter beyond the content of the application as filed. Chapter VI, 5.4 of the MSEP defines what constitutes an amendment extending the content of the application as follows:

“5.4 An amendment should be **regarded as introducing subject matter which extends beyond the content of the application as filed and therefore unallowable, if the overall change in the content of the application** (whether by way of addition, alteration or exclusion) results **in the skilled person being presented with information which is not directly and unambiguously derivable from that previously presented by the application**, even when account is taken of matter which is implicit to a person skilled in the art...” [Emphasis supplied]

Relevantly, under Chapter II, 4.3 of the MSEP, ‘subject-matter’ of the Philippine patent application “is to be understood – starting off from the prior art – as comprising those features which, in the framework of the disclosure required by Section 35.1 of the IP Code, relate to the invention”. ¹¹

Footnotes

- ¹¹ Chapter II, 4.3 of the MSEP provides: “4.3 The description should also mention any background art of which the applicant is aware, and which can be regarded as useful for understanding the invention and its relationship to the prior art; identification of documents reflecting such art, especially patent specifications, should preferably be included. This applies in particular to the background art corresponding to the first or “prior art” portion of the independent claim or claims (see III, 2.2). The insertion into the statement of prior art of references to documents identified subsequently, for example by the search report, may be required, where necessary, to put the invention into proper perspective. For instance while the originally filed description of prior art may give the impression that the inventor has developed the invention from a certain point, the cited documents may show that certain stages in, or aspects of, this alleged development were already known. In such a case the examiner may require a reference to these documents and a brief summary of the relevant contents. The subsequent inclusion of such a summary in the description does not contravene the proviso of Sec.49. The latter merely lays down that, if the application is amended, for example by limiting it in the light of additional information on the background art, its

subject-matter must not extend beyond the content of the application as filed. But the subject-matter of the Philippine patent application within the meaning of Section 49 is to be understood – starting off from the prior art – as comprising those features which, in the framework of the disclosure required by Sec.35.1, relate to the invention (see also VI, 5.3) ...” [Emphasis supplied]

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 application is to be interpreted as a person skilled in the art would understand in accordance with Section 35 of the IP Code and Chapter II, 4.9 of the MSEP.

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?

Under Chapter IV, 9.6 of the MSEP,^[1] a “person skilled in the art” should be presumed to be an ordinary practitioner aware of what was common general knowledge in the art at the relevant date. The relevant date appears to be the filing date for the application, since Chapter VI, 5.4 of the MSEP states that “it does not appear to be permissible to add to an application matter present only in the priority document for that application.” Hence, it appears that permissibility should be assessed by the person skilled in the art only from the filing date of the application, and not from the priority date as the information contained in the priority document is not considered as permissible subject matter.

Footnotes

1. [^] Chapter IV, 9.6 of the MSEP provides: “9.6 The “person skilled in the art” should be presumed to be an ordinary practitioner aware of what was common general knowledge in the art at the relevant date. He should also be presumed to have had access to everything belonging to the “prior art”, in particular the documents cited in the search report, and to have had at his disposal the normal means and capacity for routine work and experimentation.” [Emphasis supplied]

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:

The IP Code, IRR for Patents and the MSEP do not specifically address the situation where in a post-grant proceeding the amendments to the patent application were determined to contain impermissible added matter.

Nevertheless, under Section 61.2 of the IP Code,^[1] where the grounds for cancellation relate to some of the claims or parts of the claim, cancellation may be effected to such extent only. Accordingly, if the ground for cancellation arises from an impermissible added matter, cancellation should be limited to the deletion thereof.

Note however, that Sec. 65.2 of the IP Code provides that “[i]f the Committee finds that, taking into consideration the amendment made by the patentee during the cancellation proceedings, the patent and the invention to which it relates meet the requirements of this Act, it may decide to maintain the patent as amended”.

Footnotes

1. [^] *Sec. 61.2 of the IP Code provides: “61.2 Where the grounds for cancellation relate to some of the claims or parts of the claim, cancellation may be effected to such extent only.” [Emphasis supplied]*

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 IP Code, as well as the IRR for Patents and the MSEP, explicitly allows amendments to the description, figures and claims of patent application during its examination. However, for amendments to be allowed, they must not include new matter outside of the scope of the disclosure contained in the application as filed.

