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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, but in a very limited scope.

According to the Polish law, the introduction of amendments is possible only before the patent is published. Upon publication, a patentee can only file a request for correction of obvious linguistic errors (e.g. typos in the patent description.)

More serious changes can be introduced in the course of the examination of a patent application. However, these can never go beyond the scope of the original version of the application.

The Applicant has the right to introduce in the invention description and in the figures amendments and additions until the final decision on granting a patent is issued (i.e. also in the course of proceedings for a case reexamination.) Such amendments and additions cannot, however, go beyond the scope disclosed in the application description on the filing date. The amendments and additions can be made due to the PPO's request or the applicants initiative.

During the application proceedings, it is not permitted to introduce to the patent description any essential technical features that were not present in this description on the filing date.

The corrections and additions made also cannot change the subject-matter of the solution as disclosed on the filing date, in other words, it cannot create a different solutions than the one disclosed in the original version of the application description.

If the disputed new feature provides a significant technical contribution to the subject-matter of a solution, it is an inadmissible amendment due to the lack of its previous disclosure in the application description.

Any change to the application content (invention description, figures) by adding, changing or eliminating information which for a person skilled in the art is not directly and unambiguously possible to derive from the original application, shall be regarded as changing the subject-matter of the solutions, and as a consequence, as inadmissible.

It is permissible to supplement the application prior art by the applicant. The Patent Office itself often invites to make it after conducting a search. Such a supplementation of an application by a description of a solution similar to the one applied for, e.g. constituting the closest prior art, can lead to a need to introduce amendments consisting in highlighting in the invention description advantageous effects (when these are easy to be deduced by an expert from the originally disclosed technical features) and highlighting the aim of the solution applied for.

It is also admissible to redraft the technical problem description solved by the invention if it can be deduced from the entire content of the original application.

Other acceptable amendments include: correction of the title and invention description aiming to standardize the content, incl. the application category, adjustment of the invention description and title to the amended claims and corrections, obvious for an expert, based on the entire description, incorrect data, removal of the ambiguities and contradictions, amending and standardizing the technical terminology and editorial as well as linguistic errors.

Supplementation of the embodiments or description of the benefits or effects of a solution can be admissible only if these additional data were disclosed in the application, e.g. in the drawing or can be unambiguously derived from the invention description, claims, and figures.

In particular, the following amendments and additions to the application description of an invention are unacceptable according to existing case law:

- when the subject-matter of a solution created as a result of the introduction of an amendment is novel in comparison with the original application content, (*cf. ruling of the Board of Appeal App. No. 1162/91*, e.g. addition to an application, concerning a composition of a rubber mixture, additional ingredients or elimination in an application relating to a multi-layer material, of a feature presenting one layer disclosed in the original version as a significant feature distinguishing the invention,
- introduction of any technical information which could not be objectively derived by an average expert from the original invention application,
- Additional examples and technical or biological data, particular in the field of chemistry (such data can be, however, taken into account by an expert as evidence or additional explanations in the assessment of the invention patentability and included in the case files, but cannot be published as a part of the invention description.)

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

After the patent is granted, a patentee can only resign from a part of the protection by removing one or more claims.

More serious changes can be introduced in the course of the patent application examination. However, these can never go beyond the scope of the application original version. The scope of admissible changes also depends on the proceedings stage, wherein the scope of the acceptable amendments before the application publication date is broader than the scope of changes admissible at a later stage

of the proceedings.

The applicant has a right to introduce in the patent claims some amendments and additions until a final decision on granting a patent is issued. These amendments and additions cannot, however, go beyond the scope disclosed as a subject-matter of a solution on the application description on the filing date, wherein amendments introduced to the claims in a manner broadening the original protection scope are admissible only until the application is pronounced in the Bulletin of the Patent Office (for national applications) or in the PCT Gazette (for international applications). The amendments and additions can be made upon request of the Patent Office or the initiative of the applicant.

During application proceedings, it is inadmissible to introduce to the claims content any technical features that were not present in the application content on the filing date. It shall also be noted that it is unacceptable to extend the initial scope of the protection sought, defined in the patent claims after the announcement of the application, even if the introduced additions and amendments have support in the original version of the invention description. Under the term of protection scope one shall understand such changes in the patent claims which would result in the increase of the solutions number covered by the patent protection.

The disputed new feature introduced to a claim is an inadmissible amendment due to the lack of its earlier disclosure in the application description or due to a too late, in case of extending the protection scope, transfer of the same to the patent claims.

Any change of the claims by adding, changing or eliminating information that is not possible to be directly and unambiguously derived by an expert from the original application shall be regarded as changing the subject-matter of a solution, and as a consequence as inadmissible.

A particular attention shall be paid to any changes made in the claims due to the fact that these define the scope of the protection sought.

Generally permissible are changes in the claims which limit this scope, e.g. narrowing of the parameters scope and introducing change of a feature, consisting in the replacement of its general definition by a more detailed one, instead of the term „flexible support“, the expression „disc spring“ is used; instead of „oil“, the term „soybean oil“ is used, etc. provided that this detailed definition occurs somewhere else in the application description.

Possible are changes in the claims which consist in: transferring features from one claims to the others, e.g. from dependent claims to the independent claims, adding features disclosed in the invention description or in the drawing, and transferring features between the non-characterized and characterized part of the claims.

The change of the category from the product to a method of manufacture thereof is a limitation of the protection scope because the protection scope resulting from a patent granted for a particular product includes the manufacture of this product by any method. Also, the transfer of the part of characterized features to the non-characterized part and further clarification of these features is a limitation of the scope of a protection sought (decision of the Board of Appeal, App. No. 1901/98).