Rule 920 of the IRR for Patents require the applicant to indicate which portion of the original disclosure constitutes the basis for the amendments.^[1]

The determination of whether new matter is permissible is left to the discretion of the patent examiner of the Philippine Intellectual Property Office (“IPO”) who applies the “person skilled in the art” standard. Further, upon “reply to the second communication from the substantive examiner, the applicant may amend again, but any amendment will ordinarily need to be restricted to overcoming the objections raised by the examiner. Other types of amendments will require the consent of the examiner. Giving the examiner this discretion is intended to ensure that the examination procedure if brought to a conclusion in as few actions as possible”.^[2]

If the IPO patent examiner refuses to admit an amendment, in whole or in part, a petition for admittance of such amendment may be filed before the Director of the Bureau of Patents of the IPO.^[3]

“Rule 920. *Amendment of Claims.* -- The claims may be amended by canceling particular claims, by presenting new claims, or by amending the language of particular new claims (such amended claims being in effect new claims). IN presenting new or amended claims, the applicant must point out how they avoid any reference or ground of refusal of record which may be pertinent. Furthermore, in order to facilitate the processing of the examination of the application, **the applicant shall indicate in his response which form part in the original disclosure constitutes the basis of the amendments.**” *[Emphasis supplied]*

Footnotes

1. [^](#) *Rule 920 of the MSEP provides:*
2. [^](#) *Section VI, 4.7 of the MSEP.*
3. [^](#) *Rule 927 of the IRR of Patents provides: “Rule 927. Petition from Refusal to Admit Amendment. – From the refusal of the Examiner to admit an amendment, in whole or in part, a petition for admittance of such amendment may be filed before the Director under the Regulations.”*

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

yes

Please explain:

As discussed above, an impermissible added matter is not specifically defined in the IP Code, the IRR for Patents and the MSEP; hence, a clear definition of the same is in order.

Procedure for admission of amendments during cancellation proceedings should also be clarified.

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?

The IP Code allows amendments of granted patents. However, these amendments are limited to obvious mistakes, clerical errors, or mistakes and errors made in good faith. Moreover, if the amendments result in broadening of the extent of the protection conferred by the patent, the request for amendment must be made within two (2) years from the grant of the patent.^[1] As discussed above, permissibility of amendments become more difficult post-grant.

Footnotes

1. [^](#) *Section 59 of the IP Code; Rule 1209 of the IRR of Patents*

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

yes

Please explain:

Considering that the allowable amendments are limited only to obvious mistakes, clerical errors, or mistakes and errors made in good faith, and if such amendments will result in broadening of the extent of the protection conferred by the patent, only a two (2)-year period is provided for requesting the amendment, we are of the opinion that the period for filing the request for amendments must be extended. The current two (2)-year period is too restrictive since the term of a patent is twenty (20) years from the filing date thereof.

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 IPO patent examiner applies the notional “person skilled in the art” standard to determine the permissibility of amendments. We are of the opinion that this approach is effective and consistent with the rule that the patentability of an invention is examined using the “person skilled in the art” standard.

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, harmonization of the definition of impermissible added matter is desirable since the subjective standards governing the amendment of claims for patent applications and registrations have, to a certain extent, resulted in varying degrees of protection granted from one jurisdiction to another.

The varying definition of impermissible added matter becomes problematic because it allows for a situation to arise whereby an applicant enjoys varying degrees of protection from one jurisdiction to another introducing a measure of uncertainty to the scope of protection enjoyed by the patentee.

Consider a situation when an applicant or registrant relies on added matter allowed in a certain jurisdiction (for example the European Union) during the amendment stage and relies on the features of the invention as protected by the EU registration. Once registered, the patentee thereafter proceeds to market its invention containing all its features, as granted, on the assumption that the invention’s additional matter will be granted amendment in other jurisdictions since the same was granted registration in the EU. However, if another State follows a different definition on impermissible added matter, it is likely that the invention’s feature, which was incorporated as an added matter amendment, will not be granted protection. This poses a potential problem in the expectation of patent protection by the patentee which can be prevented by harmonizing the definition of impermissible added matter throughout jurisdictions.

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

We believe that the definition provided by the European Patent Office’s (“EPO”) Guidelines for Examination (Guidelines H-IV,2), is appropriate. The direct and unambiguous standard of the EPO is the same rule adopted by the Philippine Intellectual Property Code and the Philippine substantive examination guidelines.

In this regard, Section 49 of the IP Code provides that an “amendment shall not include new matter outside the scope of the disclosure contained in the application as filed.” Further, Section 5.4, Chapter VI of the MSEP provides that an amendment is impermissible “if the overall change in the content of the application (whether by way of addition, alteration or excision) **results in the skilled person being presented with information which is not directly and unambiguously derivable from that previously presented by the application**, even when account is taken of matter which is

implicit to a person skilled in the art”, which is in close parallel to the EPO standard.

We are of the opinion that the EPO’s direct and unambiguous standard is reasonable to ensure that the requirement that claims must be based on the application specification as filed will be followed. A more liberal relaxation of the direct and unambiguous standard may unnecessarily dilute said requirement to the point that it becomes nugatory. The standard ensures that the new matter must be directly and clearly derivable from the original disclosure made by the applicant.

Accordingly, we submit that the EPO standard may serve as one of the best starting points for harmonization of the definition of impermissible added matter having been the uniform rule rigorously followed in the Philippines. The definition will also allow a concrete basis for determining whether matter is impermissible by directly tracing it to the disclosures in the specifications which would form part of its support or basis.

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. It is submitted that the definition can be made to apply to all stages of a patent, whether after filing, during examination proceedings, after allowance or after grant of patent.

That the foregoing definition must apply during examination stage is emphasized by the fact that under the IP Code, patents must be published simultaneously with the grant thereof.^[1] The opportunity of incorporating added matter to a patent’s claims must be greatly limited within the examination stage is because once the patent is granted and published accordingly, third parties and the public have the right to rely on the claims of the patent as published to determine what subject matter is covered by and excluded from patent protection so that they may be guided accordingly.

If amendment is allowed post-grant, a publication mechanism therefore should be provided so that the public can be guided accordingly. Further, the public must not bear the burden of post-grant amendments in that the public should only be responsible after publication of the post-grant amendments.

With regard to the application of this definition to post-grant amendments, Section 59 of the IP Code^[2] provides that once a patent is granted, there are only three (3) instances where further changes to patents may be allowed:

(a) Changes limiting the extent of the protection conferred by the patent;

(b) Corrections of obvious mistakes or clerical errors; and

(c) Corrections of other mistakes or errors made in good faith.

The first instance clearly disallows the addition of any new matter to the scope of patent protection because to do so would have the effect of broadening the protection conferred by the patent. On the other hand, corrections, whether clerical or otherwise, are always subject to the requirement that the change must always stay within the bounds of the disclosure contained in the application as filed as required by Section 49 of the IP Code.^[3]

Based on the foregoing, the definition of impermissible subject matter need not distinguish the stage of proceedings in which the amendment is requested since ultimately, the overriding requirement is that claims must be based on the disclosure of the application at the time of the filing thereof.

Footnotes

1. [^] Sections 50 & 52, IP Code. Section 52 of the IP Code reads, as follows: “Section 52. Publication Upon Grant of Patent. - 52.1. The grant of the patent together with other related information shall be published in the IPO Gazette within the time prescribed by the Regulations. 52.2. Any interested party may inspect the complete description, claims, and drawings of the patent on file with the Office.”
2. [^] Section 59 of the IP Code provides: “Section 59. Changes in Patents. - 59.1. The owner of a patent shall have the right to request the Bureau to make the changes in the patent in order to:(a) Limit the extent of the protection conferred by it;(b) Correct obvious mistakes or to correct clerical errors; and(c) Correct mistakes or errors, other than those referred to in letter (b), made in good faith: Provided, That where the change would result in a broadening of the extent of protection conferred by the patent, no request may be made after the expiration of two (2) years from the grant of a patent and the change shall not affect the rights of any third party which has relied on the patent, as published.59.2. No change in the patent shall be permitted under this section, where the change would result in the disclosure contained in the patent going beyond the disclosure contained in the application filed.59.3. If, and to the extent to which the Office changes the patent according to this section, it shall publish the same.”
3. [^] Section 5.9, Chapter VI, MSEP provide that “[c]orrection of errors in the application documents is a special case involving an amendment, therefore the requirements of the proviso of Sec. 49 apply likewise” [Emphasis supplied]

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

No. The goal of prohibiting impermissible added matter is to prevent the addition of matters not covered by the specification of the application as originally filed. Ideally, the specification’s disclosure must be sufficiently clear and complete so that a person skilled in the art may understand the invention and replicate the same. This is a consequence of one of the fundamental purposes of patent law, which is to promote “disclosures of inventions to stimulate further innovation and to permit the public to practice the invention once the patent expires”. The submission of an insufficient disclosure violates this public policy because it opens the door for the grant of patent protection to the holder without the concomitant benefits to the public once the patent expires.

The inclusion of a prohibition against the addition of claims per se does not serve this goal because it simply works to limit the number of claims of an application to what was originally filed. However, such

a rule does not preclude the applicant from violating the disclosure requirement by submitting an incomplete specification and obtaining an earlier priority date then amending the original claims, but maintaining the original number of claims, to incorporate previously undisclosed matter by way of amendment during examination or post-grant proceedings. This is sought to be prevented by the prohibition against the grant of patent protection over matters beyond the scope of the original specification as filed.