A change of a category in relation to a category defined on the filing date is basically inadmissible (it could expose a third party to the patent infringement consequences.) However, there are circumstances where the introduction of a new category is possible. This is especially true when these categories can be derived from the request text, especially from the title, and the description comprises sufficient premises for such a change (decision of the Board of Appeal, App. No. 1901/98).

It is therefore possible to change a patent category „product“ to „a manufacture method“, „use“ or „treatment method“ to „the use“.

Particularly inadmissible are:

- changes in the claims extending the defined protection scope through, for example, the extension of a process parameters scope, introduction of new invention categories not disclosed in the original version of the invention application description.

- introduction to the patent claims, in order to limit the protection scope, a new technical parameter value, e.g. temp. 12°C that was not specifically mentioned in the application description, but it could have been derived from the invention description content since the range of 1-15°C was given; such a novel value was not disclosed;

The limitation of a protection scope cannot be free within the frames of the overall disclosure, but it is determined by the original disclosure (decision of the Board of Appeal, App. No. 1492/99).

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 above-presented interpretative rules of art. 37 IPL are expressed in PPO guidelines for examination and in the decisions of the Board of Appeal operating at the PPO.

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

There are no such differences. The only exception is an inadmissible extension of the scope of the protection sought upon publication of the application, even if the proposed claims changes do not go beyond the disclosure scope included in the original version of the patent application.

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 the application, it is not possible to introduce any amendments changing the subject-matter of the invention disclosed in the original application.

Additionally, upon publication of the application, it is inadmissible to introduce changes to the claims extending the scope of the protection initially sought.

Upon publication of a patent, it is only admissible to introduce amendments of obvious linguistic errors and to limit the patent scope consisting in the removal of one or more claims.

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.

The basic rule is the inadmissibility of the changes which „extend, beyond the content of the application as filed“.

Moreover, taking into account the above rule, the admissible changes in the claims are subjected to an additional limitation upon publication of a patent application since „the alteration of the patent claims resulting in the extension of the scope of protection originally sought may only be made until the time of publication of the application“.

6) In any assessment of impermissible added matter under your Group's current law, please explain:

a) how the patent application as filed is interpreted;

In practice, it is accepted that the scope of the disclosure also includes all information which could be easily derived by an expert from the application content.

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?

IPL does not precise this issue directly, but in the PPO practice it is accepted that the relevant date for determining the specialist knowledge is the filing 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?

no

Please explain:

Upon publication of a patent, it is not possible to introduce this type of changes in its content. Moreover, according to art. 89 IPL, a patent can be invalidated as a whole or in a part on a request of a person who has a legal interest if s/he demonstrates that this patent was granted for an invention not covered by the content of the application or original application.

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 balance is achieved by recognizing as admissible the changes which could be easily derived by a specialist from the original application version.

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

yes

Please explain:

It would be desirable to clarify for which date the knowledge of a specialist analyzing the application content shall be determined.

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 range of the admissible changes after granting a patent is very limited. Only possible are the

amendments of obvious errors and limitations of the patent consisting in the removal of one or more claims. In accordance with the IPL, the basic aim of the changes admissible after granting a patent is not the defense of the patent against its invalidation but the protection against the introduction of changes into the protection scope which would lead to cover by the scope the monopoly of solution not falling into within the patent as granted.

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

no

Please explain:

It seems that currently the IPL provides an adequate legal security and prevents collisions with patents which scope could be changed (transferred or extended) after granting.

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?

It seems that the PPO practice is sufficiently clear. However, it is worth consideration to introduce a clarification in the law relating to the date for which the knowledge of a specialist analyzing the application content shall be determined.

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:

It seems that further harmonisation of the definition „impermissible added matter”, and especially the practice relating to the assessment of the scope of the admissible changes is desirable.

Particularly, it relates to the following two issues:

- the criteria of the assessment of the changes admissible in the course of the application examination, in particular the determination of common rules taking into account the rules for interpretation of the disclosure included in the original application by a person skilled in the art;
- the scope of the changes admissible after granting a patent.

With respect to the Polish law, it would also be desirable to specify the date for which the knowledge of a specialist analyzing the application content shall be determined.

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

As impermissible added matter shall be treated each change which on the filing date, for a specialist, extends beyond the content of the application as filed.

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)?

yes

Please explain:

It seems that such a differentiation is desirable. The introduction of changes shall be more difficult upon publication of an application, and limited solely to the changes leading to the limitation of a protection after granting a patent. The introduction of such a distinction has a positive influence on the market security and legal certainty.

Unacceptable shall be any changes relating to the subject-matter of a solution disclosed in the original application, and especially introducing new information about technical effects connected with the use of the invention since by influencing the assessment of the inventive step, it could lead to grant a patent for a solution which was not disclosed in the original application.

A particular care shall be taken in the assessment of changes limiting the scope of claims introduced after granting a patent, especially in the course of the invalidation proceedings. Due to the patentability of selective invention, the introduction of claims limitation not disclosed in the original application may lead to grant a protection for a solution not disclosed in the original application.

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

Yes

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:

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?

It shall be the application filing/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?

Such a deletion of added matter shall be acceptable only before the patent publication, especially before the application publication. After granting a patent, it shall be inadmissible and shall lead to the patent invalidation.

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

The rules on the admissibility of changes shall consider not only the principle of inadmissibility of the change of a subject-matter if an invention, but also the principle of a legal security. Therefore, one shall limit the scope of admissible changes relating to patent claims which could lead to the extension of the protection scope. These amendments shall not be acceptable after granting a patent. Due to the durability of examination proceedings, it is desirable that such changes were possible only before the publication of an application.

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

Summary