Anent the proposal to prohibit adding limitations to claims, the IP Code allows amendments to patents, and more so to patent applications, provided that its effect is to limit the scope of the protection as granted. The added matter would still be considered permissible under the direct and unambiguous standard of Section 5.4, Chapter VI of the MSEP.

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

no

Please explain:

No. A prohibition against the removal of claims *per se* will not achieve the goal of preventing addition of impermissible matter simply because it does not preclude applicants from bringing in new matter by amending the existing claims of a patent application or registration.

With regard to a prohibition against the removal of limitations from claims, such prohibition may result in precluding addition of impermissible matter. We note however that such a rule would go against the Philippine laws at present and may be prejudice patent applicants since under IP Code, such prohibition only applies to post-grant amendments under Section 59 thereof where removal of limitations would have the prohibited effect of broadening the protection granted by the patent. Such prohibition is absent under Section 49 of the IP Code which, in turn, impliedly allows applicants to amend their claims to remove limitations to expand the scope of protection of their claims so long as the claims, as amended, are supported by the specification as originally filed.

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 and this is the prevailing rule required to be observed by courts under the Rules of Procedure for Intellectual Property Rights Cases (“IPR Rules”) promulgated on 03 October 2011 by the Philippine Supreme Court. In this regard, Section 4, Rule 17 of the IPR Rules encourages courts to secure technical advice from recognized experts or from the Philippine Intellectual Property Office in resolving complex questions of fact which will require technical advice or expert witness testimony:

“SEC. 4. *Request for technical advice.* – In patent infringement cases, **the court, *motu proprio* or upon motion by a party, may order the creation of a committee of three (3) experts to provide advice on the technical aspects of the patent in dispute.** Within thirty (30) days from receipt of the order creating the committee, each side shall nominate an expert, who shall then both be appointed by the court. The court shall appoint the third expert from a list submitted by the experts of each side. All fees and expenses relating to the appointment of a committee shall be initially equally shouldered by the parties but may later on be adjudicated by the court in favor of the prevailing party.

To assist in the trial involving highly-technical evidence or matters, the court may also request the IPO to provide equipment, technical facilities, and **personnel.**" [Emphasis supplied]

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?

Since Section 49 of the IP Code refers to "the disclosure of the application as filed", the relevant date of knowledge for the hypothetical skilled person must be the filing date¹¹ of the application. Matter contained in the priority document but not claimed in the application as filed should not be considered, as substantive examination is conducted by the Examiner on the application as filed, not on the priority documents.

Footnotes

1. ¹¹ Section 31 of the IP Code provides: "Section 31. Right of Priority. - An application for patent filed by any person who has previously applied for the same invention in another country which by treaty, convention, or law affords similar privileges to Filipino citizens, shall be considered as filed as of the date of filing the foreign application: Provided, That: (a) the local application expressly claims priority; (b) it is filed within twelve (12) months from the date the earliest foreign application was filed; and (c) a certified copy of the foreign application together with an English translation is filed within six (6) months from the date of filing in the Philippines."

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 added matter, since impermissible, should be prohibited and thus deleted. The impermissible extension of scope should then be addressed on the basis of the specific rule that prohibits the extension of the scope, such as on the basis of clarity and specific disclosure rules.

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

The guidelines for publication of post-grant amendments should be studied in order to ensure protection to the public who rely on the information pertaining to published patents. Since the amendments will affect the public rights, the rules such as when is a certain act considered infringing—after post-grant publication of the amendment, after constructive notice to the public, or after actual knowledge of the party involved—should be studied and clarified.

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

The industry sector views included in the proposals are those of Legal Consultants in the Intellectual Property field.

Summary

The Philippines allows for the amendment of patent claims during examination or post-grant. To be allowed, the amendment must not introduce additional matter outside the scope of the patent application's disclosure ("impermissible added matter") at the time of its filing with the patent office. Impermissible added matter is defined as any new matter which is not directly and unambiguously derivable from the original disclosure of the application as filed and results in an extension of the scope of the application.

Harmonizing impermissible added matter definitions among jurisdictions is necessary to ensure uniformity of patent protection. The best starting point for a harmonized definition is the EPO's direct and unambiguous standard. Such definition must be capable of application at any stage of the patent cycle, whether during examination or post-grant. Limitations on the definition impermissible added matter based on addition or removal of claims *per se* is not practicable nor efficacious. The definition must preclude applicants from incorporating impermissible added matter by amending an application or registration's existing claims.

Finally, rules for admission and publication of post-grant amendments -- which will determine when acts are considered infringing -- must be clarified such that the public who relies on information pertaining to published patents must be considered to be in good faith and therefore, non-infringing. Further, the allowable period for requesting amendment must be extended.